









**THE LAW OF  
TRADE AND MERCHANDISE MARKS IN INDIA**

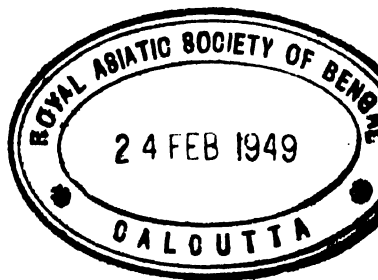


THE LAW OF  
TRADE AND MERCHANDISE MARKS  
IN INDIA.

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WITH A FOREWORD

BY  
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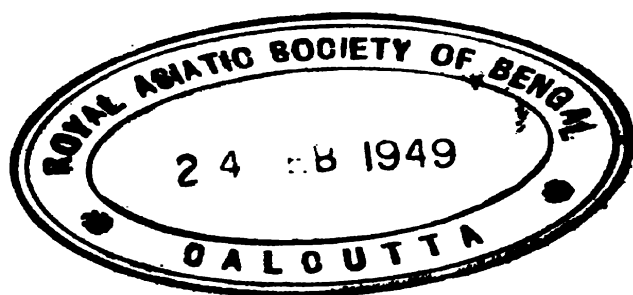


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## FOREWORD.

IN company with Abyssinia, the Solomon Islands, Monaco, St. Helena, Sarawak and a few other countries of similar commercial standing,\* the great Empire of India has no trade mark legislation! It would appear that the interests of commerce and manufacture and other practical considerations do not attract the attention of those who clamour so loudly for political recognition. Perhaps, the analysis of the problems involved requires too much thought and trouble for the popular type of politician. Be that as it may, the situation is one in which traders and manufacturers, British and Indian alike, have a profound practical interest. Those who have reason to complain of the unscrupulous imitation of the "get-up" of their commodities are driven, in default of a better remedy, either to the cumbrous and expensive judicial procedure known to English common law as a "Passing-off-suit" or to the merely penal provisions of the Merchandise Marks Law. Moreover, a merchant or manufacturer who wishes to avail himself of the first remedy must select one or more of the provinces in which to start his proceedings. If in Bengal, Bombay or Madras, he may have to choose the High Court on its original side, and in the other provinces he will have to fight his suit before a Subordinate Judge who has even less acquaintance with commercial affairs. Again, the results obtained may widely vary. In one province it may be held that he has failed to prove that his goods are known by the mark in question. In another province it may be held that the "get-up", name or mark which he seeks to protect is incapable, in law, of legal protection. In a third it may be held that the defendant's "get-up" is not a copy; while in a fourth he may obtain at enormous expense an

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\*See Appendix XIII of this book.

injunction which will be confined in its operation to that particular province. In short, the administrative side of the law is in a state of chaos, though the principles of English common law are clear and precise. Commercial India has long sought to have this state of affairs remedied and has struggled for the establishment of a Trade Marks Register as in other civilised countries. It is noteworthy that an Indian Patent Office for the protection of inventions now exists, though the need for protection of inventions is far less, in India, than for machinery to protect trade marks; for though a large proportion of the population is engaged in manufacture or trade, the number of inventions made in India is negligible. In the matter of trade marks, Indian and European interests are identical and there can be no question of a preference being given to either. Both, therefore, should unite to the achievement of a common object.

By virtue of the fact that for many years, in my practice at the Bar, I had experience of Patent and Trade Mark law I have been invited to contribute a "Foreword" to this book written by Mr. Venkateswaran of the Indian Patent Office. I venture to recommend it from two points of view. Firstly, as a text book of law it sets forth with remarkable clarity and accuracy the principles of trade mark law considered in the light of the English common law and as the basis for the establishment of a register of trade marks. As the author is careful to point out, a properly conducted registry of trade marks and the institution of the right to bring a suit for infringement depend upon the fundamental conceptions which underlie the common law passing off action, but the remedy is made swifter and far less expensive. A trade mark office, moreover, is self supporting and should, save in the beginning, involve little or no administrative cost. Mr. Venkateswaran's explanation of the basic principles of law is very thorough and complete and is admirably illustrated from the reported cases. Indeed, I am astonished to find that legal principles should be so admirably

expounded by one who is not a professional lawyer and whose daily work must leave little leisure for the study of law. Perhaps, this is less surprising in the case of an Indian author than would be the case if the book had been written by one of my own countrymen; for Indians seem to me to have a natural genius for law as a subject of study.

Mr. Venkateswaran's book, however, is more than a legal text book. It is a very complete presentment of the case for the establishment of a trade mark registry. This aspect of the matter is scientifically developed in the First Part and in the concluding chapter, and the author exhibits a very thorough grasp of the practical questions involved. I would recommend these portions of the book to commercial India and to the high administrative authorities who will have to tackle a difficult and necessarily unfamiliar problem. It is clear that, from a judicial point of view, Patents and Trade Marks will have to be administered as a Federal subject and the extraordinary situation which now prevails should be terminated as soon as possible.

I hope for this book the success which it undoubtedly deserves.

COURTNEY TERRELL,

PATNA,  
27th August, 1935.

*Chief Justice,*  
Patna High Court.





## PREFACE.

THE law of trade marks is essentially the creation of the 19th century. As in the case of the law relating to patents, we owe the development of this branch of law also to the genius of the English speaking race. Even long prior to the passing of the first Trade Marks Act, in 1875, the principles of trade mark law had been very well developed and followed in England by the Courts of Equity and Common Law. It was laid down by these courts in the early part of the last century, in a series of well-known decisions, that a person shall not represent his goods as the goods of somebody else. The right of every trader to the exclusive use of the trade mark which had become associated with his goods in the market and the right to restrain his rivals from pirating that mark were recognised under the common law, and the Courts granted injunctions and awarded damages to the injured owner of the mark. In the beginning protection was granted only in cases where fraud could be shown, but after the decision in the famous case, *Millington v. Fox*, in 1838, fraud was not considered essential for a passing off action. A right of property in trade mark came to be gradually recognised, and in order to obtain an injunction, it was held sufficient to show that the defendant threatened to do, and, if not prevented, would do, injury to that right. Notwithstanding the protection of trade mark rights thus afforded by the Common law it was found that the piracy by unscrupulous traders could not be effectively checked, and this was largely due to the cumbrous and expensive procedure involved in prosecuting suits for passing off. Under the common law, in every trade mark action the onus lay on the plaintiff to prove his title by evidence of prior usage, and such proof, even in the case of a well-known mark, was often difficult and expensive. Moreover, success in one case was no guarantee that there would not be other similar suits, and where there were several infringements, the owner of the mark had to establish his title *de novo*, in every individual action if the defendant chose to dispute it. The need was therefore keenly felt for a machinery by which the owner of a trade mark could readily establish his title to the satisfaction of

the court without being put to the necessity of proving prior usage. A demand from the commercial community for a legislative measure to facilitate and cheapen actions for infringement of trade marks resulted in the passing of the first Trade Marks Act in England, which came into operation on the 13th August, 1875. The Act and the subsequent Acts of 1883 and 1888 have been replaced by the Trade Marks Act of 1905, amended by the Acts of 1914 and 1919.

The position of trade mark owners in India at the present day is very similar to what it was in England prior to the passing of the first Trade Marks Act. In the absence of a statute law the principles of English common law are followed by the Indian courts in granting relief in trade mark cases. It is not surprising, therefore, that in their efforts to restrain piracies of their marks the owners of trade marks in India are meeting with the same difficulties as were experienced by the commercial community in England before 1875. Well-known trade marks of both Indian and English merchants are flagrantly copied and the merchants are practically helpless in the prevention of such wholesale piracies of their marks. Cheap inferior imitations of popular brands of goods are ever on the increase in the market and are passed off as the genuine ones. The injury done to trade mark owners by such fraudulent imitations of their marks by unscrupulous traders cannot be estimated easily. Apart from loss of custom by the sale of the spurious goods which displace the genuine ones, the owners of the marks often find their reputation damaged irreparably by such misrepresentation. The consequent loss of business may in most cases be permanent and be incapable of real compensation by damages obtained after a long drawn out suit under the common law. Such oppressive and unfair competition, unless checked in time, would result in what Herbert Spencer termed 'commercial cannibalism'. A legislative measure similar to that adopted in England under similar circumstances is thus urgently needed for this country. Such legislation would provide for an action for infringement and relieve the trade mark owner from the burden of establishing his title by proving prior usage in every infringement suit, the fact of registration being then regarded as *prima facie* evidence of his title to the mark. Another great advantage which would accrue from such legislation is that it would provide a permanent record of the registered marks so that any trader might consult the Register before using a new mark and thus avoid adopting unwittingly a mark that would be an infringement of an

already registered trade mark, belonging to a different trader. The advantages which such a legislation would confer have been better appreciated in recent years by the commercial communities in India, both Indian and British.

The present book has a twofold aim. Firstly, it presents a case for the enactment of a statute law for the registration of Trade Marks in India; and secondly, it gives a fairly comprehensive account of the existing law relating to trade and merchandise marks in India. The general scheme of the work will be clear from the Table of contents. After a historical Introduction, an account is given in Chapter II of the present difficulties of Indian trade mark owners in protecting their marks in India and abroad, and a plea is set forth for a Trade Marks Act for India. Certain special problems relating to the registration of cotton marks that may arise in the event of legislation are dealt with in Chapter III. Chapters IV to IX deal with the civil law relating to trade marks in India. As the principles of English common law on the subject are followed by the Indian courts, a full account is given of these principles illustrated by leading English and Indian trade mark cases. A brief account is then given of the Law of Trade Libel (Chapter X). Chapter XI deals with the Indian Merchandise Marks Act and the criminal law relating to trade marks. Although this Act was passed as early as 1889 there does not appear to be any text book on this branch of law so far. As the Indian Merchandise Marks Act is based on the English statute of 1887 the corresponding sections of the two Acts are compared, wherever necessary, and references are given to all the reported Indian cases and to the leading English cases bearing on the subject. The book concludes with a Chapter dealing with certain principles of trade mark legislation, which are discussed with special reference to Indian conditions. It is pointed out that the British system of registration offers the most equitable method of protection of trade marks and it is suggested that the Trade Marks Act which may be enacted in India may, with advantage, be modelled on the English Trade Marks Act. The Report of the Goschen Committee recently appointed by the Board of Trade in England has been carefully considered and it is hoped that the observations on these recommendations will be useful in the framing of any such Indian Act.

In view of the official position which the author holds it is desirable to state here expressly that the book represents solely his personal views and not those of the Government of India.

The author desires to express his thanks to the Government of India for kindly granting permission to publish this book and to Mr. K. Rama Pai, M.A., Controller of Patents and Designs, for his encouragement in the preparation of the book. The author is deeply grateful to Sir Courtney Terrell, Chief Justice, Patna High Court, for kindly writing the Foreword.

CALCUTTA,

S. VENKATESWARAN.

*dated the 6th Oct. 1936.*

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## LIST OF ABBREVIATIONS.

A.C.	..	Law Reports, Appeal Cases, 1891—
A.I.R.	..	All India Reporter (Allahabad, Bombay, Calcutta, Lahore, Madras, Nagpur, Oudh, Patna, Privy Council, Rangoon, Sind.)
A.L.J.	..	Allahabad Law Journal.
A.W.N.	..	Allahabad Weekly Notes.
Ad. & E.	..	Adolphus and Ellis's Reports, K.B.
All.	..	Indian Law Reports, Allahabad series.
Am.L.T.	..	American Law Times.
Amer. Rep.	..	American Reports.
App. Cas.	..	Law Reports, Appeal Cases, House of Lords, 1875-1890.
Atk.	..	Atkyns' Reports, Chancery.
B. & Ad.	..	Barnewall and Adolphus' Reports, K.B.
B. & C.	..	Barnewall and Cresswell's Reports, K.B.
B.L.R.	..	Bengal Law Reports.
Beav.	..	Beavan's Reports, Rolls Court.
Beng. L.R.App.	..	Bengal Law Reports, Appendix.
Bing.	..	Bingham's Reports, C.P.
Bom.	..	Indian Law Reports, Bombay series.
Bom.L.R.	..	Bombay Law Reporter.
Bur.L.R.	..	Burma Law Reporter.
Bur.L.T.	..	Burma Law Times.
C.B.	..	Common Bench Reports.
C.B. (N.S.)	..	Common Bench Reports, New series.
C.C.R. (L.R.C.C.R.)	..	Law Reports, Crown Cases, Reserved.
C.P.D.	..	Law Reports, Common Pleas Division.
C.W.N.	..	Calcutta Weekly Notes.
Cal.	..	Indian Law Reports, Calcutta series.
Ch.	..	Law Reports, Chancery Division, 1891-
Ch. App.	..	Law Reports, Chancery Appeals, 1865-1875.
Ch.D. (C.D.)	..	Law Reports, Chancery Division, 1875-1890.
C.L.J.	..	Calcutta Law Journal.
Cor.	..	Coryton (Bengal).
Cox.	..	Cox's Criminal Law Cases.
Cr.C.	..	Criminal Cases.
Cr.L.J.	..	Criminal Law Journal.
Cro. Jac.	..	Croke's King's Bench Reports.
Ct. of Sess. Cas	..	Court of Sessions Cases (Scotch).
D. & B.	..	Dearsley and Bell's Reports.
De G. & J.	..	De Gex, and Jones's Reports, Chancery.
De G. & Sm.	..	De Gex and Smale's Reports, Chancery.
De G.F. & J.	..	De Gex, Fisher and Jones's Reports, Chancery.
De G. J. & S.	..	De Gex, Jones and Smith's Reports, Chancery.
De G.M. & G.	..	De Gex, Macnaghten and Gordon's Reports, Chancery.
Doug.	..	Douglas' Reports.



Drew.	..	Drewry's Reports, Chancery.
Drew. & Sm.	..	Drewry and Smale's Reports, Chancery.
E. & B.	..	Ellis and Blackburn's Reports, Q.B.
E. & E. (Ell. & Ell.)	..	Ellis and Ellis's Reports, Q.B.
E.R.	..	English Reports.
Eq. Rep.	..	Equity Reports.
F. & F.	..	Foster and Finlason's Reports.
Giff.	..	Gifford's Reports, Chancery.
H. & M.	..	Hemming and Miller's Reports, Chancery.
H.L.C.	..	House of Lords Cases.
Hoff.	..	Hoffman (New York).
How. App. Cas.	..	Howard's Appeal Cases (New York).
Hyde.	..	Hyde's Reports, (Bengal).
I.C.	..	Indian Cases.
I.L.R.	..	Indian Law Reports, (Allahabad, Bombay, Calcutta, Lahore, Madras, Patna, Rangoon, etc.).
Ir.Ch.R.	..	Irish Chancery Reports.
Ir.R. (Ir.L.R.)	..	Irish Law Reports.
J.P.	..	Justice of the Peace.
Jac. & W.	..	Jacob and Walker's Reports, Chancery.
John.	..	Johnson's Reports, Chancery.
John. & Hem.	..	Johnson & Hemming's Reports, Chancery.
Jur.	..	The Jurist Reports.
Jur.N.S.	..	Jurist, New Series.
K. & J.	..	Kay and Johnson's Reports, Chancery.
K.B.	..	Law Reports, King's Bench Division, 1901—
Keen	..	Keen's Reports, Rolls Court.
L.B.R.	..	Lower Burma Rulings.
L.J.C.P.	..	Law Journal, Common Pleas.
L.J.Ch.	..	Law Journal, Chancery, 1831, (current series).
L.J.K.B.	..	Law Journal, King's Bench.
L.J.M.C.	..	Law Journal, Magistrates' Cases.
L.J.P.C.	..	Law Journal, Privy Council.
L.J.Q.B.	..	Law Journal, Queen's Bench.
L.R.C.P.	..	Law Reports, Common Pleas Cases.
L.R.Ch.	..	Law Reports, Chancery Appeal Cases.
L.R.Eq.	..	Law Reports, Equity Cases.
L.R.H.L.	..	Law Reports, House of Lords, 1866-1875.
L.R.Ir.	..	Law Reports, (Ireland).
L.R.Q.B.	..	Law Reports, Queen's Bench Cases.
L.T.	..	Law Times Reports.
L.T. (Journal).	..	Law Times Notes of Unreported Cases.
L.T. (N.S.)	..	Law Times Reports, New Series.
L.T. (O.S.)	..	Law Times Reports, Old Series.
Lah.	..	Indian Law Reports, Lahore series.
Leg. Obs.	..	Legal Observer.
M.L.J.	..	Madras Law Journal.
M.H.C.	..	Madras High Court Reports.
Mac. & G.	..	Macnaghten and Gordon's Reports, Chancery.
Mad.	..	I.L.R., Madras Series.
Madd.	..	Maddock's Reports, Chancery.
M.W.N.	..	Madras Weekly Notes.
Man. & G.	..	Manning and Granger's Reports, C.P.
Mer.	..	Merivale's Reports, Chancery.

Mod.	..	Modern Reports.
Mont. D. & De G.	..	Montague, Deacon, and De Gex's Reports.
Moore. Ind. App.	..	Moore's Indian Appeal Cases, Privy Council.
My. & Cr.	..	Mylne and Craig's Reports, Chancery.
N.L.R.	..	Nagpur Law Reports.
N.R.	..	New Reports.
Nagpur.	..	I.L.R. Nagpur series.
O.W.N.	..	Oudh Weekly Notes.
Ph.	..	Phillips's Reports.
P.L.R.	..	Punjab Law Reporter.
P.R.	..	Punjab Record.
P.W.R.	..	Punjab Weekly Reporter.
Q.B.	..	Law Reports, Queen's Bench, 1891—
Q.B.D.	..	Law Reports, Queen's Bench Division, (1875-1890).
R.P.C.	..	Reports of Patent, Design and Trade Mark Cases.
Rang. (R.)	..	Indian Law Reports, Rangoon Series.
Rettie Ct. Sess. Cas.	..	Rettie Court of Session Cases (Scotland), 4th series.
Russ.	..	Russell's Reports, Chancery.
S.L.R.	..	Sind Law Reporter.
Scot. L. Rep.	..	Scottish Law Reporter.
Scot.L.T.	..	Scottish Law Times.
Seb. Dig.	..	Sebastian's Digest of Cases of Trade Mark, etc.
Sim.	..	Simons' Reports, Chancery.
Sol.J.	..	Solicitors' Journal, 1856—(Current).
Swanst.	..	Swanston's Reports, Chancery.
T.L.R.	..	Times Law Reports, 1884—(Current).
Ves.	..	Vesey's Reports, Chancery.
Weir.	..	Weir's Criminal Rulings.
W.N.	..	Weekly Notes (Law Reports).
W.R.	..	Sutherland's Weekly Reporter.
W.R.Cr.	..	Sutherland's Weekly Reporter, Criminal Cases.



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## ERRATA.

### PAGE

41, line 5, *for* " Key " *read* " Kay ".

151, footnote 20, *for* "Hennessy & Co." *read* "Payton & Co., Ld."

264, footnote 16, *for* " Titus, Ward & Co." *read* " Snelling,  
Lampard & Co., Ld."

353, line 1, *delete* " the delivery of the goods for."

416, footnote 20, *after* " under " *add* " exception (1) or ".

464, after the last line *add* " chandise they are not or that they  
belong to a person to whom they ".



# THE LAW OF TRADE AND MERCHANDISE MARKS IN INDIA

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## CHAPTER I.

### HISTORICAL.

There is at present no statute law in India for the registration of trade marks. The question of enacting a Trade Marks Act has been engaging the attention of both British and Indian merchants for over half a century and several attempts were made in the past by the Government of India to provide such a measure. But these attempts have not so far succeeded, as there was not forthcoming till recently that general consensus of opinion among the various commercial bodies in India, which Government regarded as an essential condition for their embarking on legislation affecting commercial interests. With the growth of India's trade and industries the need for a Registration Act has now become almost imperative. The question of the enactment of such a legislative measure has of late begun to exercise the mind of the commercial community in India more vigorously than ever; and commercial opinion is now unanimous that legislation cannot be postponed any longer. One may, therefore, look forward to the introduction of a Trade Marks Registration Bill in the near future. In this connection, it may prove to be of interest, and perhaps of some value, to review the history of the attempts made in the past to secure such legislation and to clarify the various issues connected with this somewhat complicated problem. The first few Chapters are accordingly devoted to this topic.

**Trade Marks Bill of 1879.**—The first demand for legislation for registration of trade marks in India was made in April, 1877, by the Bombay Mill Owners' Association, who approached the Government of Bombay with a request for the introduction, into the local Legislative Council, of a bill on the lines of the English

Act (The Trade Marks Registration Act, 1875). The request was supported by the Bombay Chamber of Commerce, in whose opinion the growing Indian industries, especially the cotton manufactures of Bombay, needed the protection of such legislation. The Bombay Government, considering that any legislation in this direction should apply to the whole of India, placed the matter before the Government of India, who accordingly introduced a Bill<sup>1</sup> in the Imperial Legislative Council and circulated it for opinion. The Bill sought to provide that after a certain date no suit for infringement of trade marks could be instituted in the Courts unless such marks had already been registered; this was not, however, to affect the trade marks already in use before the date of the Act. The Bill further required that all marks, Indian and English, should be registered in India and that no special privilege should attach to marks registered in England.

The Bill was referred in due course to a Select Committee, who found that opinion was divided on the one important question, whether trade marks already registered in England should be registered afresh in India. The Bengal Chamber of Commerce was of opinion that the proposed measure should apply only to Indian products; but this view was open to the grave objection that the position of a very large number of trade marks would still remain as unsatisfactory as before. The other Chambers of Commerce were also opposed to the proposal.<sup>2</sup> The Bombay Chamber accordingly suggested the registration in India of all trade marks. English opinion also favoured this view. Another suggestion was that the Indian register should automatically recognise trade marks registered in England; this could not be accepted by the Select Committee, as according to them it would create legal difficulties in determining the rights of ownership in cases where the same mark might be owned by one person in India and by another in England. After a careful consideration of these and other suggestions, the Committee recommended as a practicable course that every trade mark registered in India should have superadded to it some distinctive inscription of such a nature as to strike the eye at first glance, *e.g.*, "Indian Mark."

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(1) Draft Bill No. 1 to be called "The Indian Trade Marks Act, 1879".

(2) It may be remarked that the Bengal Chamber also, have lately modified their view, *see* Mr. G. L. Winterbotham's speech in moving the resolution on Trade Marks at the annual meeting of the Associated Chamber of Commerce on the 9th January, 1933.

**Bill of 1880.**—As a result of this recommendation the original Bill was withdrawn and a fresh Bill ("The Indian Trade Marks Act of 1880") was introduced. This Bill also was circulated; but it met with some opposition. The solution proposed by the Select Committee, namely, superadding some distinctive inscription to marks registered in India, had failed to commend itself to most of the authorities consulted, as, apart from technical difficulties and expenses involved, the distinctive device to be added to the mark might sometimes, in the case of a well-known Indian mark, so completely destroy the identity of the mark as to deprive it of most of its value to the owner. On the other hand, in some cases where an Indian manufacturer adopted a well-known English mark with the device or inscription super-added, it might so little affect the appearance of the mark that the injury done to the English owner would scarcely be less than if his mark were used without the addition. In the face of these objections the Select Committee had ultimately to restore the Bill to its original form providing for the registration in India of both Indian and foreign marks;<sup>3</sup> but the Committee favoured the adoption of a scheme for the registration of Indian marks in England. This suggestion, however, met with severe opposition and the Bill was, therefore, abandoned.

**India and the International Convention.**—In 1884, the Secretary of State addressed the Government of India on the question of India joining the International Convention for the Protection of Industrial Property. The Government of India replied that, as adherence to the Convention would involve legislation for registration of Trade Marks, and as the Government did not consider such a measure expedient at that time, they were averse to India's accession to the Convention.<sup>4</sup>

**Patents Act, 1888.**—The matter came up again in connection with the passing of the Patents and Designs Act of 1888. It was proposed to incorporate in this Bill the provisions of the English Act for the registration and protection of trade marks. The proposal was supported by public opinion in England,<sup>5</sup> but, as there was some opposition in India, Government ultimately withdrew from the Bill the clauses relating to the registration of trade marks.

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(3) The Committee stated that this course was recommended by several of the authorities including the Commissioner of Patents and Trade Marks, London.

(4) An enquiry as to whether the Government of India would reconsider their position in respect of Industrial Property Convention was made in 1901 by the Secretary of State (Lord George Hamilton).

(5) *Vide* Trans. Inst. Pat. Agents, V. p. 66.



**Trade Marks Registers at Customs Houses.**—With a view to facilitate the work of Customs Officers in seizing and detaining goods bearing fraudulent trade marks, Mr. O'Connor suggested in 1891 that a register might advantageously be opened in all the principal Customs Houses of India, and provisions made for the registration of trade marks by any merchant who might choose to do so. This suggestion was referred to Local Governments and the commercial community for opinion. The Bengal, Bombay and Karachi Chambers of Commerce strongly objected to the proposal, which did not, therefore, receive any further attention. Mr. O'Connor's suggestion was, however, given a trial in November, 1895, at Calcutta by the then Collector of Customs, Mr. Skrine, who, on his own responsibility, undertook the registration of Indian and foreign trade marks for a nominal fee. Considerable publicity was given to the scheme in England and in India. It was hoped that imported goods bearing imitations of marks already on the above register would be stopped at the port. But it was soon discovered that this could not be effected as the appraisers were unable to remember the various registered trade marks. This led to the discontinuance of the register. A similar register introduced at the Madras Customs House in 1896 had also to be abandoned after a short trial.

**Trade Marks not registrable under the Inventions and Designs Act.**—Although legislation for registration had been abandoned, applications continued to be received by Government for the registration of trade marks as designs under Part II of the Inventions and Designs Act of 1888. The Advocate General of Bengal, whose advice was sought by the Government, gave his opinion that trade marks were not designs and were, therefore, not capable of registration under this Act. In view of the large number of applications, notifications to this effect had to be issued not only in all the Government Gazettes but also in some of the important newspapers.

**Memorandum of the Cutlers' Company.**—In the meantime, British shippers to India had begun to feel the need for an Indian Trade Marks Act, as in their view the protection under the Common Law was inadequate. The state of things in India was precisely the same as obtained in England previous to the Act of 1875, *viz.*, that in every trade mark case brought before the Indian courts the proprietor of the mark had to go through the old and very expensive process of proving his title to the mark, instead of merely having

to produce a certificate of registration. The Cutlers' Company, Sheffield, therefore, prayed for the constitution of a trade marks office in India.<sup>6</sup> The India Office pointed out to the Board of Trade that, if registration were introduced in India, all English marks would have to be re-registered in India, as was the case in the Colonies, and asked the Board whether commercial opinion in England would be agreeable to such a Bill. On enquiry, it was found that, with the exception of the Manchester Chamber of Commerce, all the other Chambers of Commerce in England would welcome such a measure. The Government of India were then approached, who in their turn consulted the Local Governments and the Chambers of Commerce in India. The majority of Local Governments, while recognising the benefits of legislation, did not consider the time ripe for such a measure, whereas the commercial community generally favoured the introduction of the measure. Even those who opposed legislation stated that they would have no objection to an Act, if registration was restricted to trade marks of Indian manufacturers, imported goods being excluded from its scope or if cotton marks were excluded from the scope of the Act. But, as neither of these suggestions was acceptable to Government, no further action was taken.

**Representations from the Association of Chambers of Commerce of United Kingdom and from the London Chamber of Commerce.**—Meanwhile, the Association of Chambers of Commerce of the United Kingdom pressed on the Secretary of State the need for immediate legislation, pointing out that the consensus of opinion of the civilised world was in favour of trade marks legislation and that "there was really no valid reason why the Indian Empire should stand in isolation from the rest of the world in this matter." They further suggested that the cotton marks may, if necessary, be excluded from the operation of the legislation. About the same time the London Chamber of Commerce also wrote<sup>7</sup> to the Secretary of State pressing for legislation for registration of trade marks in India. They pointed out that "German, Austrian and Italian infringements of English marks were able to permeate the Indian market without the slightest protection for the original mark holders, except the Merchandise Marks Act or a costly suit at Common Law", and said that "whatever reasons, if any, existed

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(6) Letter, dated 8th February, 1902. *See also* rejoinder No. 67, dated 28th April, 1905.

(7) Letter, dated 4th January, 1905.

years ago for not establishing an adequate trade marks law in India and Burma do not exist to-day, and there is a general consensus of opinion that a Trade Marks Bill upon English lines should be at once introduced into India''.

**Second Memorial from the Association of Chambers of Commerce, United Kingdom.**—The subject was broached for the second time by the Association of the Chambers of Commerce in their Memorial dated the 24th May, 1906, which was forwarded to the Government of India by the Secretary of State. Lord Minto's Government in their reply dated the 9th August, 1906, stated that the question of legislation depended upon a change of public opinion in India and that no such change had taken place since their previous despatch on the subject to the Secretary of State.

**Private registers opened by Chambers of Commerce.**—About this time a system of private registration was inaugurated by the Bombay Mill Owners' Association. The Register was opened in 1903 and registration was undertaken only in respect of trade marks for cotton goods of Indian manufacture, the imported goods being left out.<sup>8</sup> The Madras Chamber, who had all along opposed legislation had also by this time opened a trade marks register of their own. The Upper India Chamber of Commerce followed suit in 1907 with a similar register and gave greater publicity to their action by inviting traders in general who might desire to avail themselves of the opportunity, to register their trade marks in their register.<sup>9</sup>

**Third Memorial from the Association of Chambers of Commerce, United Kingdom.**—In 1908, still another attempt was made by the Association of the Chambers of Commerce, United Kingdom, to reopen the question. In reiterating their original demand they pointed out that the commercial community in India were "rapidly coming round to the view that registration would be a beneficial thing", and said: "Practically all the countries in the world have now established systems of trade mark registration, and there does not appear to be any reason why the Indian Empire should be an exception, especially as infringements of trade marks are very frequently committed in India, and no doubt, trade mark registration there would stop to a very large extent, this reprehensible practice."<sup>10</sup> The Government of India again consulted Local

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(8) For a history of this register, see next Chapter.

(9) See for instance "The Pioneer", November 4, 1907.

(10) Memorial, dated 19th October, 1908, to the Secretary of State.

Governments and Chambers of Commerce but such opinion as was received showed that there was still some opposition to legislation, though the supporters were distinctly on the increase. Among these the Upper India Chamber of Commerce deserves to be particularly mentioned. Encouraged by the large measure of success which attended their private register, they were now very enthusiastic about legislation for registration.

**Industrial Property Convention.**—In 1922, the League of Nations, dealing with the question of protection of legitimate commerce, condemned “unfair competition”, and recommended *inter alia* that such of the State members of the League as were not already members of the Industrial Property Convention should take steps to adhere to it. Expert opinion in England<sup>11</sup> as well as in India supported the proposal for joining the Convention; but the absence of legislation for trade marks registration was an obvious obstacle.

**Patents and Designs Bill, 1930.**—The question was re-opened in connection with the passage of the Indian Patents and Designs (Amendment) Bill, in 1930, in the Indian Legislative Assembly. The Select Committee urged upon the Government the desirability of India becoming a member of the International Convention for the Protection of Industrial Property. Sir Purshottamdas Thakurdas in supporting the Bill in the Assembly (27th January, 1930) briefly referred to the history of the subject and said that the absence of legislation for registration of trade marks in India was militating against India being a party to the International Convention. He pleaded strongly for the early introduction of legislation for registration of trade marks and requested the Government of India to take the steps necessary to enable India to join the Convention. The Hon'ble Sir George Rainy, Member for Commerce and Railways, replying on behalf of Government, declared that a copy of the resolution passed by the Federation of Industrial and Commercial Congress urging trade mark legislation had been received and that Government had asked for further particulars from the Federation. He assured the House that the question would be reconsidered if the Government of India were convinced that commercial opinion was in favour of such legislation.

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(11) The Comptroller of Patents and Designs, London, (Mr. Temple Franks) also addressed the Government of India recommending introduction of legislation for registration of trade marks.

**Alleged piracy by Japanese manufacturers.**—In the growth of support for trade marks legislation in India, particular mention may be made of the serious allegation of piracy on an unprecedentedly large scale, against Japan, not only of recent Indian, but also of well established English, marks. The Calcutta piece-goods traders and the Manchester Chamber of Commerce have openly alleged that the Japanese have been copying British trade marks and labels on their goods, and that several infringements of a serious nature have been brought to their notice. The Secretary for Overseas Trade, speaking in the House of Commons on the 9th November, 1932, referred to the widely prevalent practice in India of passing off spurious goods of foreign manufacture for English goods by the fraudulent use of well-known British trade marks, and added that protests against such practice had been duly conveyed to the Japanese and other Governments. On account of such fraudulent copying of British trade marks, it is said, Lancashire alone is losing thousands of pounds every year. The protection offered by the Common Law has not apparently been of much avail in actual practice. As Mr. Rhodier, the Chairman of the India Committee of the Manchester Chamber, stated recently, in the absence of legislation for registration, the legal protection (under Common Law) of trade marks in India was bound to be extremely complicated,<sup>12</sup> and this opinion has been independently affirmed by Sir Edward Rhodes.<sup>13</sup>

**Conference of the Associated Chambers of Commerce, 1933.**—The Associated Chambers of Commerce at their conference held in January, 1933, passed the following resolution:—

“That in the opinion of this Association the commercial circumstances and the conditions of the present time require the enactment of legislation to provide for the registration of trade marks in India in such a manner as will give the registered user of any mark the right to an immediate injunction preventing the use of such mark or any colourable imitation thereof by others, subject only to proof of prior usage by the defendant in any dispute.”

After referring to the altered conditions in India which necessitate the early introduction of a Trade Marks Act, Mr. Winterbotham who moved the resolution said: “Almost every other country of industrial importance in the world makes legislative provision for the registration of trade marks and the increasing number of

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(12) “The Statesman”, 29th October, 1932.

(13) Loc. cit.

references received on the subject by the Bombay Chamber go to show the need for similar legislation in India". The resolution was enthusiastically supported by Mr. A. L. Carnegie on behalf of the Upper India Chamber of Commerce, who said that his Chamber had, since 1905, consistently pressed for the enactment of legislation for the registration of trade marks and that with the development of industry in India it was becoming more and more necessary that manufacturers should be effectively protected in the use of their valuable trade marks. The terms of the above resolution were duly communicated to the Government of India, who replied<sup>14</sup> to the effect that the matter was receiving the consideration of the Government of India, and that a further communication would be sent to the Association as soon as decision was reached. Meanwhile, replying in the House of Commons to Mr. Patrick Joseph Hannon, Sir Samuel Hoare, Secretary of State for India, said that the Government of India would, doubtless, give due weight to the demand by the commercial bodies in India for legislation for the registration of trade marks, and added that he had much sympathy with the suggestion and realised the importance of the matter to manufacturers in England.<sup>15</sup>

#### **Demand by the Indian commercial bodies for legislation.—**

As early as December, 1927, the Indian Industrial and Commercial Congress passed the following resolution in their session held at Madras:—

"This Congress recommends to the Government of India that it is desirable in the interests of Indian trade and industries to introduce at an early date legislation for the registration of Trade Marks in India, in the absence of which Indian merchants are put to considerable hardship both in India and abroad, and India is unable to join the International Convention for the Protection of Industrial Property."

The Indian Press also has since been evincing no small interest in the matter.<sup>16</sup> Indian legislators have begun to feel their responsibility in the matter; and interpellations from Messrs. S. C. Mitra and Vidyasagar Pandya elicited from the Hon'ble Sir Joseph Bore the reply that the question was engaging the attention of the Govern-

(14) Letter, dated 4th October, 1933.

(15) "The Statesman", 2nd May, 1932.

(16) See for instance, *The Indian Textile Journal*, October, 1928; *Capital*, January, 1929; *Times of India*, 13th January, 1934 and 4th January, 1935; *Statesman*, 1st and 3rd November, 1932; *Forward*, 8th and 20th October, 1933 and 3rd December, 1933; *Liberty*, 17th November, 1932; *The Whip*, 5th January and 19th March, 1935.

ment of India.<sup>17</sup> The more important Chambers of Commerce have also from time to time addressed the Government on this subject. Mention may, for instance, be made of the memorandum pleading strongly for legislation submitted to Government by the Bengal National Chamber of Commerce in December, 1933. The commercial community in India is undergoing a growing disillusionment about the efficacy of the Common Law for protecting trade marks. And, with the growth of numerous minor industries and the diversification of the products of major industries it can hardly be gainsaid that the need for a Trade Marks Act has now become more insistent than ever before.

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(17) Legislative Assembly Debates, 1st December, 1933, Vol. VIII, No. 9, Official Report.

## CHAPTER II.

### CASE FOR TRADE MARKS LEGISLATION IN INDIA.

In the absence of statutory legislation for registration of trade marks, an action for infringement of a mark lies in India either under the Merchandise Marks Act or under the Common Law of the land. A person whose trade mark has been infringed can get relief in the Civil Court by an action for passing-off, and can also file a criminal complaint against the wrong-doer under the Merchandise Marks Act. In either case, the onus of proof of rightful ownership of the mark naturally lies on the plaintiff. There is a mistaken opinion, more or less generally held by the commercial community in India, that a registration of declaration of ownership under the Registration Act of 1908 would constitute a legal proof of ownership. Prompted by this belief there is a tendency among merchants and manufacturers to register such declarations under the Indian Registration Act. This chapter will deal in some detail with such registrations, particularly in regard to their legal value for establishing one's title.

**Legal value of registration under Act XVI of 1908.**—It is unfortunate that the real value of the registration under the Indian Registration Act of a declaration of ownership of a trade mark has not been clearly understood by the commercial public in this country. Many of them are under the impression that such registration confers on the declarer legal rights similar to those that are conferred for instance, in England by registration of a trade mark under the Trade Marks Act. It is necessary to emphasize that, whereas in England there is a special legislation for the registration of trade marks, which registration confers *prima facie* title of ownership to the proprietor, there is no corresponding legislation in India which provides for such a registration of trade marks. The Indian Registration Act of 1908, which is availed of by the commercial public for the purposes of registration relating to trade marks provides for registration of *documents* only and not of trade marks. What can, therefore, be



registered, and is actually being registered, under this Act is not the mark itself, but merely a *declaration* of ownership;<sup>1</sup> and obviously the declaration merely represents no more than the recorded opinion of the registrant. The registration office does not naturally enquire either about the distinctiveness of the trade mark described in the declaration or the registrant's right to the mark. On the other hand, before registration of a trade mark is allowed in England, the Registrar has to satisfy himself about the applicant's title to the mark and about the novelty of the mark. In order to secure these ends a systematic search is made in the Trade Marks Register to ensure that the mark proposed to be registered has not been already anticipated, and the mark is advertised before registration so as to give an opportunity to any member of the public who has reasons to do so to oppose the registration. Naturally, it is insisted in England that the trade mark, for which registration is sought, must be distinctive. None of these precautions is, however, taken when a declaration of ownership is registered in India. In the first place, even the registrant is not in a position to satisfy himself that he has not been anticipated regarding the mark, by any prior registration in the Registration Office, since he has no right of access to the record of previous registrations and there is no provision entitling him to information from the office regarding prior registration.<sup>2</sup> It may be noted that, even if one is allowed access to the Register, it will be impossible to make any proper search as the marks described in the declarations are never classified and indexed, and as documents relating to other than trade marks are also entered in the same register<sup>3</sup> (Miscellaneous Register, Book No. 4.). The impracticability of maintaining such a classified list of trade marks will be apparent when one considers further that there are thousands of registration offices all over the country and declarations of ownership of trade marks can be registered in any one of them. In the existing conditions, it is, therefore, not impossible for one to

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(1) The procedure adopted for the registration of a declaration of ownership of a trade mark under the Indian Registration Act is the same as for the registration of any other document. The declaration is made on Rs. 2 stamped paper and is signed before two witnesses. Two copies of the mark with full description are submitted along with the declaration. Particulars regarding period of previous use of the mark and registration in foreign countries, if any, are generally, given in the declaration. A further fee of Rs. 2 is charged for registration.

(2) See Section 57 (3) of the Act.

(3) Vide Section 51-B (3) of the Act.

register a false declaration of ownership for even well-established trade marks without the knowledge of the rightful owners of such marks. In fact, such false declarations are not unknown. In the circumstances the question of the mark satisfying conditions like distinctiveness before it is registered, does not naturally ever arise in connection with the registration of such declarations.

That the registration of declaration of ownership of a trade mark does not constitute proof of title to it has been repeatedly emphasised by the courts. For instance, in *The Swadeshi Mills Co. v. Juggilal Kamalapat Cotton Spinning and Weaving Mills, Co., Ltd.*,<sup>4</sup> Mears, C. J., observed: "It appears that the defendant firm 'registered' their label in Calcutta under Registration Act No. 16 of 1908. That Act relates to registration of documents alone and has nothing to do with the registration of trade marks. We hold, therefore, that the registration had no legal validity or effect" for establishing title to the mark.<sup>5</sup> Registration under the Act of 1908 can, of course, authenticate the fact of the declaration by the registrant independent of the correctness or otherwise of the subject matter of the declaration and to that extent may serve as secondary evidence in certain cases.<sup>6</sup>

**Registration with Chambers of Commerce.**—Besides "registration" under the Act of 1908 merchants often 'register' their marks in the Trade Marks Registers maintained by the Upper India Chamber of Commerce at Cawnpore, the Madras Chamber of Commerce and the Bombay Mill Owners' Association. The history of the inauguration of these registers has already been dealt with in Chapter I. It has only to be pointed out that such 'registration' has even less legal value and confers even less legal protection to the registrant than a similar registration under the Indian Registration Act. The public are in this case also often misled and are put to unnecessary expense. What is lacking in these systems of registration is the element of publicity,<sup>7</sup> which

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(4) A.I.R. 1927 All. 81: 49 All. 92: 24 A.L.J. 975. See also *Hafizulla Hamidulla v. Sk. Papa*, A.I.R. 1933 Nag. 344.

(5) A declaration of ownership of a trade mark under the Indian Registration Act is not regarded as equivalent to a certificate of registration of the mark by Trade Mark offices in those foreign countries where a certificate of registration in the country of origin is a condition precedent to registration, or in England and Dominions for the purposes of allowing priority rights in the case of Indian applicants.

(6) *Moolji Sicca & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678.

(7) Certain safeguards are, however, provided in the system of registration by the Bombay Mill Owner's Association. It appears that

is so essential for ascertaining the rights of the declared owner to the mark in question. The dangers of such registration were exposed in the recent Madras case *Hussain Meah Sahib v. Abdul Rahim Sahib*<sup>8</sup> where the plaintiff after registering in his name with the Madras Chamber of Commerce a trade mark which was already being used by the defendant and to which the defendant had the right of a prior user, applied for an injunction to restrain the prior user himself from using the mark on his own beedies. The need for some provision, whereby the public may be acquainted with a person's claims to a trade mark, cannot be over-emphasised; for it will provide an opportunity to challenge the claimant's position. Any person, who desires to do so, should be enabled to oppose the registration of any mark and set the matter at rest. In the absence of such provision no system of registration can be of any practical value.

**Conflict of registration.**—Besides 'registrations' as described above, declaration of ownership can also be made before the Presidency Magistrate. The existence of a multitude of registers often results in a conflict of registrations.<sup>9</sup>

**Announcements in newspapers.**—'Registrations' as above described are usually followed up by public announcements in newspapers declaring the person's ownership of the mark and sometimes warning others against infringement. Even among those who realise that their 'registrations' are not of any help in establishing title to the mark, there are many who seem to

registration was first introduced by this Association as early as 1886. The process adopted during the first years of its inception appears to have been comparatively simple as registration was regarded as only optional. Since 1903, however, every member of the Association has been required to enter in this Register all marks used by him in the trade. Any member desiring to register a mark is required to submit a sufficient number of copies which are then circulated to all the members of the Association. If any member finds that the trade mark concerned is an infringement of a previous mark registered by him, he lodges a formal objection. The matter is then decided by arbitration by two independent members of the Association. In the event of their disagreement the case is submitted to a third member whose verdict is binding. It appears that the last revision took place in 1923 when a number of marks which had not been in use for a long time were removed from the Register. It is estimated that about 2000 marks are now on this Register.

(8) A.I.E. 1931 Mad. 326.

(9) See for instance: *British American Tobacco Co., Ltd. v. Mahboob Buksh*, 15 C.W.N. 280: 38 Cal. 110: 7 I.C. 279.

believe that these announcements constitute proof of use and, therefore, of ownership. This view is clearly incorrect, as such announcements can establish only the intention of the plaintiff to use the mark and it is well settled under the Common Law that a mere intention to use a trade mark does not confer title to the mark.<sup>10</sup> For instance in the early case of *Maxwell v. Hogg*,<sup>11</sup> Lord Justice Cairns observed:—"I am prepared to hold, without hesitation that the mere intention, and the declaration of the intention, to use a name will not create any property in that name, and to hold also that there can be no protection in this court for the intended name during the course of manufacture of the article which is to bear that name".

**Legal claim to title.**—It is thus clear that registrations of declarations of ownership under the Indian Registration Act or in the registers of some commercial bodies or public announcements of such declarations in newspapers are not of any material assistance to a trade mark owner in India in establishing his title to the mark before the courts, and that it is the exclusive prior user alone which can confer such title. It is, however, often difficult and expensive for the plaintiff to adduce evidence of such exclusive prior use, in order to establish his title to the mark. What is wanted is a machinery by which the owner of a trade mark can establish his title without being put to the necessity of proving the fact of prior usage. Such machinery is provided in England and other foreign countries by legislation for registration of trade marks. It will be seen from the preceding Chapter that the various attempts made in the past for enacting a Trade Marks Act in India were unsuccessful owing to lack of sufficient response from the commercial communities, who evidently did not fully appreciate the importance of such legislation. It will, therefore, be useful at this stage to consider dispassionately and at some length the various issues that had been raised before and on which absolute unanimity of opinion had been lacking.

**Objections against legislation classified.**—The objections that have been raised and the fears expressed from time to time

(10) This principle of law is embodied in Section 37 of the English Act which provides for the removal of a registered mark on the ground of non-user. See also *Batt & Co.'s Tm.* (No. 2), 15 R.P.C. 262. 534; 16 R.P.C. 411; *James Crean & Son, Ltd.'s Tm.*, 38 R.P.C. 155; *Ducker's Tm.*, 45 R.P.C. at pp. 400-401.

(11) (1867) L.R. 2 Ch. App. 307; 36 L.J.Ch. 433; Seb. Dig. p. 156.

in respect of trade mark legislation in this country may be briefly summarised as follows:—

(1) The existing law is sufficiently comprehensive to afford adequate protection to trade marks.

(2) If an Indian Act is passed on the lines of the English Trade Marks Act unregistered marks would lose the protection which they now enjoy.

(3) A Trade Marks Office would not be self-supporting and would involve additional burden on the tax-payer.

(4) The commercial community is opposed to legislation.

(5) The cotton marks do not require the protection of new legislation.

The objections may be considered *seriatim*.

**Is existing legal protection adequate?**—It has often been stated, that the existing law is adequate to protect owners of trade marks against piracy of their marks and that therefore there is no need for a Trade Marks Act. It is also said that while in England the main difficulty is concerned with proof of ownership and registration facilitates proof of title, in India, the ownership of a mark is seldom in dispute and the question generally at issue is whether a particular mark is or is not a colourable imitation of the plaintiff's mark. An examination of the trade mark cases in India will hardly bear out this contention. As those who are familiar with the reported cases know, the very first issue that is generally raised in most of the trade mark cases in India refers to the plaintiff's exclusive title to the mark. This has happened even in the case of several well-known trade marks. Those who are acquainted with these cases can have no doubt about the difficulty of proving exclusive user, and, therefore, of the inadequacy of the protection of the Common Law. It can now be easily understood how England and the United States outgrew the stage of reliance on the Common Law and resorted to specific legislation on trade marks.

The Merchandise Marks Act is no less unsatisfactory as protection for trade marks. In the first place, it gives only a right to proceed criminally against the infringer and does not provide the means either of realising damages or of preventing by injunction the continuance of the fraudulent practice. Thus both as cure and as preventive, it is thoroughly useless. The position is very clearly stated in the following passage from an address by

Lord Moulton:<sup>12</sup> "I thoroughly object to trusting to our criminal legislation for the purpose of giving a real and constant protection to trade. Penalties are utterly inefficient for the purpose of preventing bad practices. It is infinitely better to be able to call in the assistance of a Civil Court and get an injunction preventing a bad practice being continued. There are many people who would willingly pay a penalty for something nefarious once a fortnight; they would probably earn it in an hour or two next day. It is very much better to have the power of getting an injunction which nobody in England dare disobey. And, therefore, I am glad that these marks, which have a special value as indicating the origin, or shall I say, as proving some inspection of the goods, should no longer be obliged to trust to the very inefficient protection of the Merchandise Marks Act, and can now be defended in our Civil Courts. They are administered by a much more highly trained body of men, and I think that those who know the practice of the two Courts will agree that the protection is likely to be much more efficient." The passage quoted above contemplates a person seeking redress under the Merchandise Marks Act in England where he can readily establish his *prima facie* title by production of a certificate of registration of the mark. A person seeking redress under the Indian Merchandise Marks Act, is naturally under even greater disability since he has *de novo* to establish his title to the mark.<sup>13</sup> This involves costly legal proceedings and even more costly delay. Where, for instance, there is some doubt regarding the complainant's title, he is asked to have his claim settled first in a Civil Court.<sup>14</sup> The speedy relief, which the criminal law aims at giving, is thus not in practice available in India. Further, the owner of an Indian trade mark is at a disadvantage compared with the owner of a foreign trade mark who can readily establish his title for the purposes of taking action under the Indian Merchandise Marks Act by the mere production of a certificate of registration in his home country.<sup>15</sup>

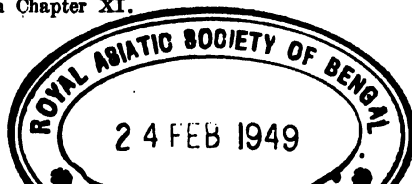
As regards foreign goods bearing counterfeit marks, it is often asserted that the Sea Customs Act serves all the requirements of the merchants for the protection of their marks. This is not borne out

(12) Trans. Inst. Pat. Agents 24, p. 43 (1905).

(13) *Anookool Chunder Nundy v. Queen-Empress*, 27 Cal. 776.

(14) *Emperor v. Bakaulah Mallik*, 31 Cal. 411; 8 C.W.N. 307, 1 Cr.L.J. 140; *Dowlat Ram v. King-Emperor*, 32 Cal. 431; 2 Cr.L.J. 326; *Surja Prasad v. Mohabir Prasad Tribedy*, (1906) 11 C.W.N. 887.

(15) See discussion under S. 478, I.P.C., in Chapter XI.



by the provisions of this Act. Here again, the question of ownership is important. The Collector of Customs will not on his own initiative ordinarily detain goods with counterfeit trade marks. The aggrieved party will have to furnish in every case an indemnity bond and immediately institute legal proceedings. The burden of justification for detention of the goods is thus thrown entirely on the complainant.

**Will unregistered marks suffer by legislation?**—A fear was expressed some years ago by a section of the commercial community that, if legislation were enacted in India on the model of the English Trade Marks Act, the protection now enjoyed by the unregistered trade marks in India might cease. There is, in fact, absolutely, no basis for this fear. It is well-known that the enactment of the Trade Marks Act in England did not in any way affect the remedies which were already available to a trade mark owner under the Common Law. While registration under the Act is a condition precedent to an action for infringement under the Act,<sup>16</sup> the right to a passing-off action under the Common Law is always available to a trade mark owner whose rights have been infringed, irrespective of whether the mark has been registered or not. Indeed, there have been many instances where, although the registration was held by the Court to be invalid under the Trade Marks Act and the mark was consequently ordered to be removed from the Trade Marks Register, the plaintiff was still successful in a passing-off action. We need only refer here to the well-known “Yorkshire Relish”<sup>17</sup> and the “Stone Ale”<sup>18</sup> cases as typical instances where this right at Common Law was expressly affirmed by the Courts.

*Section 45 of the Act of 1905* expressly lays down.—“Nothing in this Act contained shall be deemed to affect rights of action against any person for passing-off goods as those of another person or the remedies in respect thereof”. A trader may still acquire in England right to a trade mark by user. The effect of legislation is not to provide that no one shall have a trade mark unless it is registered in accordance with the Act, but only that a person using such an unregistered trade mark shall not be entitled to an action for infringement as provided under the Trade Marks Act. The proprietor of an unregistered mark is still entitled to an action for

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(16) *Vide* S. 42, Appendix III.

(17) *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, 2 Ch. 54; (1897) A.C. 710; 12 R.P.C. 496; 13 R.P.C. 235; 14 R.P.C. 720.

(18) *Montgomery v. Thompson*, (1891) A.C. 217, 8 R.P.C. 361.

passing-off; and the right of action which he had hitherto enjoyed is, therefore, not affected in the least. Nor is any new species of property created by registration under the Act. Registration merely gives the proprietor a statutory title in respect of his mark to the same rights, which, before the Act of 1875, he could have obtained only by proving that the mark had become his trade mark. "Where does the Patents, Designs and Trade Marks Act, 1883, confer any new right of property on the owner of a trade mark?" asks Lord Justice Romer in *Bow v. Hart*<sup>19</sup> and then goes on to say: "The Act is a statutory recognition of the law which had been previously laid down by the Court of Chancery, but it provides a better method of procedure".<sup>20</sup> It is obvious, therefore, that if the Indian Trade Marks Act be modelled on the lines of the English Statute, the rights of trade mark holders under the Common Law will not in any way be prejudicially affected.

**Will a Trade Marks Office be self-supporting?**—As regards the financial aspect of the question, there can be little doubt that a Trade Marks Office in India will, from its very start, be entirely self-supporting. In view of the commercial importance of the country the number of applications for registration of trade marks from foreign and Indian merchants would certainly be very large. Indeed, when we consider that several thousands of declarations of ownership of trade marks are now registered annually under the Act of 1908, notwithstanding the fact that such 'registration' does not confer any legal title to the mark, one can safely presume that the number of applications for registration of trade marks which may be received after the enactment of a Trade Marks Act in India would be very large, and that the revenue would be ample to maintain a Trade Marks Office.

**Is commercial opinion opposed to legislation?**—As regards commercial opinion on the question of legislation it has already been pointed out in the last Chapter that whatever reasons, if any, existed years ago against legislation do not exist now and that there is a general consensus of opinion that an Indian Trade Marks Act should be introduced without further delay. Reference has been made to the resolutions urging trade marks legislation passed by the Indian Industrial and Commercial Congress in December, 1927,

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(19) (1905) 1 K.B. 592.

(20) This passage is quoted with approval by Clauson, J., in *Champagne Heidsieck, et Cie Monopole, Societe Anonyme v. Buxton*, 47 R.P.C. 28.



and by the Associated Chamber of Commerce in January, 1933, and to the Memorandum on the subject submitted recently to Government by the Bengal National Chamber of Commerce. The increasing volume of competition and the growth of industries have convinced every section of the commercial community in India of the utter inadequacy of the legal protection under Common Law. The disabilities of traders in India under the existing law have been emphasised by Sir Edward Rhodes and Mr. Rhodier (Chairman of the India Committee of the Manchester Chamber) in connection with the alleged piracy of British marks in India.<sup>21</sup> In respect of no other question perhaps, can it be said that commercial opinion in India is at present so unanimous as in the matter of this much needed legislation.

**Do cotton marks have sufficient protection in India at present?**—From a historical standpoint, the registration of cotton marks in India is slightly in a different category from other marks. The bulk of India's foreign trade in cotton goods was till recently with Lancashire, and the trade was in the hands of a number of well established English manufacturing firms. Owing to the willing co-operation among them, and the general desire to respect one another's trade mark and to avoid dispute among themselves, there was hardly any case of trade mark piracy in this trade. In rare cases of such infringement, representations made to those responsible for the importation of the spurious goods were received and acted upon readily to rectify the position, so that rival interests could operate without undue friction. The inadequacy of the present laws to afford protection against infringement of cotton marks did not naturally arise. This explains why the earlier attempts to legislate did not meet with enthusiastic support from this section of the commercial community.

But the situation has now completely altered. Due to severe competition from other foreign manufacturers of cotton goods, particularly from Japan, Lancashire no longer enjoys the supreme position in this trade with India which she was having till recent years. Cases of unfair competition in this trade are becoming more and more frequent; and several complaints have been made regarding fraudulent infringements of well-known British marks. The natural immunity against piracy, which the English cotton marks had enjoyed all along, has now ceased to

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(21) "The Statesman", 29th October, 1932.

exist and this has justifiably caused alarm in Lancashire.<sup>22</sup> The helplessness of Lancashire in effectively securing protection to their trade marks in India under the present conditions was voiced by Mr. Rhodier, the Chairman of the India Committee of the Manchester Chamber of Commerce and by Sir Edward Rhodes. The latter is stated to have declared: "No wise man will take legal action in India, because the processes have so long been uncertain and the Japanese know that and take advantage of them."

It is not surprising, therefore, that there has been a notable change in the attitude of this trade towards legislation for registration of trade marks in India. This new point of view was clearly expressed by Mr. G. L. Winterbotham of the Bombay Chamber of Commerce. In moving the resolution on trade marks legislation (which was passed unanimously) at the annual meeting of the Associated Chamber of Commerce, he said: "The Bombay Chamber has up till last year consistently opposed any suggestion of trade mark registration, but times and circumstances change, and it is owing to changed commercial and industrial conditions that we have revised our opinion and now advocate legislation for registration of trade marks in India, on the lines of the English Act. I do not think that this question of changed condition needs any elaboration. In the past the importance of trade marks was centered mainly on import business and especially on the import trade in piecegoods from England. Moreover, the import trade was largely controlled by a number of firms with considerable experience in trade mark usage in England, who were ordinarily ready and willing to co-operate in the recognition of established marks and the avoidance of disputes. Not only have the imports from countries other than England greatly increased, but there are far more people nowadays trading and far more trade marks involved, while there has also been a substantial growth of industries in India. We make no apology, therefore, for our change of view which, we consider, that the altered conditions demand."

As regards Indian mill-owners, it may be observed that they have all along felt the need for the registration of cotton marks and have pressed for legislation. Both the Indian and British commercial interests are thus now agreed that a Trade Marks Act which includes the registration of cotton marks within its scope,

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(22) See for instance "The Statesman," dated 29th October, 1932, 1st November, 1932 and 11th November, 1932.

would be very beneficial and should be enacted early. In this connection, it may be stated that, as a very large portion of the cotton marks now used in India is owned by the Lancashire firms and as most of them may have already been registered in England, it would be convenient to review the history of the registration of cotton marks in England. An attempt in this direction is made in the next Chapter and a practical scheme is suggested to deal with the enormous number of cotton marks which may be received for registration in India immediately after the passing of a Trade Marks Act.

**Present difficulty in establishing title to the mark.**—Having disposed of the various objections that have so far been raised against legislation, we may now proceed to consider some of the various disabilities under which Indian merchants suffer in the absence of a Trade Marks Act. The inadequacy of the existing statutes such as the Merchandise Marks Act and the Sea Customs Act for affording protection against misuse of marks has already been pointed out. We shall here draw attention to the difficulties met with in obtaining remedies under the Common Law. As has already been pointed out, the plaintiff in a passing-off action has to establish his title to the mark by satisfactory and conclusive evidence. It is often necessary to call a large number of witnesses for this purpose. As regards documentary evidence, it may be observed that in this country it is usual for merchants to destroy commercial records after some years owing to the difficulty of preserving them beyond a certain period. It is, therefore, not surprising to find that even in cases where a mark had been in use for over 20 or 30 years, evidence of more than a few years' user (say 8 or 10 years) could not be often adduced. We may specially mention in this connection the difficulties of foreign merchants, many of whom, even though they possess long-established rights in their marks in this country, often find themselves in a precarious position when it comes to a question of establishing their title before the Indian Courts. The alleged piracy of British marks<sup>23</sup>

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(23) That the complaints regarding the piracy of British marks in India are not of recent origin, will be seen from the following evidence of Mr. G. J. Rodgers before the English Committee of 1862.

*Question 471.*—"Would an unlearned person in these matters discover that it was not one of your knives?—No. I do not suppose that he would".

*Question 478.*—"What nation competes with you, more particularly in Calcutta by sending out these spurious goods?—Germany."

by Japan has of late brought this question to greater prominence before the public.

**Delay and heavy cost in Trade Mark suits.**—The necessity to prove the plaintiff's title by evidence of prior usage naturally gives rise to long delays and heavy costs in trade mark suits in India, and many complaints have been made on that account. For instance, in a letter addressed sometime ago to the Secretary of State, the London Chamber of Commerce observed that trade mark owners in India have at present no relief except under the "Common Law whereby, in a cumbrous process of adducing the most expensive class of evidence, the trader is only able to obtain a measure of justice and might be nearly ruined in the process." The Chamber pointed out an instance of a "recent case where £1,000 had to be spent in connection with a mark used by an English house in India for a number of years". Again the Hon'ble Mr. M. V. Robert in moving on behalf of the Upper India Chamber of Commerce a resolution for legislation of trade marks at the meeting of the Conference of Indian and Ceylon Chambers of Commerce observed that in trade mark suits in India "delays were unreasonable, expenses excessive, and the gravity of the issue rarely understood".<sup>24</sup>

The present position is clearly analysed by Mr. Winterbotham of the Bombay Chamber of Commerce thus: "We do not deny that the existing law does provide a remedy; but our contention is that recourse to it imposes what we consider to be unfair conditions on the owner of a valuable trade mark, who has to go to a great deal of trouble and expense to prove the reputation and the prior usage of his mark against a defendant who may be, and often is, a man of straw from whom adequate damages cannot be recovered, even if the case is won. Nor is the winning of one case any guarantee that a similar case against another defendant might not have to be fought. We feel that in all ordinary circumstances the burden of proof and the expenditure of time and money should be upon the defendant." So also in the Memorandum dated the 2nd December, 1933, addressed to the Government of India, the Bengal National Chamber, after mentioning that injustice has

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*Question 479.*—"Do they send out spurious articles very largely? Yes, and we have received many letters on the subject."

(24) See Report of the Conference of Indian and Ceylon Chambers of Commerce, January, 1905. The unsatisfactory nature of the legal protection of trade mark owners as was evidenced by the "Amritsar Imitation case" was referred to in this meeting.

resulted in many instances under the present system, proceed to say: "Apart from that, it has to be noted that even if justice was done and was capable of being done, in the prevailing condition of extreme uncertainty, the procedure invariably leads to unjustifiably large expenses for securing recognition of what might be called a natural right. Such unnecessary expenses as well as the uncertainty attendant on the present position can be effectively removed only by legislation on the model of the British and other Trade Marks Acts in this country".

**Plaintiff may be required to establish title and validity of mark in every suit.**—It is also necessary to point out here that the trouble of proving ownership does not end even after the owner of a mark once succeeds in fully establishing his rights before the Court. In every subsequent infringement suit he is put to the necessity of proving afresh his title to the mark if the defendant chose to dispute it.<sup>25</sup> Similarly, the validity of the same mark may be disputed in every subsequent case, although it had been already decided in the plaintiff's favour.<sup>1</sup> The whole procedure will have to be gone through *de novo* every time an infringement occurs. Again, if infringement of a well-known mark occurs in different parts of the country, a number of suits may have to be filed in the different Courts having respective local jurisdiction. The plaintiff has then to prove that in each of these local areas he had acquired title to the mark.<sup>2</sup> This is often difficult even in the case of well-known trade marks. The effect of such litigation on the mind of the proprietor of a trade mark, especially of one of recent origin, can be easily imagined and it would not be surprising if his business sometimes comes to a standstill on this account. There can be little doubt that an experience of this nature would

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(25) For instance, in supporting the resolution on trade marks at the meeting of the Associated Chambers Mr. Carnegie of the Upper India Chamber of Commerce said how a firm which was a member of his Chamber had developed a large business in the manufacture of an article sold under the trade name "Flex" and how the firm had to fight several infringement suits in which the mark "Flex" had been altered to, among others, Alex, Elex, Slex, Alek, Tlex, Plex and Glex, each of these infringements being printed in the same style as the original mark.

(1) See S. 46 of the English Trade Marks Act which provides for the granting of a certificate of validity to the owner of a registered mark once the issue is decided in his favour by a Court.

(2) See for instance the recent infringement cases in respect of "Swan" Mark of Messrs. Mable, Todd and Co., Ltd., in Rawalpindi, Madras and other districts.

act as a powerful brake on the enterprise and initiative of even the most optimistic of trade mark owners.

**Difficulties of Indian merchants in foreign countries.—**

We may next refer to the difficulties of registration of trade marks by Indians in foreign countries. In many of these countries the production of a certificate of registration in the country of origin is a condition precedent to registration.<sup>3</sup> In the absence of a Trade Marks Registration Act in India, it is impossible to comply with this requirement and Indian marks cannot be registered in these countries on this account. In an article contributed to the Indian Textile Journal, dated October, 1928, Mr. M. P. Gandhi mentions an instance of such difficulty experienced by some Indian merchants. It is stated that these merchants instructed their agents in Greece to register certain trade marks, but the registration could not be effected as India is not a member of the International Convention for the Protection of Industrial Property. The loss caused to Indian merchants by this disability is substantial. Apart from the fact that an Indian merchant cannot register his trade mark in these countries, there is the further possibility that an unscrupulous foreign rival may register the identical mark in his own name and thereby effectively prevent the Indian merchant from selling his goods under his mark in such countries. Another important point may be noted in this connection. In England and America the Common Law rights are recognised, so that Indian trade mark owners have at least a right to a passing-off action, though at comparatively great expense. But in a number of foreign countries this right at Common Law is not recognised while registration of Indian marks is refused for want of a certificate of home registration. The Indian merchant has thus absolutely no legal protection for his mark in these countries, even after the mark had been in use there for a considerable time.

A few of the other disabilities of Indian merchants in foreign countries may also be briefly mentioned here. As India is not a member of the International Union, an Indian merchant is denied some of the valuable rights<sup>4</sup> to which a national of the countries of the Union<sup>5</sup> is legally entitled. One such right is that of priority of twelve months for an application for patent and six months for the registration of a design or a trade mark. The effect of this article

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(3) See Appendix XIV for a list of these countries.

(4) See "Articles of the International Convention for the Protection of Industrial Property", Appendix X.

(5) See Appendix XVI for a list of the contracting States.

of the Convention is that when a merchant of a contracting state registers a patent or a design in his own country, he is assured of the rights of priority thereof in other contracting states for a period of twelve or six months as the case may be. In the absence of such priority rights the Indian merchant runs, even in those countries where he can register his trade mark, the risk of his mark being refused registration, as it is possible that, in the period between his adoption of the mark at home and his application therefor in the foreign country, an application for the registration of the same or a closely similar mark may have already been made by a national of that foreign country or a national of any of the countries of the Union claiming prior Convention date. There can be no doubt that the denial to Indians of priority right in foreign countries causes them severe hardships, especially in the case of Indian inventors who seek to protect their inventions abroad by taking out patents in foreign countries.<sup>6</sup>

**Disabilities in the absence of a central Registration Office.**—The difficulties of Indian merchants arising from the absence of a central registration office may also be noted. Under the existing conditions, it is impossible for a merchant in this country to find out whether a particular mark he has been using or proposes to use is new or not. It often happens that, after expending considerable labour and money to make his trade mark popular, the owner of the mark finds that a rival trader has the title to the identical or a closely similar mark. The latter may have used the mark only in a small area or to a small extent, so that the first trader was unaware of his rival's right for a long time. All the same, he may have to lose the fruits of his labour in popularising the mark. Nor can the first trader have any reasonable expectation that the mark which he may use next would meet with a better fate. In a country of such vast area, it is extremely difficult at present for a merchant in one part of the country, say Madras, to find out whether the mark he proposes to apply to his goods is already being used by another merchant on similar goods in a distant part of the country, say Punjab. Two merchants may thus acquire title to the mark in different parts of the country in good faith and in total ignorance of each other's existence. The two rights may co-exist for some time without conflict, but trouble would start when the goods under these marks acquire popularity in the market, and the

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(6) See for instance evidence of Mr. Rutnagar before the Industrial Commission, Industrial Commission Report (1917-1918), Evidence, Vol. IV, pp. 325-327.

two merchants begin to compete in other parts of the country. Apart from such *bona fide* cases of concurrent user, the absence of a central trade marks office tends to encourage the setting up of false claims of concurrent user in trade mark suits. There is no doubt that under the present system the legitimate aspirations of a trade mark holder in this country are thus hampered.

**Special difficulties.**—In a number of Indian cases, where the validity of the mark was disputed, it has been held that the mark was not sufficiently distinctive to constitute a trade mark. Almost any mark is used at present by the merchants in India for application to their goods. They are not in a position to know whether a mark which they propose to apply on their goods, is *prima facie* suitable for use as a trade mark. For instance, one finds in the market goods under the marks “Superfine scent,” “Calcutta soap,” “Chandan soap,” “Neem tooth powder,” and other word marks that are obviously descriptive of the composition or quality of the goods, or which constitute well-known geographical names. An exclusive monopoly in the use of these marks cannot be claimed by any particular trader, as the words may be legitimately required by any other trader to describe his goods answering to the particular descriptions. Registration of such marks would be refused if the Indian Act be enacted on the lines of the English legislation. In the absence of a statute defining what marks are registrable, the Indian merchants do not at present have any guidance in choosing their marks. In the present state of industrial development, legislative guidance in this matter, apart from any question of legal protection, will be a great boon to them. Most of the trade marks now used in India will not be admitted for registration in England and other countries. The Collector of Customs, Calcutta, quoted some years ago, an instance in which out of 200 marks current in India, which were sent to England for registration, not a single one could be registered. No better testimony is required to demonstrate forcibly the extremely unsatisfactory position of trade marks in this country.

**Need for legislation.**—From what has been said above it is clear that the present position in this country in respect of protection of trade marks is far from satisfactory. What is urgently needed is a statute for registration of trade marks, as in England, providing for an action for infringement as distinguished from a passing-off action. Such legislation would be beneficial to both vendors and buyers of goods. In the case of the merchant, who



sells his wares, legislation will be a great boon, as it would facilitate proof of title, in trade mark suits. Instead of his having to produce evidence of user and reputation to establish his title he would merely have to produce a certificate of registration, and the onus of proof would be shifted from the plaintiff to the defendant. A more effective and speedy protection against infringement would thus be available to the trade mark owner. As regards the purchasing public, a trade mark is an assurance to them that the article on which the mark is applied is a genuine produce of the manufacturer. Legislation for the effective protection of trade marks will, therefore, tend to prevent imposition of spurious goods on the public and will enable the purchaser to buy with confidence the goods he wants. That these advantages are well appreciated all over the world will be seen from the fact that practically all countries of any commercial importance have on their statute books an Act for the registration of trade marks. Even minor states such as Chile, Peru, Iraq and Manchouko form no exception. Of our own neighbours, Ceylon has had a Registration Act ever since 1889, and Siam has also recently promulgated such an Act. A trade mark is the very soul of business and no business under modern conditions can be expected to prosper unless trade mark rights are efficiently protected. The enormous value, which a successful trade mark can attain, will be appreciated from a few familiar examples such as "Kodak," "Sunlight soap," "Amrutanjan," "Bovril," "His Master's Voice," "Cocogem," etc. It is stated that the marks controlled by the Imperial Tobacco Co. alone are valued at more than several crores of rupees. If the business enterprise and initiative of Indian merchants have to be fostered and stimulated, if India is to take her rightful place in the comity of trading nations, it is imperative that the trade marks in this country should obtain adequate protection. Legislation for the registration of trade marks in India is necessary for this purpose. With such legislation piracy of trade marks would be discouraged and trade mark suits would consequently become much fewer.<sup>7</sup> In any case it cannot be questioned that legislation "provides a better method of procedure",<sup>8</sup> and, as Mr. Winterbotham said, "to fight a trade mark case with a register would be a very much simpler matter than it is to-day".

(7) "As soon as one trader prospered, the others would start imitating his labels. A Registration Act is necessary to put a stop to this state of things", Costello, J., (Calcutta High Court), *Statesman*, 19th March, 1931.

(8) Per Romer, L.J., in *Bow v. Hart*, (1905) 1 K.B. 592.

## CHAPTER III.

### COTTON MARKS.

In the previous Chapter reference was made to the unique position which the cotton trade occupies in our country and the necessity for the registration of cotton marks when a Trade Marks Act is passed in India. It may be observed that the problem presented by the registration of these marks will be slightly different from that of trade marks in other classes. The number of trade marks on cotton goods in actual use is very large and many of them exhibit only slight differences among themselves. Immediately after the enactment of legislation, registration would no doubt be sought for most of these marks, and some difficulty may be experienced in examining them for their distinctiveness. The problem would, however, be exactly similar to what was experienced in England soon after the enactment of a Trade Marks Act. It would therefore be instructive to inquire how the difficulty of registration of these marks was overcome in England. Again, the registration of cotton marks in England has engaged the most careful attention of the British legislators and the provisions relating to the registration of these marks have been amended several times. The valuable experience obtained in England in respect of cotton marks as a result of the working of the Trade Marks Act for 60 years will therefore be of invaluable help and guidance in framing and administering the future Trade Marks Act. A brief history of the registration of cotton marks in England since 1875, is, therefore, given below.

**Cotton marks under the first English Trade Marks Act.—**The Trade Marks Rules under the first Act of 1875 were issued in August, 1876, in respect of registration of marks in the cotton classes. For the purpose of facilitating the granting of trade marks for these goods, an office was set up at Manchester for the exhibition of all devices, marks, letters, words, figures, etc., used in the cotton trade. Every person, who at the date of the passing of the Act used any cotton mark, was required to send to this office

three representations of such cotton mark, on or before 1st January, 1877, if resident in the United Kingdom, and if resident elsewhere, on or before 1st March, 1877. They were also required to send four representations of all their "combination stamps", that is, combinations of several different trade marks which were treated by the dealers in cotton goods as equivalent to a single mark. A committee of persons conversant with the usages of the cotton trade was appointed, and was authorised to examine all the cotton marks thus received and divide them into two classes:—(A) those which were in the opinion of the committee trade marks within the meaning of the Act; (B) those which were not in their opinion trade marks (*vide* rule 59). In the instructions issued to the Committee, the Commissioner of Patents stated that the division of these marks should be based on certain broad principles. The more important of these were that single letters should not be considered as trade marks, and that, where more than three persons applied for the registration in the same class of goods for the same mark, or for marks which so closely resembled each other as to be calculated to deceive, such mark or marks should not be considered as trade marks within the meaning of the Act, (Three Marks Rule). The Committee was further instructed to consider, not merely such evidence as might be formally brought before them, but to utilize its expert knowledge with regard to the state of things in the trade, in deciding whether a particular mark should be placed in the first or the second class.

**A list and B list.**—Acting on these principles the Committee classified all the marks into two groups known as the *A* list and the *B* list, of which the former contained the registrable and the latter the non-registrable marks. Rule 62 provided that any person claiming to be the proprietor of a cotton mark in the *A* list might apply for registration, subject to the usual conditions attached to the registration of any other trade mark. Marks placed in the *B* list were not allowed to be registered except in pursuance of an order of the Court. The scope of the decision of this Committee in respect of a non-registrable mark came up for consideration before the House of Lords in *Orr-Ewing and Co. v. Registrar of Trade Marks*.<sup>1</sup> Lord Chancellor Cairns said that "the rules appear to provide a rough but useful way of separating, by means of the technical knowledge and judgment of the committee, the cotton trade-marks into two classes. The first class is to consist of those

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(1) 8 Ch. D. 794; 4 App. Cas. 479.

marks which the committee is of opinion are trade-marks within the Act, and proprietors in this class are to have the benefit, arising from this opinion, of being able at once to apply to be registered in respect of those marks. With regard to the second class, there is no decision pronounced against them, but the proprietors cannot apply for registration as a matter of course. They must come to the Court, and it must be for the Court to say whether the Registrar shall proceed on their application to register or not. In deciding this the Court will have before it the circumstance that the opinion of the Committee was adverse to the claim of a trade mark; but this would be an opinion only, and not a decision arrived at after hearing both sides or rendered in any judicial proceeding." It is necessary to point out that in a number of applications before the Courts, owners of the *B* list marks were successful, and the Registrar was directed by the Court to have these marks registered. Rule 63 (a)<sup>2</sup> stated that the Trade Marks Rules (1876), numbered 57 to 63, did not apply to such trade marks for cotton goods as were not in use at the date of the passing of the Act of 1875, and that the registration of new cotton marks should be applied for in the same manner and would be subject to the same conditions as that of trade marks for other goods. Such of the new marks in the cotton classes, as were refused registration, were placed in a list known as the "Refused list".

**Abolition of "B list" in 1926.**—The expert Committee which was created under the Trade Marks Rules of 1876 was later dissolved by Government on the recommendation of the Herschell Committee. A new practice was then adopted and the Keeper of the Cotton Marks at Manchester was authorised to consult the Trade Marks Committee of the Manchester Chamber of Commerce whenever difficulties arose in respect of registration of cotton marks. The Keeper of the Cotton Marks was further required, while considering the registrability or otherwise of a mark, to make a search for conflicting marks in the "*B* list" and the "Refused list" in addition to the Trade Marks Register. When the Amendment Act of 1919, came into force, providing for division of the Register into two parts, it was felt that the "*B* list" had outlived its usefulness. It had by that time become very cumbrous, as there was no provision in the rules for removing from this list such of those marks as had long since gone out of use. The rules were accordingly modified in 1926, to suit the existing needs. Owners

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(2) Issued by the Board of Trade on 21st October, 1879.

whose marks were in the "B list" were allowed without a specified period to register these marks in part B of the Trade Marks Register, and it was laid down that those marks in the B list for which registration was not applied for within that period, would cease to be quoted against other applications. The marks which were not considered as qualified for registration in part B of the Register were transferred to the "Refused list" and the proprietors were asked to pay the ordinary fee to retain such marks in the list, in the same manner as in the case of other marks. In this way the B list was cleared of all the marks therein.

**Line headings.**—Another measure which was specially adopted in connection with the registration of trade marks in the cotton classes related to the line headings or patterns. These were not considered registrable under the Acts of 1875, 1883 or 1888. The question whether it would be expedient to provide for registration of line headings in cotton goods was carefully considered by the Herschell Committee. While there was general agreement among the witnesses that such registration would be desirable, opinion differed as to its practicability. The difficulties of registering line headings were forcibly brought out in the case of *Mitchell v. Henry*.<sup>3</sup> Cotton, L.J., summed up the case in the following words: "What is claimed by the plaintiffs is a double thread on a white selvage; if that is distinctive, then what the defendants are using, namely, a triple thread upon a white selvage, must be a distinctive trade mark and therefore I cannot restrain the defendants." After a careful investigation of the evidence which was tendered before them, Lord Herschell's Committee came to the conclusion, that it would be impracticable to provide for registration of line headings for cotton goods. This recommendation was incorporated in the Act of 1905.<sup>4</sup>

**Scheme for India.**—We may now propose a tentative scheme for dealing with the large number of cotton marks, for which, registration may be sought as soon as an Indian Trade Marks Act, comes into force. The Government of India may appoint a Committee of experts, having knowledge of the cotton trade in this country. The owners of cotton marks may be invited to co-operate in the matter, and they may be requested to submit to the Committee four copies each, of all their marks which are

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(3) (1880) 15 Ch. D. 181.

(4) See S. 64 (10-b) of Act of 1905 (Appendix III).

actually in use in the country at the time.<sup>5</sup> These should include all the marks which are used on imported cotton goods by the manufacturers or the vendors thereof, and all the trade marks used by manufacturers in India, on cotton goods produced for home market or export trade. The Committee should be asked to classify these marks as (a) registrable and (b) non-registrable, in accordance with instructions from the Registrar of Trade Marks. This preliminary classification by the expert Committee will be of great help to the Registrar when registration of these marks is applied for. The granting of registration must, however, rest with the Registrar. Should the Registrar refuse registration to any of these marks, appeal should lie to the Government of India as in the case of other marks. During the initial period provision may be made for the Registrar to forward, in cases of difficulty, applications for new cotton marks to the expert Committee for opinion. The expert Committee may be dissolved after 5 years by which time all the old marks would have sought registration if their owners desired it. Sufficient experience would have been gained by this time so that there would no longer be any need for the continuance of the Committee.

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(5) A list of trade marks which are now in use in the cotton trade by the Bombay Mill Owners is maintained by the Bombay Mill Owner's Association. It appears that there are over 2,000 marks in this list, and that members of the Association consult this list before introducing any new mark in the market.

## CHAPTER IV.

### WHAT CONSTITUTES A TRADE MARK.

It has been pointed out in the last Chapter that, although there is no statutory protection of trade marks in India, a plaintiff whose trade mark has been infringed may obtain relief under the Common Law by an action for passing-off. In order to establish his title for this purpose he has to prove that he is the prior user, and that the mark is distinctive. The question, "what constitutes a trade mark?" is therefore of importance, and will be discussed in this Chapter. It is hoped, that the criteria of a valid mark as disclosed by a study of the leading cases would, apart from their bearing on the right to a passing-off action, be of great help to the mercantile community in their choice of suitable marks. It not infrequently happens that a manufacturer or a trader who has built up a huge business around a mark, finds himself in the unenviable position of having chosen a mark, which by its very nature is unsuitable as a trade mark, and is, therefore, not ordinarily entitled to legal protection. A knowledge of what are the essential requirements of a valid mark, would, on the other hand, have enabled him to make a correct choice from the beginning. We shall now proceed to consider what the Courts have held to be the essential requirements of a good trade mark.

**Trade mark defined.**—In the absence of a statutory definition of a trade mark,<sup>1</sup> the Indian Courts have generally followed the definition adopted by the English judges. In the words of Lord Cranworth, a trade mark may be described as a particular mark or symbol, used by a person for the purpose of denoting that the article to which it is affixed, is sold or manufactured by him, or by his authority, or that he carries on business at a particular place.<sup>2</sup> It "must be some visible concrete device or design affixed

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(1) See however Sec. 478, I.P.C., where a definition is given for the purposes of the Merchandise Marks Act, Chapter XI.

(2) *Leather Cloth Co. (Limited) v. American Leather Cloth Co. (Limited)*, 35 L.J.Ch. 53.

to goods to indicate that they are the manufacture of the person whose property the trade mark is,"<sup>3</sup> and must be used for "designating goods as being the goods which have been in some way or other, dealt with by A.B., the person who owns the trade mark."<sup>4</sup> A trade mark has been defined by an American judge, as "a distinctive mark of authenticity through which the products of a particular manufacturer may be distinguished from others,"<sup>5</sup> and as "one's commercial signature to his goods." It is, however, not necessary that every trade mark should indicate the particular manufacturer or vendor or give the address of either of them. When a mark has become recognised by the public as exclusively designating the goods of a particular manufacturer or seller, it will be sufficient indication of ownership, and the owner of the mark will be protected by the Courts against infringement, although purchasers may not be able to tell from the mark, who the particular maker or the seller of the article is.<sup>6</sup>

Thus, to constitute a valid trade mark, two things are essential. In the first place it must be used in trade, that is, affixed to goods, and not merely used in trade circulars or advertisements.<sup>7</sup> Secondly, it must be distinctive, that is, it must distinguish the goods so marked, from other similar goods in the market. In the words of Lord Chancellor Halsbury, "distinctive" means "distinguishing a particular person's goods from somebody else's—not a quality attributed to the particular article, but distinctive in that respect that it is a manufacture of his, distinguished from somebody else's." If a mark merely describes the quality or origin of an article, such a descriptive mark is, obviously, not capable of distinguishing the goods of one maker from those of others, *e.g.*, "Painkiller" and "Gripe Water", for medicines, "Malted Milk" and "Madras Curry Powder", for articles of diet. Similarly, a word, though invented, may not constitute a valid trade mark, if

(3) *Anath Nath Dey v. Emperor*, 17 C.W.N. 227.

(4) *Per Kay, J., In re The Australian Wine Importers' Tm.* L.R. 41 Ch.D. 278.

(5) *Per Veeder, J., in United Lace and Braid, Co. v. Barthels Manufacturing, Co.*, 221 Fed. Rep. 457, 459.

(6) *Wotherspoon v. Currie*, L.R. 5 H.L. 508; *Bewlay & Co., Ltd. v. Hughes*, 15 R.P.C. 290; *Madhavji Dharmsey Manufacturing Co., Ltd. v. Central India Spinning, Weaving and Manufacturing Co., Ltd.*, A.I.R. 1916 Bom. 183; 41 Bom. 49.

(7) *See Chapter V.*



it had been used merely to describe a new article, *e.g.*, “Chocoroons”<sup>8</sup> for sweetmeat.

Trade marks may be classified as follows:—(1) Names, (2) Signatures, (3) Word marks, and (4) Distinctive devices. These are considered *seriatim* in the following sections. For the purposes of discussion the English Trade Marks Registration Act is followed, and the leading English cases concerning the registration of trade marks are referred to. It must, however, be borne in mind, that a trade mark can obtain protection under the Common Law in England, even though its registration is refused, or set aside as in cases where a *prima facie* descriptive mark becomes distinctive of the goods of a particular manufacturer.

**Name Marks.**—The name of an individual or company is registrable as a trade mark under section 9 (1) of the English Act. A manufacturer or vendor naturally thinks that if his goods are marked with his name, that would serve to identify his goods in the market. A moment's consideration will show, that it would only distinguish his goods from those of others not bearing his name. In view of the right that every trader has to the *bona fide* use of his name in connection with his goods, it would not be fair to give an exclusive right to a name mark to any one individual, and the section accordingly lays down that, a name mark can be registered only when it is represented in a special or particular manner.<sup>9</sup> Thus in *Fanfold Ltd.'s Application*,<sup>10</sup> as the name of the company was represented in ordinary type registration was refused, the addition of indistinct scrolls being held, as not so special or particular as to distinguish the applicants' goods. A mere embellishment of a well-known kind will not by itself make the representation distinctive.<sup>11</sup> If the name of an applicant company is written in more or less ordinary handwriting it does not satisfy the requirement of distinctiveness for registration.<sup>12</sup>

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(8) *Williams Ltd.'s Application*, 34 R.P.C. 197. The trade mark actually used in connection with the sweetmeat was “Velvona”, the name “Chocoroons” appearing underneath. See also “*Diabolo*” case, 25 R.P.C. 565, where the word was used for the name of a game and not to denote the tops used in the game.

(9) This sub-section does not say that name should be that of a living person or that of the applicant for registration. On this point, see *Holt & Co.'s Tm.*, 13 R.P.C. at p. 122, *per* Lindley, L.J.

(10) 45 R.P.C. 199, 325.

(11) See *Application of Benz, etc., Cie*, 30 R.P.C. 177.

(12) *British Milk Products, Co., Ltd.'s Application*. 32 R.P.C. 453.

The section does not lay down that the name selected as the trade mark should be that of the actual manufacturer or selector of goods. Again, as the owner of a trade mark may assign the mark to another, it follows that a name mark continues to be valid even when it represents a predecessor in business and not its present owner.<sup>13</sup> Where the name of a living person forms part of a trade mark, consent from such person is essential for registration in England, and in the case of persons recently dead, from their legal representatives.<sup>14</sup>

**Surnames.**—Mere surnames are *prima facie* not suitable as trade marks. The reason is obvious. A name like Smith, Brown, or Bose may represent any number of persons, and cannot be appropriated by any one of them for exclusive use.<sup>15</sup> As Neville, J., said: "The right to the surname that a man uses is shared with every other person who has the same name, and, consequently, he has got about as much monopoly in it as he has in the air that he breathes; he has to share it in common with all his fellow citizens."<sup>16</sup> A surname which is of rare occurrence may be considered less objectionable.<sup>17</sup> The object of placing these restrictions was explained by Lord Herschell's Committee in the following words: "Little or no mischief might result where the name of the applicant was an uncommon one; but where the name was a common one the result would be to deprive all persons bearing the same name of their right to use a common word in connection with their own name, and even if the name were an uncommon one, it would be impossible to say, that there were not other persons bearing it, who might wish to use it in connection with the common word, which it is sought to monopolise". The mere combination of a surname with a mark which is not otherwise distinctive will not make the combination mark distinctive. Surnames are, however, not so objectionable when applied to a class of goods where the trade is

(13) See for instance *Bury v. Bedford*, 32 L.J.Ch. 741; *Massam v. Thorley's Cattle Food, Co.*, 14 Ch.D. 748. See also Chapter VI under Trade names.

(14) See Rule 14 of English Trade Marks Rules.

(15) See Section 9 (4) of the English Act, 1905.

(16) *Cadbury Bros., Ltd.'s Application*, 32 R.P.C. at p. 12.

(17) *Teofani & Co., Ltd. v. Teofani*, 30 R.P.C. 76, 446; *Muratti, Sons & Co. Ltd.'s Application*, 32 R.P.C. 77; *Winget Ltd.'s Application*, 36 R.P.C. 75; *J. C. Eno Ltd.'s Application*, 37 R.P.C. 1.

restricted to a few people, *e.g.*, *motor cars*.<sup>18</sup> A surname may by long user become associated with the goods of a particular manufacturer.<sup>19</sup>

In India, a manufacturer often uses as his trade mark his own name, or that of the company, or the names of some prominent Indians. Portraits are also commonly used in combination with those names. The courts have recognised the validity of such marks. But it is essential in such cases for the claimant to prove that the goods bearing the mark have become known in the market as exclusively of his manufacture;<sup>20</sup> otherwise the mark will not be protected.<sup>21</sup>

**Signature marks.**—The signature of a person being the name of a person represented in a special manner is distinctive, and can therefore constitute a trade mark.<sup>22</sup> A signature mark continues to be valid when used by a successor in business. This class of marks is also common in India.

**Word marks.**—By far the most important class of marks in use consists of words or combination of words. Word marks may be grouped under—(a) invented words, *i.e.*, words which have never been in use before, and (b) ordinary words which are non-descriptive of the goods. As examples of the first type the words “Kodak,” “Solio,” “Aguerine,” “Bovril,” “Hovis” may be given. Fancy words of this type catch the imagination of the public and are eminently suitable for use as trade marks. The grant of exclusive use of an invented word to a particular trader does not interfere with the rights of others. As Lord Herschell remarked, invented words would deprive no one of anything. As examples of ordinary words having no direct reference to the character or quality of the goods, may be cited, “Elephant,” “Goldflake,” “Scissors” and “Black Cat” for cigarettes, “Cobra” for boot polish, or “Swan” for ink.

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(18) See *Daimler & Co.'s Application*, 33 R.P.C. 337; *Burford (H.G.) & Co., Ltd.'s Application*, 36 R.P.C. 139; *Thornycroft & Co., Ltd.'s Application*, 37 R.P.C. 25.

(19) See for instance *Cadbury Bros. Ltd.'s Application*, 32 R.P.C. 9; *W. & T. Avery Ltd.'s Application*, 36 R.P.C. 89; *Burford (H.G.) & Co., Ltd.'s Application*, 36 R.P.C. 139; *Daimler & Co., Ltd.'s Application*, 33 R.P.C. 337; *Muratti, Sons & Co., Ltd.'s Application*, 32 R.P.C. 77; *Crossley Bros., Ltd.'s Application*, 38 R.P.C. 81; *Reddaway & Co., Ltd.'s Application*, 38 R.P.C. 83; *Perry & Co., Ltd.'s Application*, 38 R.P.C. 195.

(20) *Dunbar v. Holland Bombay Trading Co.*, 12 S.L.R. 129; 20 Cr. L.J. 277; *Mohammad Rasa v. Emperor*, A.I.R. 1930 Oudh 360.

(21) *Gobinda Chandra Roy v. Abdul Rashid*, A.I.R. 1928 Cal. 235.

(22) See Section 9 (2) of the English Act, 1905.

**History of word mark registration in England.**—Numerous and valuable as word marks are, their registration in England presented problems of great difficulty in the earlier years. The first Registration Act, i.e., the Act of 1875, refused registration to all word marks (except those in use before the passing of the Act).<sup>23</sup> This restriction was later on removed by the Act of 1883, which provided for the registration of “fancy words or words not in common use.” The interpretation of this new provision by the courts was, however, so stringent that the registration of only six words<sup>24</sup> was upheld among the numerous cases that came before the courts during the years 1883 to 1888. A vague implication of any reference to the quality or origin of the goods, was considered sufficient ground for refusal of registration.<sup>25</sup> The courts insisted that in addition to being “not in common use” “a fancy word” should have no reference to the character or quality of the goods. To quote Lopes, L. J., “a word to be a fancy word must be

(23) Even such an obviously distinctive word as “Aeilyton” was refused registration by Jessel, M.R. in *Stephens’ Trade Mark Case*, 3 Ch.D. 659 (1876); Seb. Dig. p. 303.

(24) “Alpine” for embroidery, In re *Stapley & Smith*, 29 Ch.D. 877; “Lawford” for tennis racquets In re *Slazenger v. Mailings*, W.N. 1885, p. 124; “Bovril” *Bovril Trade Mark*, In re, 13 R.P.C. 382; “Mazawattee” for tea, *Densham & Sons’ Tm.*, 12 R.P.C. 75, 271; “Oomoo” for wine, In re *Burgoyne*, 6 R.P.C. 227; “Tabloid” for medicine, In re *Burroughs, Wellcome & Co.*, 21 R.P.C. 217.

(25) Words held to be not fancy words: “National Sperm” candles, In re *Price’s Patent Candle Co.*, 27 Ch.D. 681; “Electric Velveteen”, In re *Leaf’s Trade mark*, 4 R.P.C. 31; “Gem” air guns, In re *Arbens*, 35 Ch.D. 248; “Self washer” in *Lever v. Goodwin*, 36 Ch.D. 1; “The Jubilee Note” paper in *Towgood Bros. v. Alexander Pirie & Sons, Ltd.*, 4 R.P.C. 67, “Benledi” whiskey, In re *Ainslie & Co.*, 4 R.P.C. 212; “Red, White and Blue” label tea, In re *Hanson*, 37 Ch.D. 112; “Sanitas” for disinfectant, In re *Sanitas Co.*, 4 R.P.C. 533; “Reversi” game, In re *Waterman*, 39 Ch.D. 29; “Bokol” for beer, In re *Davis & Co., Ltd.*, 6 R.P.C. 207; “Herbalin” for medicine in *Humphries v. Taylor Drug, Co.* (2), 59 L.T.N.S. 820; “Syrup of Figs” In re *Californian Fig Syrup Co.’s Tm.*, 40 Ch.D. 620; “Kokoko” Cotton piece goods, In re *Jackson & Co.*, 6 R.P.C. 80; “Manor” tin plates, In re *Thompson*, 6 R.P.C. 213; “Emollion” toilet cream, In re *Grossmith*, 6 R.P.C. 180; “Hand Grenade Fire Extinguisher”, *Harden Star Hand Grenade Fire Extinguisher Co., Ltd.’s trade mark*, 3 R.P.C. 132; “Tower Tea”, *Great Tower Street Tea Co. v. Smith*, 6 R.P.C. 165; “Brymbo Special” for iron, In re *Batt & Co.*, 6 R.P.C. 493; “Electroid” for anti-fouling composition, In re *Hannay*, 7 R.P.C. 46; “Apollinaris” for mineral water, In re *Apollinaris Co., Ltd.*, 8 R.P.C. 137; “Beatrice” for shoes, *Harris Trade Mark*, 9 R.P.C. 492; “Britannia” for soap, *Hodgson v. Sinclair*, 9 R.P.C. 22; “Carnival” for cigarettes, *Lloyds and Sons’ Trade Mark*, 10 R.P.C. 281; “Shakspeare” for cigars, *Banks & James Trade Mark*, 12 R.P.C. 333; “Triticumine” for biscuits and bread, *Meahy & Co., Ltd. v. Triticine, Ltd.*, 15 R.P.C. 1; “Cyclostyle” for pens, etc., *Gesletner*, In re, 25 R.P.C. 156.

obviously meaningless as applied to the article in question. It must be a word fanciful in its application to the article to which it is applied in the sense of being so obviously and notoriously inappropriate as neither to be deceptive nor descriptive, nor calculated to suggest deception or description. Further than that, the word must have an innate and inherent character of fancifulness which must not depend on evidence, and cannot be supported by evidence, to show, that in fact, it is neither deceptive nor descriptive, or calculated to be deceptive or descriptive. What I mean is that a fancy word, in my opinion, must speak for itself, it must be a fancy word of its own inherent strength.”<sup>1</sup> Again, in the words of Lindley, L.J., a fancy word “must either have, to ordinary English people, no meaning like the words ‘Eureka’ or ‘Aeilyton,’ or if it has any meaning at all, it must be obviously meaningless when used as a trade mark.”<sup>2</sup>

**Act of 1888.**—The dissatisfaction of the commercial community on account of the enormous difficulty in finding a word to suit the stringent requirements laid down above, led to the appointment of a departmental committee, presided over by Lord Herschell. In accordance with the recommendations of this committee a less stringent provision was inserted in section 10 of the Act of 1888. The expression “Fancy word or words not in common use” in clause (c) of section 64 (1) of the Act of 1883 was replaced by the following sub-sections:—“(d) an invented word or invented words; or (e) a word or words having no reference to the character or quality of the goods, and not being a geographical name.” Notwithstanding this express provision the courts continued to exercise the same scrutiny in respect of word marks, and interpreted that the two sub-sections should be read together. A number of good trade marks were thus disallowed on the ground of lack of real invention, or on the ground of some remote suggestion of descriptiveness. A few typical cases are given below to illustrate the nature of these decisions.

In *Talbot's Trade Mark case*,<sup>3</sup> the word “Emolliolorum” registered as a fancy word in 1883 for saddle paste, was later on ordered to be expunged from the register, on the ground that though the word was meaningless to an ordinary Englishman,

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(1) In re *Van Duzer's Trade Mark* and in *Leaf's Trade Mark*, 4 R.P.C. 31 at p. 39.

(2) *Ibid.* p. 38.

(3) 11 R.P.C. 77.

there was the likelihood of the word conveying the impression that the article would act by softening, and that, consequently, the word was descriptive. Again, when the word "satinine" was sought to be registered as an invented word under the Act of 1888 for starch, Key, J., in refusing registration observed: "This is a word which describes the quality of the goods, and there is marvellously little invention in the matter, for the only invention is putting at the end of a common word 'satin', which brings to every man's mind in a moment, the notion of a glossy surface, the common conclusion 'ine' which you find in 'satine', 'saccharine', and half a hundred other English words. Certainly, if that is inventing a word, it is the easiest mode of inventing you can possibly conceive. But, I understand, this Act of 1888 is subject to the limitation which the decisions have put on the former Act, that you cannot possibly use any word, fancy word or otherwise, if it is a descriptive word." So also, in the "Somatose" case,<sup>5</sup> registration was refused for the word "somatose," as a trade mark for a pharmaceutical preparation of meat ingredients, on the ground, that the original (Greek word "soma" meant body, and that, therefore, "somatose" could not be said to have no reference to the quality of the goods. This was confirmed by the Court of Appeal (Lindley, L. J., dissenting)<sup>6</sup> Kay and Smith, L.J.J., holding that as the words "Soma", "Somatic" and "Somatical" were in the dictionary, "somatose" could not be regarded as an invented word. In his judgment, Lord Justice Kay went so far as to remark that the Act of 1888 was by no means intended to give traders a larger right to monopolise words, than the former Act of 1883, but, rather, if anything, to restrict that right still further, and to render the duty of the Comptroller more simple and easy. Smith, L. J., pointed out that an invented word must be a "word coined for the first time and is, of necessity, incapable of reference to the character or quality of the goods, because, *ex hypothesi*, it is an entirely new unknown word, incapable of conveying anything". He added: "It is impossible, I think, to hold that the legislature intended that an invented word might be a word having a reference to the character or quality of the goods,

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(4) *Meyerstein's Application*, 7 R.P.C. 114.

(5) *Farbenfabriken Vormals Fried Baeyer & Co.'s Tm.*, 11 R.P.C. 84.

(6) Lindley, L. J., agreed, however, that an invented word to be a valid mark must have no reference to the character or quality of the goods. *Ibid* at p. 90.

whereas a non-invented word might not. There would be no sense in so holding."

"**Solio**" case.—The above decisions\* which laid down that an invented word within the meaning of the Act should be a word devoid of any reference whatever to the character or quality of the goods, were overruled by the House of Lords in the well-known "**Solio**" case.<sup>8</sup> The Eastman Photographic Material Co., Ltd., applied for registration of the word "**Solio**" for photographic paper. Registration was refused by the Comptroller, on the ground, that it was the practice of the Patent Office to refuse registration of trade marks in respect of photographic papers, to words which consisted merely of the word 'sun', or its equivalent 'Sol', or of either of these words, with some ordinary termination or affix. On appeal, Kekewich, J., held that the word 'Solio' would be understood to refer to the sun, and that, as applied to photographic paper, it was not a word having no reference to the character or quality of the goods. This decision was affirmed by the Court of Appeal, who were bound by their own previous decision in the Somatose case. Further appeal was made to the House of Lords. It was contended on behalf of the Eastman Photographic Materials Company, that the word "**Solio**" had nothing to do with photography, or even with light, and that it was wrong arbitrarily to divide a word and reject it, because a fragment taken by itself might have some reference to the character or quality of the goods. When counsel for the Comptroller cited the Somatose case as the authority for taking the opposite view, Lord Herschell merely remarked that he should have thought that "**Somatose**" was an excellent illustration of an invented word. The decision of the Court of Appeal was reversed, and the important rule was laid down that the two sub-sections (d) and (e) of section 10 (of the Act of 1888) were alternative, as is

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(7) The following words were also refused registration on the ground that they were not invented words:—"Appollinaris" for mineral water, (In re *Apollinaris Co.*, 8 R.P.C. 137.) "Eboline" for silk goods (*Sir Titus Salt & Co.'s Application*, 11 R.P.C. 517); "Electrozone" for medicinal substances (*British Electrozone Co.'s Application*, 13 R.P.C. 447); "Pirle" for cloths and stuffs of wool, etc. (*Ripley & Sons' Application*, 15 R.P.C. 151), Kekewich, J., held, that 'Pirle' was identical in sound with 'Pearl' and that Pearl itself was a term of commendation, 'Pearl finish' being the name of a particular kind of finish. But, "Mazawatte" for tea (*Densham & Sons' Tm.*, 12 R.P.C. 75, 271) and "Kynite" for explosives (*Kynoch & Co.'s Trade Marks*, 14 B.P.C. 905) were held to be invented words.

(8) In re *Eastman Photographic Materials Co., Ltd.*, 13 R.P.C. 707; 14 R.P.C. 487; 15 R.P.C. 476.

evident from their natural grammatical construction, and should not be read conjunctively. It was clearly pointed out, that an invented word need not be meaningless, nor devoid of reference to the character or quality of the goods. In his remarkably lucid judgment Lord Herschell observed: "The word 'Solio' by itself conveys to nobody an idea. When you find it is used with regard to photographic paper you might spell it out and you might think of 'Sol' the sun, or might not, and if it were used with reference to boots, you might think it had reference to the sole of the boot, and if it were used in reference to the earth, you might think it was from "Solum" the soil, but that would depend upon the idea suggested by the connection in which it was used, and not by the word itself." Lord Chancellor Halsbury was satisfied that the word "Solio" was an invented word, and that it did not indicate the character or quality of the goods. His Lordship observed: "It certainly is a very strange thing that you should take three letters out of a word, and by the somewhat circuitous process that has been adopted here, arrive at the conclusion that it is not an invented word and that it does describe the character and quality of the goods."

**Lord Herschell on invented words.**—After reviewing the earlier decisions Lord Herschell said: "The vocabulary of the English language is common property, it belongs alike to all; and no one ought to be permitted to prevent the other members of the community from using, for purposes of description, a word which has reference to the character or quality of the goods. If then the use of every word in the language was to be permitted as a trade mark, it was surely essential to prevent its use as a trade mark, where such use would deprive the rest of the community of the right which they possessed, to employ that word for the purpose of describing the character or quality of goods. But with regard to words which are truly invented words—words newly coined—which have never theretofore been used—the case is as it seems to me, altogether different; and the reasons which required the insertion of the condition are altogether wanting. If a man has rightly invented a word to serve as his trade mark, what harm is done, what wrong is inflicted, if others be prevented from

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(9) Lindley, L.J., had taken the same view in the "Somatose" case where he said that in his opinion both "Somatose" and "Satinine" were invented words and that although "Satinine" might be descriptive, "Somatose" by itself did not suggest any reference to the character or quality of the goods (11 R.P.C., p. 90).



employing it, and its use is limited in relation to any class or classes of goods to the inventor". Referring to the "Satinine" case, and to Lord Justice Kay's observation on the lack of invention in that word, Lord Herschell further remarked: "It may be that the word, "Satinine", which was there in question, was objectionable on other grounds, but if the word be an 'invented' one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases. It may, no doubt, sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before, nor do I think that a mere variation of the orthography or termination of a word, would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form. Again, I do not think that a foreign word is an invented word, simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country, that it would suggest no meaning except to a few scholars, might not be regarded as an invented word. It is in this respect that I desire to qualify my assent to Lord Justice Smith's proposition that an invented word could never have a meaning."

**Lord Macnaghten's judgment.**—In equally forceful language Lord Macnaghten observed: "The Act of 1883 made the substituted expression 'an invented word or words' a separate, independent, and sufficient condition of registration. . . . But the word must be really an invented word; nothing short of invention will do. On the other hand, nothing more seems to be required. If it is an invented word—if it is 'new and freshly coined' it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods. . . I do not think that it is necessary that it should be wholly meaningless. . . . The object of putting a restriction on words capable of being registered as trade marks was to prevent persons appropriating to themselves that which ought to be open to all. There is a 'perpetual struggle' going on as Lord Justice Fry has observed, 'to enclose and appropriate as private property certain

little strips of the great open common of the English language. That', he added, 'is a kind of trespass against which I think the courts ought to set their faces.' And I think the Legislature has set its face against it both in the Act of 1883 and in the Act of 1888. There is little danger of the apprehended mischief if invention is required as a condition of registration. After all, invention is not so very common."

**Result of decision in the "Solio" case.**—The decision of the House of Lords in the "Solio" case forms a land-mark in the history of Trade Marks Law. To realise the significance of this decision one has to consider not only the very large number of invented words that were placed on the register in the next few years but also the nature of most of them. While on the one hand there came into existence marks like "Kodak" which would have obtained registration in any case, some of the new marks like "alundum," "tachtype," "neostyle," and "lactobacilline" would never have found their way to the register, but for the decision in the "Solio" case. In the "Savonol" case,<sup>10</sup> the claim of invention in respect of the word "Savonol" for soap was disputed on the ground that the French word "Savon" was for many years known in England and used in connection with a number of toilet soaps and that the addition of "ol" was a trifling variation. Following Lord Macnaghten's judgment in the "Solio" case, Buckley, J., held that "Savonol" was by itself meaningless and was an invented word.

**Sirumal v. Emperor.**—The importance of the decision in the "Solio" case as regards Indian trade marks can hardly be over-emphasised. The leading Indian case in this connection is *Sirumal v. Emperor*.<sup>11</sup> It was contended that the word "Aguerine" was only a combination of two well-known English words "Ague" and "Rine," and could not, therefore, constitute an invented word having no reference to the character or quality of the goods. After referring to the English decisions the learned Judge observed: "The word 'Aguerine,' not being an ordinary English word, nor a combination of two ordinary English words, must be regarded as a fit subject for trade mark. . . . The test of an invented word is that, it must have been substantially new at the date of registration; or have been substantially new when first used by the applicant, and have been only used to denote his goods

(10) *Field, Ltd. v. Wagel Syndicate, Ltd.*, 17 R.P.C. 266.

(11) A.I.R. 1932 Sind 94, Mehta, A.J.C.

down to the date of registration. It is not necessary that its production should have involved any great ingenuity or anything like 'invention' in the sense in which the test is used in patent law."

**Real invention essential.**—From the above judgments it is clear that while on the one hand the quantum of invention is immaterial, a mere semblance of invention will not qualify a mark for protection. A mere variation of a well-known word, or the addition of a common termination, does not make an invention, e.g., "piano" and "pianette", "absorb" and "absorbine", "console" and "consolette." Mere novelty is not enough to constitute invention, and a word mark does not become distinctive, merely because it was not in the language before. This point was particularly emphasised by Lord Shand in his judgment in the "*Solio*" case.<sup>12</sup> "There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short or meaningless syllable added to it, or a mere combination of two known words, would not be an "invented" word; and a word would not be "invented" which, with some trifling additions or very trifling variation, still leaves the word one which is well-known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word." It makes no difference whether a word "is spelt phonetically, fantastically or conventionally".<sup>13</sup> Again, a word cannot be said to be an invented word if it was already in existence although the claimant was not aware of its existence.<sup>14</sup>

**Words held not to be invented.**—The following words have been held to be not invented:—

Formalin,<sup>15</sup> Uneeda<sup>16</sup> (phonetically equivalent to "you need

(12) 15 R.P.C. 476; See also observations of Parker, J., in *Philippart v. William Whiteley, Ltd.*, 25 R.P.C. 565.

(13) *Per* Farwell, L.J., in "*Orlwoola*" *Trade Marks case*, 26 R.P.C. 850 at p. 863.

(14) *Sir Titus Salt & Co.'s Application*, 11 R.P.C. 517. "If it were otherwise the fewer words a man knows the more readily could he invent. What the Act requires is that the word should be an invented word in fact, and not merely in the belief of the person claiming to register it as a trade mark", (Chitty, J.).

(15) *Formalin Hygienic Co. Ltd.'s Application*, 17 R.P.C. 486.

(16) *National Biscuit, Co.'s Application*, 18 R.P.C. 170.

a''), Panoram<sup>17</sup> (suggesting panorama, panoramic), Haematogen,<sup>18</sup> Absorbine,<sup>19</sup> Bioscope,<sup>20</sup> Cyclostile,<sup>21</sup> Diabolo<sup>22</sup> (variant of an Italian word for a game), Orlwoola<sup>23</sup> (mis-spelling of "all wool"), Arsenoid,<sup>24</sup> Gnidroc<sup>25</sup> (the letters in Cording written in the reverse order), Ogee<sup>1</sup> (phonetically equivalent to O.G.), Eanco<sup>2</sup> (phonetically equivalent to E. & Co.), Aluminox<sup>3</sup> (abbreviation of aluminum oxide), Wetordry<sup>4</sup> (a mere juxtaposition of the words wet or dry) Fanfold.<sup>5</sup>

**Words held to be invented.**—The following were on the other hand held to be invented words:—

Savonol,<sup>6</sup> Tachtype,<sup>7</sup> Neostyle,<sup>8</sup> Kodak,<sup>9</sup> Vezet,<sup>10</sup> Lactobaciline,<sup>11</sup> Parlograph,<sup>12</sup> Stanwal,<sup>13</sup> Alundum,<sup>14</sup> Sardovy.<sup>15</sup>

(17) *Kodak, Ld. v. London Stereoscopic and Photographic, Co., Ld.*, 20 R.P.C. 337.

(18) *Hommel v. Bauer & Co.*, 21 R.P.C. 576; 22 R.P.C. 43.

(19) *Christy & Co. v. Tipper & Sons*, 21 R.P.C. 97, 755.

(20) *Warwick Trading, Co., Ld. v. Urban*, 21 R.P.C. 240.

(21) *Gestetner's Trade Mark*, 24 R.P.C. 545.

(22) *Philippart v. William Whiteley, Ld.*, 25 R.P.C. 565.

(23) "Orlwoola" *Trade Marks*, 26 R.P.C. 850.

(24) *Yalding Manufacturing Co., Ld.'s Application*, 33 R.P.C. 285.

(25) *Cording (Geo.) Ld.'s Trade Mark*, 33 R.P.C. 70, 83, 325. The mark was eventually registered as "Nidroc" by dropping the first letter 'G'.

(1) *Garrett's Applications*, 33 R.P.C. 48, 117; "Ogee" was shown to be a dictionary word and a term well-known in architecture and carpentry.

(2) *Eisman & Co. (London), Ld.'s Application*, 27 R.P.C. 134.

(3) *The Salter Paint and Colour Co.'s Application*, 40 R.P.C. 402.

(4) *Minnesota Mining and Manufacturing Co.'s Application*, 41 R.P.C. 237.

(5) *Fanfold Ld.'s Application*, 45 R.P.C. 199, 325.

(6) *Field Ld.'s Application*, 17 R.P.C. 266.

(7) *The Linotype Co.'s Application*, 17 R.P.C. 380.

(8) *Neostyle Manufacturing Co., Ld.'s Trade Mark*, 20 R.P.C. 329.

(9) *Kodak, Ld. v. London Stereoscopic and Photographic, Co., Ld.*, 20 R.P.C. 337.

(10) *Verschur and Zoon's Application*, 22 R.P.C. 568. It was contended that the letters "V.Z." were the initials of the name of the firm and would be pronounced "Vee Zet" in Dutch. Registration allowed with a disclaimer of the letters "V.Z."

(11) *Application of Societie le ferment*, 29 R.P.C. 497.

(12) *Lindstroem Aktiengesellschaft's Application*, 31 R.P.C. 261.

(13) *Standard Woven Fabric Co.'s Application*, 35 R.P.C. 53. It was alleged that the word sounded like "standwell" and that there was a village by the name of "standwell" with which the mark was likely to be confused.

(14) *Norton Co.'s Application*, 36 R.P.C. 153.

(15) *Brown, Wills and Nicholson's Application*, 41 R.P.C. 171.

**Ordinary Word Marks.**—Since 1888 ordinary words in common use can be registered in England. But to constitute valid trade marks they should be “words having no reference to the character or quality of the goods”. It is further essential that such word should not be, “according to its ordinary signification, a geographical name or a surname.”<sup>16</sup> The principle of refusing registration to words, descriptive of the goods, has never been questioned, for the obvious reason, that the grant of legal protection to them, would cut at the very root of Trade Mark Law, by denying the natural right of the trading public to use the ordinary language, for the *bona fide* description of their goods, or their place of business.<sup>17</sup> Fair commerce would then be hampered by the creation of absurd monopolies in ordinary words, and the traders, far from having a wide field to choose their marks from, would find themselves excluded from access to, what has been picturesquely described, as the “great open common of the English language”.

Marks consisting of ordinary words may be divided into two groups, (i) descriptive of the goods, and (ii) non-descriptive of the goods. The former may be descriptive of the articles, of the composition, type or design, quality or grade, or may indicate the mode of manufacture, the name of maker, or the origin or the trade source of the goods.

In deciding whether a word is descriptive it must be looked at as a whole and it must be judged by the impression it conveys to the ear as well as to the eye.<sup>18</sup> Thus in the “*Orlwoola*” case,<sup>19</sup> in refusing registration on the ground that “all wool” or “all woolly” could not be distinctive for woollen goods, Lord Justice Farwell observed: “It is said that to the eye ‘Orlwoola’ and ‘all wool’

(16) See Section 9 (4) of the English Act.

(17) The law has been clearly laid down by Lord Herschell in his judgment in the “*Solio*” case. See also Herschell Committee’s report, an extract from which was quoted by Lord Halsbury, L. C. in the same case, *vide* 15 R.P.C. at pp. 481, 482.

(18) See also Chapter VI. “There is one important distinction between word marks and other marks. The former appeal to the ear as well as, and indeed more than, to the eye. The latter appeal to the eye only” per Cozens-Hardy, M.R., “*Orlwoola*” *Trade Mark*, 26 R.P.C. at p. 855.

(19) “*Orlwoola*” *Trade Marks*, 26 R.P.C. 681, 850. See also *National Biscuit Co.’s Application*, 18 R.P.C. 170; 19 R.P.C. 281, where “*Uneeda*” was rejected as it was phonetically equivalent to “you need a”. It would appear, however, that “*Uneeda*” was subsequently registered under the Act of 1905, *vide* 26 R.P.C. p. 853.

are quite distinct, but that is not enough, the mark is not pictorial, but verbal, and the words are meant to be spoken, as well as read."

**Marks held to be descriptive of the goods.**—The following have been held to be words having reference to the character or quality of the goods to which they are applied:—

"Washerine"<sup>20</sup> for laundry preparation; "Painkiller"<sup>21</sup> for a medicine; "Native Guano"<sup>22</sup> for manure; "Edge's Filtered Blue"<sup>23</sup> for laundry blue; "Parchment Bank" for paper;<sup>24</sup> "John Bull"<sup>25</sup> for fermented liquors and spirits; "Carters Little Liver Pills";<sup>1</sup> "Desiccated Soup";<sup>2</sup> "Roadster"<sup>3</sup> for boots and shoes; "Magnolia"<sup>4</sup> for metals and metal bearings; "Emollio"<sup>5</sup> for cream; "Monobrut"<sup>6</sup> for champagne; "Typographs"<sup>7</sup> for metals and type making machines; "Pirle"<sup>8</sup> (misspelling of Pearl which was descriptive of a kind of finish) for cloth; "Cellular"<sup>9</sup> for cloth and clothing; "Nector"<sup>10</sup> for tea, coffee and cocoa; "Uneeda"<sup>11</sup> (equivalent to "you need a") for biscuits; "Bioscope"<sup>12</sup> for cinematographic apparatus; "Hæmatogen"<sup>13</sup> for medicine; "Century"<sup>14</sup> for machinery of several kinds; "Orlwoola"<sup>15</sup> (mis-

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(20) *Burland's Trade Mark*, 6 R.P.C. 482.

(21) *Perry Davis v. Harbord*, 7 R.P.C. 336.

(22) *Native Guano Co. v. Sewage Manure Co.*, 8 R.P.C. 125.

(23) *Edge's Trade Mark*, 8 R.P.C. 207.

(24) *Pirie & Sons v. Goodall & Sons*, 8 R.P.C. 261.

(25) *Paine's Trade Mark*, 9 R.P.C. 130.

(1) *Carter Medicine Co.'s Trade Mark*, 9 R.P.C. 401.

(2) *Frederick King & Co.'s Trade Mark*, 9 R.P.C. 350.

(3) *Thompson v. Miller*, 13 R.P.C. 35.

(4) *Magnolia Metal Co.'s Trade Marks*, 14 R.P.C. 265, 621. Magnolia was shown to be the name of the particular patented alloy of which the goods in question were made. It was the only name by which the alloy was known.

(5) *Grossmith's Trade Mark*, 6 R.P.C. 180.

(6) *Vignier's Trade Mark*, 6 R.P.C. 490.

(7) *Linotype Co.'s Application*, 14 R.P.C. 900. "Typograph" was a dictionary word meaning type making or type setting machine.

(8) *Bipley's Application*, 15 R.P.C. 151.

(9) *Cellular Clothing Co. v. Maxton & Murray*, 15 R.P.C. 581; 16 R.P.C. 397.

(10) *Harrison & Crossfield's Application*, 18 R.P.C. 34.

(11) *National Biscuit Co.'s Application*, 18 R.P.C. 170; 19 R.P.C. 281.

(12) *Warwick Trading, Co., Ltd. v. Urban*, 21 R.P.C. 240.

(13) *Hommel v. Bauer & Co.*, 21 R.P.C. 576.

(14) *Printing Machinery Co., Ltd.'s Application*, 23 R.P.C. 38.

(15) *"Orlwoola" Trade Marks*, 26 R.P.C. 681, 850.

spelling of "All wool") for clothing; "Diamine"<sup>16</sup> for dyes; "Standard"<sup>17</sup> for sanitary and toilet appliances; "Ribbon"<sup>18</sup> for dental cream; "Classic"<sup>19</sup> for Christmas Cards; "Gripe Water"<sup>20</sup> for a palliative for gripes; "Victor"<sup>21</sup> for hack saw blades; "Aluminox"<sup>22</sup> (aluminum oxide) for paints, varnishes, enamels, etc.; "Wetordry"<sup>23</sup> for abrasives such as sand paper, glass paper, or emery paper; "Charm"<sup>24</sup> for ladies' stockings; "Palmolive"<sup>25</sup> for soap.

**Not descriptive.**—On the other hand, the following words have been held to have no direct reference to the character or quality of the goods:—

"Brownie" and "Bullseye"<sup>1</sup> for films; "Quaker"<sup>2</sup> for fermented liquors; "Lactobacilline"<sup>3</sup> for milk ferment; "National"<sup>4</sup> for cash registering machines, etc.; "Regimental"<sup>5</sup> for cigarettes; "Trilby"<sup>6</sup> for gloves, ladies' blouses, etc.

**Geographical names as Trade Marks.**—Geographical names are, as a class, not suited for use as Trade Marks. The reason for this, as explained by the Herschell Committee, is that a geographical

(16) *(Leopold) Cassella & Co.'s Application*, 27 R.P.C. 453.

(17) *Standard Ideal Co. v. Standard Sanitary Manufacturing Co.*, 27 R.P.C. 789.

(18) *Colgate & Co.'s Application*, 30 R.P.C. 262.

(19) *Sharpe, Ld. v. Solomon Bros., Ld.*, 31 R.P.C. 441; 32 R.P.C. 15.

(20) *Woodward, Ld. v. Boulton Macro, Ld.*, 32 R.P.C. 173.

(21) *Massachusetts Saw Works' Application*, 35 R.P.C. 137.

(22) *The Salter Paint and Colour. Co.'s Application*, 40 R.P.C. 402.

(23) *Minnesota Mining and Manufacturing Co.'s Application*, 41 R.P.C. 237. The word was held to suggest that the abrasive could be used wet or dry and it was in fact waterproof.

(24) *Keystone Knitting Mills Ld.'s Trade Mark*, 45 R.P.C. 193, 421.

(25) In the matter of a trade mark "*Palmolive*", 49 R.P.C. 269.

(1) *Kodak, Ld. v. London Stereoscopic and Photographic Co., Ld.*, 20 R.P.C. 337.

(2) *Ellis & Co.'s Trade Marks*, 21 R.P.C. 617.

(3) *Application of La Society le ferment*, 29 R.P.C. 497.

(4) *National Cash Register Co.'s Application*, 34 R.P.C. 273, 354. Secondary signification of the word "National" was established. Registration of the word "National" for metal hollow-ware goods was refused in *National Galvanizers. Ld.'s Application*, 37 R.P.C. 202, as secondary signification was not established.

(5) *Imperial Tobacco Co., Ld.'s Trade Marks*, 35 R.P.C. at p. 209 (Duke, L.J.). The decision of the Court of Appeal was based, however, on a different ground, *viz.*, that the original registration was valid under section 41.

(6) *Holt & Co.'s Trade Mark*, 13 R.P.C. 118, Lindley & Smith, L. J.J. (Kay, L.J., dissenting). "Trilby" was shown to be the name of the heroine in a novel.

name though not indicating the source of the goods in question, must, nevertheless, be open to rival traders, at all times, to describe similar goods coming from, or manufactured, or sold at that place. But it is only when the general and popular signification of the word in question is geographical, that it cannot constitute a valid trade mark. Thus in the *Magnolia case*<sup>7</sup> where the word was objected to on the ground, that there were places in the United States by that name, Lord Justice Rigby observed: "A word does not become a geographical name simply because some place on the earth's surface has been called by it. For example we agree with Mr. Justice Kekewich that the word 'monkey' is not proved to be a geographical name by showing merely that a small, and by no means generally known, island has been called by that name. If, indeed, in its primary and obvious meaning, the word has reference to a locality as in the word 'Melrose' in Van Duzer's case, or the word 'Eboline' in Sir Titus Salt & Co.'s case . . . it may well be a geographical name within the meaning of the sub-section.<sup>8</sup> Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real, or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word 'Apollinaris Spring'. So if 'Magnolia' had been the name of a place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name."

That geographical names though unsuitable as a class, may, in special cases, be capable of appropriation as trade marks was emphasised by Lord Moulton, in the following passage<sup>9</sup>:—"No man has got a right to take Dundee as a trade mark; the people of Dundee have a right to use that, with a freedom which renders it quite unsuitable for the special appropriation, which is signified by its being adopted as the trade mark of any one firm. But, on the other hand, it is perfectly clear that there are some geographical names which would make excellent trade marks. Suppose a

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(7) *Magnolia Metal Co.'s Trade Marks*, 14 R.P.C. 621.

(8) See Sec. 10 (c) of the Act of 1883. Cf. Sec. 9 (4) of the Act of 1905, where the words "according to its ordinary signification" were inserted as a result of the decision in the "*Magnolia*" case.

(9) *Trans. Inst. Pat. Agents XXIV. p. 43 (1905).*



man chose to sell a brand of cigarettes which he called 'Matterhorn' cigarettes or 'Monte Rosa' cigarettes, nobody could say that he was not using a perfectly legitimate trade mark." Thus in the *Liverpool Electric Cable Company's case*<sup>10</sup> it was held by the Court of Appeal that in considering whether a geographical name is registrable, both the locality and the goods must be taken into consideration, and that the name of such an important commercial centre as Liverpool, even though it might in fact be distinctive of the goods in respect of which it was sought to register it, was not registrable. The objection to geographical names extends to their adjectival forms and variations.<sup>11</sup>

The following are examples of words held to be geographical:—"Brymbo"<sup>12</sup> metal; "Apollinaris"<sup>13</sup> mineral water; "Eboline"<sup>14</sup> silk-goods; "Worcester"<sup>15</sup> corsets; "Hopton Wood"<sup>16</sup> stone; "Ghazi-pore"<sup>17</sup> rose water.

The following words were, on the other hand, held not to be geographical:—"El Destino"<sup>18</sup> cigars; "Mazawatte"<sup>19</sup> tea; "Magnolia"<sup>20</sup> metal; "St. Raphael"<sup>21</sup> medicinal wine; "Chartreuse"<sup>22</sup> liqueur; "Berna"<sup>23</sup> motor cars; "Stanwal"<sup>24</sup> rubber goods.

**Secondary signification.**—Although a descriptive word is *prima facie* not adapted to distinguish the goods of any one trader, it may, under certain circumstances, lose its primary descriptive

(10) *Liverpool Electric Cable Co. Ltd.'s Application*, 46 R.P.C. 99. See also *Price's Patent Candle Co., Ltd. v. Ogston and Tennant, Ltd.*, 26 R.P.C. 797; *Venkatachalam v. Rajagopala Naidu*, 55 Mad. 966.

(11) *Sir Titus Salt Bart Sons & Co.'s Application*, 11 R.P.C. 517. "Eboline" was refused registration although the word had been coined in ignorance of the town "Eboli" in Italy.

(12) *Batt & Co's Trade Mark*, 6 R.P.C. 493.

(13) *Apollinaris Co.'s Trade Mark*, 8 R.P.C. 137.

(14) *Sir Titus Salt Bart Sons and Co.'s Application*, 11 R.P.C. 517.

(15) *Royal Worcester Corset Co.'s Application*, 26 R.P.C. 185.

(16) *Hopton Wood Stone Firms, Ltd. v. Gething*, 27 R.P.C. 605.

(17) *Balladin and Alladin Firm v. Puranmul Balbehari Lall*, A.I.R. 1915 Low. Bur. 123; 30 I.C. 633; 8 Bur.L.T. 113.

(18) *Pinto v. Trott*, 8 R.P.C. 173; *Pinto v. Badman*, 8 R.P.C. 181.

(19) *Densham & Son's Trade Mark*, 12 R.P.C. 75, 271.

(20) *The Magnolia Metal Co.'s Trade Marks*, 14 R.P.C. 621.

(21) *Clement et Cie's Trade Mark*, 16 R.P.C. 173, 611.

(22) *Rey v. Lecouturier*, 25 R.P.C. 265.

(23) *Berna Commercial Motors' Application*, 32 R.P.C. 113. Sarjant, J., refused to identify it with the town of Berne in Switzerland.

(24) *Standard Woven Fabric Co.'s Application*, 35 R.P.C. 53.

meaning, and acquire a special significance as denoting the goods of a particular trader. As Lord Justice Fletcher Moulton observed in his historic judgment in the *Perfection case*:<sup>25</sup> "It often occurs in trade that by continued user words get recognised as denoting the goods of a particular firm. These words may in themselves be unsuitable to be chosen as trade marks, but they have in fact become so." Such words are said to have acquired a secondary signification in connection with the goods of that particular firm. It will generally be very difficult to prove, that an ordinary descriptive word has lost its primary meaning, and has become distinctive of the goods of a particular trader. But, where proof of secondary signification is established, the mark is entitled to legal protection,<sup>1</sup> irrespective of the nature of the mark. In a well-known case,<sup>2</sup> Lord Parker said: "Independently of any Trade Mark legislation, whenever a person uses upon, or in connection with his goods, some mark which has become generally known to the trade or the public as his mark, and thus operates to distinguish his goods from the goods of other persons, he is entitled in equity to an injunction against the user of the same or any colourable imitation of the same mark, in any manner calculated to deceive the trade or the public. Equity has never imposed any limitation on the kind of mark entitled to this protection, but in every case it has to be proved that the mark has by user become in fact distinctive of the plaintiff's goods." The question of secondary signification in its bearing on the plaintiff's right to a passing-off action will be taken up in another Chapter. Whether a word has acquired secondary signification or not is a question of fact and will generally depend on the nature, extent and duration of the user. "The extent to which the court will require the proof of this acquired distinctiveness to go will depend on the nature of the case. If the objections to the word itself are not very strong it will act on less proof of acquired distinctiveness

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(25) 26 R.P.C. 854 at pp. 856-857.

(1) Such marks may not, however, be eligible for registration. As Lord Parker said: "A common law mark is still not necessarily registrable. If the tribunal finds that a mark is anywhere, or among any class of people, in fact distinctive of the goods of the applicant, it may be influenced by this fact in determining whether it is adapted to distinguish these goods from those of other persons, but distinctiveness in fact is not conclusive". *W. and G. du Cross Ltd.'s Application*, 30 R.P.C. at p. 673. See also *The Liverpool Electric Cable Co.'s Application*, 46 R.P.C. 99; *Hans Lawitzsen's Application*, 48 R.P.C. 392; In the matter of a trade mark "*Palmolive*," 49 R.P.C. 269.

(2) *W. and G. du Cross Ltd.'s Application*, 30 R.P.C. at p. 672.

than it would require in the case of a word which in itself was open to grave objection.”<sup>3</sup>

An excellent illustration of this principle is afforded by the well-known case of *Reddaway v. Banham*.<sup>4</sup> The mark “Camel Hair Belting” was shown to be descriptive of the article in question as the belting was made principally from camel hair. It was, nevertheless, held that owing to extensive user the words never meant to the trade belting made of camel hair but only denoted Reddaway’s belting. The words thus constituted a valid common law mark, and protection was accordingly granted. Similarly, in *Smidt v. Reddaway & Co.*,<sup>5</sup> Ameer Ali, J., held that the words “Camel hair” had acquired a secondary signification in India in connection with Reddaway’s belting, and his decision was affirmed on appeal. Again, in *Badische Aniline and Soda Fabrik v. Farbenfabriken Bayer & Co., Ltd.*,<sup>6</sup> the court observed: “If once the plaintiffs establish, that the particular device, be it words or letters, whatever the device may be, if the plaintiffs once establish that the device indicates the plaintiffs’ manufacture, so that any one seeing that device upon that article, would be justified in concluding that he is purchasing goods of the plaintiffs’ manufacture, then this court will protect the plaintiffs against not only the use of the particular device, but against any imitation of that device, which imitation is likely to cause deception of the public.”

In the cases of the following words it was held that secondary signification was established:—

“Silverpan”<sup>7</sup> for jam; “K.M.S.”<sup>8</sup> for pottassium (kalium) meta sulphite; “Fruit salt”<sup>9</sup> for an aperient; “Club Soda”<sup>10</sup> for aerated water; “Valentine”<sup>11</sup> for a meat preparation; “Dunlop”<sup>12</sup>

(3) 26 R.P.C. at p. 858, per Fletcher Moulton, L.J., “Perfection” case.

(4) 13 R.P.C. 218. See Chapter VI where this case is discussed in greater detail.

(5) 32 Cal. 401.

(6) 6 Bom. L.R. 407.

(7) *Faulder & Co., Ltd. v. O. C. Rushton, Ltd.*, 20 R.P.C. 477.

(8) *Boake, A. Roberts & Co., Ltd. v. Wayland & Co.*, 26 R.P.C. 251.

(9) *Eno v. Dunn & Co.*, 10 R.P.C. 261.

(10) *Sir S. Cochrane v. McNish & Son*, 13 R.P.C. 100.

(11) *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R.P.C. 673.

(12) *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor. Co., Ltd.*, 22 R.P.C. 533.

for motor tyres; "Horse Shoe"<sup>13</sup> for boilers; "Thorley's Food"<sup>14</sup> for cattle; "Lawson Tait"<sup>15</sup> for bedsteads; "California Syrup of Figs"<sup>16</sup> for laxatives.

The extreme difficulty of proving that an ordinary descriptive word has acquired secondary signification was emphasised by Lord Davey in the *Cellular Clothing Company's case*.<sup>17</sup> It was held that the term "Cellular" although not used before, was merely descriptive of the quality of the cloth and did not denote exclusively the clothing of any particular manufacturer. Further examples of words where the alleged secondary signification could not be established are:—

"Chivers"<sup>18</sup> for jelly; "Slipon"<sup>19</sup> for coats; "Guaranteed"<sup>20</sup> for corsets; "Shorland"<sup>21</sup> for shoes; "Hæmatogen"<sup>22</sup> for medicinal preparation of that name; "American shoes"<sup>23</sup> "Ripley's oval blue"<sup>24</sup> for laundry blue; "Naptha soap";<sup>25</sup> "Vacuum cleaner";<sup>1</sup> "Automatic Aerators";<sup>2</sup> "Flaked oat-meal";<sup>3</sup> "Gripe Water";<sup>4</sup> "Malted Milk";<sup>5</sup> "White Jelly Crystals"<sup>6</sup> for confectionery.

(13) *Kinnell & Co., Ltd. v. Ballantine & Sons*, 26 R.P.C. 12.

(14) *Massam v. Thorley's Cattle Food Co.*, (1880) 14 Ch.D. 748.

(15) *Whitfield's Bedsteads Ltd.'s Application*, 26 R.P.C. 657.

(16) *California Fig Syrup Co.'s Application*, 26 R.P.C. 436.

(17) *Cellular Clothing Co. v. Maxton & Murray*, 15 R.P.C. 581; 16 R.P.C. 397.

(18) *Chivers and Sons v. Chivers & Co., Ltd.*, 17 R.P.C. 420.

(19) *Burberrys v. Cording & Co., Ltd.*, 26 R.P.C. 693.

(20) *Symington & Co. v. Footman Pretty & Co.*, (1885) 56 L.T. 696.

(21) *Gamage (A.W.), Ltd. v. Randall (H.E.), Ltd.*, 16 R.P.C. 185.

(22) *Hommel v. Bauer & Co.*, 22 R.P.C. 43.

(23) *Randall, Ltd. v. Bradley & Son*, 24 R.P.C. 657, 772.

(24) *Ripley v. Griffiths*, 19 R.P.C. 590.

(25) *Fels v. Christopher Thomas & Bros.*, 21 R.P.C. 85. See also *Fels v. Stephenson Bros, Ltd.*, 20 R.P.C. 443; 21 R.P.C. 89; *Fels v. Hedley & Co., Ltd.*, 20 R.P.C. 437; 21 R.P.C. 91.

(1) *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, 24 R.P.C. 641.

(2) *Aerators, Ltd. v. Tollit*, 19 R.P.C. 418.

(3) *Parsons Bros. & Co. v. John Gillespie & Co.*, (1898) A.C. 239; 15 R.P.C. 57.

(4) *Woodward, Ltd. v. Boulton Macro, Ltd.*, 32 R.P.C. 173.

(5) *Hortick's Malted Milk Co. v. Summerskill*, 34 R.P.C. 63.

(6) *White Tomkins and Courage, Ltd. v. United Confectionary Co., Ltd.*, 31 R.P.C. 430.

**Geographical names and secondary signification.**—The same considerations apply as regards secondary signification of geographical names. Thus in *McAndrew v. Bassett*,<sup>7</sup> which was decided as early as 1864, the word “Anatolia” was held to have acquired secondary signification in connection with the plaintiff’s liquoreice, although in its primary sense it indicated the origin of the product. So also in *Seixo v. Provezende*<sup>8</sup> the word “Seixo” which was the name of a district, was proved to have acquired secondary signification for wine. In the well-known *Glenfield Starch case*,<sup>9</sup> a starch manufacturer whose factory was originally located at Glenfield continued the use of the name “Glenfield” on his labels even after he removed to another locality. A rival manufacturer acquired the site of the old factory at Glenfield, and sold his starch with the word “Glenfield” appearing prominently on his labels. In an action for passing-off, the House of Lords held that “Glenfield” in connection with starch, denoted exclusively the plaintiffs’ manufacture. In *Montgomery v. Thompson*,<sup>10</sup> which is another well-known case, the words “Stone ale” were held to be associated exclusively with the plaintiff’s ale.

A few other examples of geographical words that have acquired a secondary signification are given below:—

“Reading”<sup>11</sup> for biscuits; “Yorkshire Relish”<sup>12</sup> for sauce; “Hunyade”<sup>13</sup> for mineral water; “Dindigul”<sup>14</sup> for cigars; “Worcester”<sup>15</sup> for china and porcelain; “Apollinaris”<sup>16</sup> for mineral water; “Oswego”<sup>17</sup> for corn flour; “London Candles”;<sup>18</sup> “California Syrup of Figs”<sup>19</sup> for medicinal preparation; “Itala”<sup>20</sup>

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(7) (1864) 4 De G. J. & S. 380.

(8) (1866) L.C. 1 Ch. 192.

(9) *Wotherspoon v. Currie*, L.R. 5 H.L. 508.

(10) 8 R.P.C. 361.

(11) *Huntley & Palmer v. The Reading Biscuit Co., Ltd.*, 10 R.P.C. 277.

(12) *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, 12 R.P.C. 496; 13 R.P.C. 235; 14 R.P.C. 720.

(13) *Saxlehner v. Apollinaris Co.*, 14 R.P.C. 645.

(14) *Bewlay & Co., Ltd. v. Hughes*, 15 R.P.C. 290.

(15) *Worcester Royal Porcelain Co., Ltd. v. Locke & Co.*, 19 R.P.C. 479.

(16) *Apollinaris Application*, In re, 24 R.P.C. 436.

(17) *National Starch Co.’s Application*, 25 R.P.C. 802.

(18) *Price’s Patent Candle Co., Ltd. v. Ogston Tennant, Ltd.*, 26 R.P.C. 797.

(19) *California Fig Syrup Co.’s Application*, 26 R.P.C. 436.

(20) *Application of Itala Fabbrica di Automobile*, 27 R.P.C. 493.

and "Berna"<sup>21</sup> for motor cars; "Liverpool Cables"<sup>22</sup>

**Laudatory words.**—A word which is merely laudatory of the goods to which it is applied cannot be claimed as exclusive property by any one trader. In the *Perfection case*,<sup>23</sup> Cozens-Hardy, M.R., observed that such laudatory words as "good", "best", "super-fine", could not acquire a secondary meaning as indicating only the goods of any particular manufacturer. His Lordship further remarked, that "an ordinary laudatory epithet ought to be open to all the world and is not capable of being registered"; and Farwell, J., added: "no amount of evidence could show that laudatory words had lost their primary meaning; and in such cases the tribunal may well refuse to admit evidence".

Whether a particular word is merely a laudatory expression or something more, will depend on the facts of each case. The principle that laudatory words as a class cannot constitute valid marks under the common law was established even as early as 1874. In *Ragget v. Findlater*<sup>24</sup> where two rival vendors of stout described their goods as "nourishing", it was held that the mark was a mere advertisement or a description of the quality of the goods and could not constitute a trade mark. After discussing the earlier authorities, Malins, V. C., observed: "I think that the whole of that proceeded on the basis that if the word had been an English word describing quality, the word merely describing the quality would not be the subject of a trade mark. My opinion is that, for the protection of the public it is necessary that a trade mark should be something beyond a mere English word denoting quality. The word "nourishing" therefore of itself will not do. If he (plaintiff) has only rested his case on the word "nourishing" I am clearly of opinion that that is no trade mark and on that ground I think his case wholly fails".

It may be noted here that while certain expressions are laudatory in their application to all kinds of goods, there are others which are so only when used in connection with certain goods.

(21) *Commercial Motors, Ltd.'s Application*, 32 R.P.C. 113.

(22) *Liverpool Electric Cable, Co., Ltd.'s Application*, 46 R.P.C. 99.

(23) *Joseph Crosfield & Sons, Ltd.'s Application*, 26 R.P.C. 837.

Registration of the word "Perfection" for soap was refused by the Court of Appeal although the word had become distinctive of the applicants' soap in many parts of England.

(24) (1874) L.R. 17 Eq. 29; 43 L.J.Ch. 64; Seb. Dig. p. 258.

To the former may be said to belong words like "best", "excellent", "superior", "superfine", "standard".<sup>25</sup> On the other hand, it was held that the word "health" though merely a commendatory epithet for cocoa might not be so when applied to fishing rods.<sup>1</sup>

**Chemical names.**—Where a word is the only practicable name of a chemical element or compound, it is obvious that no one should be allowed an exclusive monopoly of it and registration is accordingly refused in England to such words.<sup>2</sup> In *Cassella & Co.'s Application*.<sup>3</sup> Neville, J., allowed registration of the word "diamine", as it had acquired secondary signification with the applicants' dyes, but this order was discharged by the Court of Appeal, on the ground, that notwithstanding long user, a known technical English word indicating a certain composition of the article to which it is applied, could not acquire secondary meaning, and that the applicants' use of the word for dyes containing no amino groups would be misleading. Buckley, L. J., after referring to the 'Perfection' case, observed, that the principle that certain words ought to be open to all the world was not confined to laudatory epithets, but extended "so as to forbid the appropriation by one trader of any word forming part of the common stock of the English language, unless the word is one adapted to distinguish the goods." Kennedy, L.J., went further: "It is, I think, in one respect a stronger case for the court's refusal to sanction registration where the word which the trader seeks to monopolise is, as here, descriptive of a chemical quality, as applied to goods, which, as in the present instance, do not possess the quality, than where, as in *Crosfield's case*, the word which it is sought to register is simply a laudatory substantive or adjective, for its use, in the former case, may actually deceive."

(25) *Standard Ideal Co. v. Standard Sanitary Manufacturing Co.*, 27 R.P.C. 789. "The word 'Star' is one of those few words of universal use which could hardly be appropriated by any one of mankind that it must be a part of the common stock-in-trade for naming articles and especially for naming them with a view to praise them." Wright, J., in *Dexter's Application*, 10 R.P.C. 269. Followed, *Adamjee Hajee Dawood & Co., Ld. v. Swedish Match Co.*, A.I.R. 1928 Rang. 210.

(1) *Thorne (Henry) & Co., Ld. v. Eugen Sandow and Sandow, Ld.*, 29 R.P.C. 440. See also *Keystone Knitting Mills, Ld.'s Trade Mark*, 45 R.P.C. 193, 421, where "charm" was held to be commendatory for ladies' stockings. In *Connor's Application*, 41 R.P.C. 458, Tomlin, J., said that "Sterling" is not one of those words which cannot be distinctive.

(2) See Section 6 (2) of the Act of 1919.

(3) 27 R.P.C. 453.

An analogous case is that of *Upendra Nath Brahmachari v. Union Drug Co., Ltd.*,<sup>4</sup> which came before the Calcutta High Court. It was contended that the name "Urea stibamine" for an antimony compound discovered by the plaintiff for the treatment of Kala-azar, was a chemical name descriptive of the drug in question, and could not therefore be monopolised. It was argued for the plaintiff that the word had, and would convey, no chemical meaning whatever, and that having regard to the constitution of the compound, namely paraminophenyl stibinate, the name "Urea stibamine" was purely a fancy or invented word such as Stibanyl, Stibosan, Aminostiburea (of the defendants), etc. An interlocutory injunction was granted by Ghosh, J., on the ground that the word "Urea stibamine" was a fancy or invented word, and that the compound designated by that word had a proper scientific and descriptive name. In view, however, of the decision in the "Diamine" case cited above, it is doubtful whether the above judgment represents correct law.

**Foreign words.**—The question has often arisen before the courts whether a foreign word can constitute a trade mark. The answer depends on the facts of each case. Apart from the nature of the word itself, the circumstances in which it is used will have to be taken into account, such as the kind of goods, class of purchasers and the nature of the market. In *Raggett v. Findlater*<sup>5</sup> Sir R. Malins, V. C., said: "If you use a foreign word or a word in a dead language not known to people in general, the word itself because it is not generally understood, may very reasonably become a trade mark." So also in *Seixo v. Provezende*,<sup>6</sup> Lord Chancellor Cranworth held that the plaintiff was entitled to the protection of his mark, which consisted of a crown and the word "Seixo", although it was established that the word was common in Portuguese. And in *Barlow & Jones v. Johnson & Co.*,<sup>7</sup> the word "Osman" for Turkish towels was held to be a distinctive mark for towels. In an Indian case<sup>8</sup> the name of a syrup "*Sharbat Ruh Afza*" sold by

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(4) A.I.R. 1926 Cal. 837. The "Diamine" case does not appear to have been cited. When the case came up for trial the plaintiff withdrew and the matter was not proceeded with.

(5) (1874) 17 Eq. 29; Seb. Dig. p. 258. See also *Ford v. Foster*, 7 Ch. 611; 41 L.J.Ch. 682; Seb. Dig. p. 228, where the Greek word "Eureka" for shirts was protected.

(6) (1866) L.R. 1 Ch. 192; 14 W.R. 457. See also *Rey v. Lecouturier*, 25 R.P.C. 265; 27 R.P.C. 268; "Chartreuse" for liqueur.

(7) 7 R.P.C. 395.

(8) *Unani Oswakhana v. Hamdard Dawakhana*, A.I.R. 1930 Lab. 999.



one firm, was adopted by a rival firm of druggists. It was contended that the expression was merely descriptive and laudatory, in the use of which, no one could establish an exclusive title. Currie and Tekchand, JJ., held, however, that the Persian words "Ruh Afza" could be understood only by a few educated Urdu speaking people and were not such as to preclude the acquisition of a secondary meaning.

The circumstances under which a foreign word can constitute an invented word were pointed out in the "Solio" case.<sup>9</sup> The rule was stated in the Diabolo case<sup>10</sup> by Mr. Justice Parker (afterwards Lord Parker) thus: "To be an invented word, a word must not only be newly coined, in the sense of not being already current in the English language, but must be such as not to convey any meaning, or, at any rate, any obvious meaning, to ordinary Englishmen. It must be a word having no meaning or no obvious meaning until one has been assigned to it. I use the expression 'obvious meaning' and refer to 'ordinary Englishmen' because to prevent a newly coined word from being an invented word, it is not enough that it might suggest some meaning to a few scholars. Further, while on the one hand the fact that a word may be found in the vocabulary of a foreign language does not, in itself, preclude it from being an invented word, so on the other hand a foreign word is not an invented word merely because it is not current in the English tongue." "Savonol," "Lactobacilline," Mazawattee," etc., are examples of invented words of foreign origin.

Where a foreign word is the common name by which an imported article is known, it cannot be registered as a fancy word for such article, although the name was unknown previous to the importation of the article. Thus in *Davis & Co., Ltd. v. Stribolt & Co.*,<sup>11</sup> the registered trade mark "Bokol" for beer imported from Norway, was ordered to be expunged from the register, when it was shown that it was the name of a common kind of beer in that country.

**Pictorial representations.**—In addition to name and word marks, traders are in the habit of adopting other devices such as pictorial representations, labels, tickets, numerals, letters, get-up, to arrest the attention of the purchasing public. When such devices are distinctive, they constitute valid trade marks.

(9) 15 R.P.C. 476. See the judgments of Lord Herschell and Lord Macnaghten.

(10) *Philippart v. William Whiteley, Ltd.*, 25 R.P.C. 565.

(11) 6 R.P.C. 207.

Pictorial representations have been in use from early times. These have an artistic appeal to the eye and can be easily remembered, *e.g.*, cat and barrel for beer, stars for matches, elephant for cigarettes, Johnnie Walker for whisky, ox-cart for wine. In India, where a large majority of people are illiterate, pictorial marks have a special value. Such representations are therefore extensively used by both Indian and foreign merchants. A picture mark should be distinctive in order to constitute a trade mark. But it is not necessary that there should be at least some part which is entirely new. Thus a combination of two devices of pictures, which are severally common to the trade, may form a new trade mark. The observations of Lord Herschell's Committee in this connection are extremely valuable: "We think that the juxtaposition of two or more such marks is not, if there be nothing more than this, a combination constituting a new mark. An important test appears to be whether the existing marks are so combined as to suggest a new idea. For instance, assuming a cat and a fiddle to be each an old mark, we do not think the mere representation of a cat and fiddle together would be a new mark; but the representation of a cat playing upon a fiddle, the idea conveyed by which would be neither the cat nor the fiddle but a cat playing upon a fiddle, would be a good combination, and might properly be registered." Thus, in *Wills' Trade Mark case*,<sup>12</sup> the court held that a distinctive design of a star was a good trade mark for tobacco, though other star marks were used in the trade, and in *Adamjee Haje Dawood & Co., Ltd. v. Swedish Match Co.*,<sup>13</sup> a label having five stars in a line was held to be distinctive, although three stars had been previously used as a trade mark.

Pictures that are merely descriptive cannot constitute a trade mark. But descriptiveness is not wholly incompatible with distinctiveness. In *James' Trade Marks case*<sup>14</sup> the trade mark for black lead consisted of a representation of a cylinder surrounded by a dome top, and although it was shown that the black lead was generally, though not always, sold in this shape by the plaintiffs the pictorial device was held to be a valid mark. Lord Justice Lindley

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(12) 10 R.P.C. 269.

(13) A.I.R. 1928 Rang. 210. See also *Hodgson v. Kynoch, Ltd.*, 15 R.P.C. 465, where the device of a lion in various forms and colourings was used by the plaintiffs on their soap wrappers, boxes and show cards.

(14) 3 R.P.C. 340. Cf. *Sphincter Grip Armoured Hose Co.'s Trade Mark*, 10 R.P.C. 84 where a design of a triple knot of hose was refused registration in respect of armoured hose, etc.

observed: "I cannot see why, according to English law, a fish may not be a distinctive mark of that particular kind of fish; way a pig should not be, according to English law, a distinctive mark for lard, or something made of a pig, I do not know. Supposing you turned a pig skin into a leather, I do not know why a pig should not be a good trade mark for tanned pig's hide". So also in *Emperor v. Bakaullah Mallik*<sup>15</sup> it was held, that the pictorial representation of fishes constituted a valid trade mark for fish hooks.

**Labels, tickets, etc.**—A word which in itself could not constitute a proper trade mark, would not become valid merely because of its being printed on a label or ticket affixed to the goods; nor would the addition of a conventional border or a few ornamental designs or flourishes, which are themselves well-known make the label distinctive. So, in an early Madras case,<sup>16</sup> Sir Charles Turner, C. J. and Muttusamy Ayyar, J., said: "It must not be assumed that every ornament which may be applied to the case or flask or wrapper in which goods are exposed for sale is necessarily a trade mark. Such ornaments are often employed as mere devices to arrest attention and are not intended to convey any other meaning. To constitute them trade marks they must have been adopted as symbols devised to distinguish a particular class of goods as the goods of that class manufactured or selected by a particular manufacturer or merchant." In that case their Lordships held that the label bearing a Maltese cross in red colour for brandy, was a proper trade mark.

In considering the distinctiveness of a label, it was held in many cases that a label must contain one or more distinctive particulars to qualify for registration. In *Orr Ewing case*,<sup>17</sup> Lord Cairns said: "I apprehend the first duty cast upon the court is to ascertain whether some one, or more than one, of the essential particulars of a trade mark as defined by the Act, is found to exist, so that the mark may be described with the one, or more than one, essential particular or particulars which distinguish it." And in *Bradley's Trade Mark case*,<sup>18</sup> Chitty, J., observed: "It is quite

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(15) 31 Cal. 411.

(16) *Laverne v. Hooper*, 8. Mad. 149.

(17) *Orr Ewing & Co. v. The Registrar of Trade Marks*, 48 L.J.Ch. 710; 4 App. Cas. 479.

(18) (1882) 9 R.P.C. 205. See also *Birmingham Vinegar Brewery Co.'s Application*, 11 R.P.C. 195; *Bryant & May's Trade Mark*, 8 R.P.C. 69; *Wright, Crossley & Co.'s Application*, 17 R.P.C. 386.

true that the mark must be looked at as a whole, but we must find in the whole, one at least of the essential particulars''. But, it is now well settled, that in order to constitute a distinctive label, it is not necessary that at least one of the separate particulars comprising the label should be distinctive. The label should be looked at as a whole in considering the question of distinctiveness, and not dissected and each part examined. Thus, in *Leahy, Kelly & Leahy v. Glover*,<sup>19</sup> "The Great Two D brand" label was held to be distinctive, though its component parts were not separately registrable.

**Numeral.**—According to the Trade Marks Act of 1905, numerals can be registered, if distinctive. The earliest Indian case, where the question of numerals as trade marks was considered, appears to be *Ralli v. Fleming*.<sup>20</sup> The plaintiffs had been importing from Manchester and selling grey shirtings, which were marked with the figure of a turtle in a star and the number '2008'. The defendants, who imported cloth of similar quality from the same manufacturers, commenced to sell their cloth, with the mark consisting of the figure of a rose in a square, and the number '2008'. An interlocutory injunction was granted. Sir Richard Garth, C. J., observed, that "the number 2008 is a peculiar symbol which like a 'lion' or 'tree' or a 'flower' would convey a particular meaning", and that it constituted part of the plaintiffs' trade mark. On the other hand, Markby, J., held that it had not been proved that the public had come to associate cloth bearing the number 2008 as exclusively the plaintiffs' goods, that the number was only a quality mark, and that it could not therefore form part of the trade mark. It was, however, made clear by the learned Chief Justice in his judgment, that if the number had been merely used to designate a particular kind or quality of cloth, the plaintiffs could not claim any exclusive right to its use. Such quality mark may be a quality mark of importation, or a quality mark of manufacture.

In *Barlow v. Gobindram*,<sup>21</sup> Sale, J., held that the number 9000 marked on the plaintiff's goods was only a quality number. On the other hand, in *The Madhavji Dharamsey Manufacturing Co., Ltd. v. The Central India Spinning, Weaving and Manufacturing Co., Ltd.*,<sup>22</sup> where the plaintiffs' cloth was stamped with the number

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(19) 10 B.P.C. 141.

(20) 3 Cal. 417.

(21) 24 Cal. 364.

(22) 41 Bom. 49. See also *Holland Bombay Trading Co. v. Buktear Mull and Kissen*, 8 C.W.N. 421; *Hargobind v. Ralli Bros.*, 35 P.R. 1902

'2051' and immediately below that with number '10' to denote the shade of the cloth (black twill), it was held that the mark was not a quality mark but was distinctive of the plaintiffs' goods.

**Letters and initials.**—The question whether letters and initials can constitute trade marks, has generally been answered in the negative, on the ground, that the letters of the alphabet ought to be open to any member of the public to use.<sup>23</sup> In England registration is ordinarily refused for letters and initials, unless they are represented in a distinctive manner. Thus in the "W. and G." case<sup>24</sup> the Registrar's decision refusing registration of the mark consisting of the initials "W. and G." for motor cars was upheld by the House of Lords. In his learned judgment Lord Parker observed that, "it is apparent from the history of trade marks in this country that both the legislature and the courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Act, a monopoly in what others may legitimately desire to use". His Lordship added, "there seems to be no doubt that any individual or firm may legitimately desire in the ordinary course of trade to use a mark consisting of his or their own initials upon, or in connection with, his or their goods", and such "use of the initials of an individual or firm on the goods, packing cases, letter paper and invoices of such individual or firm is common".

Registration of initials and letters has, however, been allowed in some of the earlier cases, e.g., "V. and Z."<sup>25</sup>, "B.S.A.", "A.B.C.",<sup>2</sup> C.B.,<sup>3</sup> "K.M.S."<sup>4</sup>

There are also a number of well-known common law marks consisting of letters and initials. Some of these were referred to by Lord Justice Fletcher Moulton in the "W. and G." case,<sup>5</sup> in the

("K. 68" for malmals); *Ebrahim Currim & Sons v. Abdullah Saheb*, A.I.R. 1934 Mad. 226 (No. 611 for umbrellas); *Anglo India Drug and Chemical, Co. v. Swastik Oil Mills Co., Ltd.*, A.I.R. 1935 Bom. 10.

(23) The same rule applies to phonetic equivalents, e.g., Eanco (E & Co.), Ogee (O.G.).

(24) *W. & G. du Cross Ltd.'s Application*, 28 R.P.C. 413; 29 R.P.C. 65; 36 R.P.C. 660.

(25) *Verschure and Zoon's Application*, 22 R.P.C. 568.

(1) *Birmingham Small Arms Co.'s Application*, 24 R.P.C. 563.

(2) *Albert Baker & Co.'s Application*, 25 R.P.C. 513. See also *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, 24 R.P.C. 27.

(3) See 29 R.P.C. at pp. 73-74.

(4) *Boake, A. Roberts & Co., Ltd. v. Wayland & Co.*, 26 R.P.C. 151.

(5) *Du Cross (W. & G.) Ltd.'s Application*, 29 R.P.C. 65 at pp. 73-74.

following passage:—"From the earliest times in the history of English Trade Mark Law it has been acknowledged by the courts that letters and combinations of letters can be good trade marks. In the famous case of *Millington v. Fox*, which is often referred to as being the foundation of this branch of our law, the trade mark consisted of the letters 'I.H.' and in the still earlier case of *Motley v. Downman*, *Lord Cottenham* upheld the trade mark 'M.C.' Even apart from these decisions, which are of the highest authority, the proposition that a combination of two letters cannot be a distinctive trade mark has no justification either in practice or in reason. No trade mark is better known than the trade mark 'L.L.' for whisky, those letters having been taken as the initials of a Lord Lieutenant. In some trades to my own knowledge, as for example in the corset trade, trade marks usually take the form of two letters, such as 'Y. and N.', 'C.B.' etc., and they are usually recognised as distinguishing the goods of the owners of the trade marks. Such combinations may, in some cases, be the initials of the members of the firm, or some one of its predecessors; but in my opinion it is immaterial whether this is or is not the case."

In India the courts have in many cases given protection to marks consisting of letters or initials. In *Jawala Prasad v. Munna Lal Serowjee*,<sup>6</sup> the initials of the firm "M.D.S." on canisters of ghee, were held to constitute the plaintiffs' trade mark. So also in *Holland Bombay Trading Co. v. Buktair Mull and Bal Kissen*.<sup>7</sup> the mark consisting of the initials "H.B.T.C." was considered a good mark. Again, in *Banarsi Das v. Emperor*,<sup>8</sup> the mark consisting of the letters "D.L." on balls of cotton thread was held to be valid. This decision was approved in *Mohammad Razu v. Emperor*,<sup>9</sup> where the court observed that there was no warrant for the broad proposition that a letter or combination of letters could not constitute a trade mark.

**Colour and get-up.**—A trade mark must be as a rule distinctive irrespective of colour,<sup>10</sup> but in some cases a particular colour,<sup>11</sup> or a combination of colours,<sup>12</sup> might constitute a trade

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(6) 37 Cal. 204.

(7) 8 C.W.N. 421.

(8) A.I.R. 1928 Lah. 186.

(9) A.I.R. 1930 Oudh 360.

(10) *Hanson's Trade Mark*, 5 R.P.C. 136.

(11) *Dunhill v. Bartlett and Bickley*, 39 R.P.C. 426.

(12) *Chwan Swee Bee v. National Carbon Co.*, A.I.R. 1930 Rang. 326.

mark. The same considerations apply to other forms of get-up. The question is of importance in passing-off actions and is discussed in another Chapter.<sup>13</sup> How far designs can be protected as trade marks is also discussed in that Chapter.

**Loss of distinctiveness.**—Just as a descriptive trade mark can, by extensive user, acquire distinctiveness, a mark originally distinctive may, in course of time, lose its distinctive character, and become descriptive of the character or quality of the articles. An exclusive monopoly for the use of such a mark will not be allowed. For instance, the word “Maizena” originally distinctive, had become descriptive of corn flour,<sup>14</sup> and was accordingly held to be *publici juris*. A well-known example is the word “gramophone”,<sup>15</sup> which, though originally distinctive, was held to be the common name of a talking machine with disc records.

**Names of patented and new articles.**—In the case of a patented article the name by which the article was known during the tenure of the patent becomes public property after the termination of the monopoly, and cannot constitute a trade mark. Thus, in refusing registration to “Formalin”, Farwell, L.J., observed: “I am prepared to say that not only would it be extremely difficult, but in my judgment it is impossible for a man, who by taking out a patent obtains a monopoly for a particular article, which on the face of that patent he describes by a particular new name, to say that that name which he says means the patented article means something else, namely, the article made by him.”<sup>16</sup> Other examples of such words are:—“Linoleum”,<sup>17</sup> “Cyclostyle”,<sup>18</sup> “Native guano”.<sup>19</sup>

Where a word is the name of a new article, it cannot constitute a trade mark.<sup>20</sup> In his dissenting judgment in the “Vaseline”

(13) See Chap. VI.

(14) *National Starch Manufacturing Co. v. Munn's Patent Maisena and Starch Co.*, 11 R.P.C. 281. See Chapter VI.

(15) *Gramophone Co. Ltd.'s Application*, 27 R.P.C. 689.

(16) *Formalin Hygienic Co.'s Application*, 17 R.P.C. 486. See also Sec. 6 (1) which refuses registration of names of patented articles. Cf. Sec. 6 (2) regarding chemical names.

(17) *Linoleum Manufacturing Co. v. Nairn*, (1873) 7 Ch.D. 834.

(18) *Gestetner's Tm.*, 25 R.P.C. 156.

(19) *Native Guano Co. v. Sewage Manure Co.*, 8 R.P.C. 125.

(20) *Per Lopes, L.J.*, in *Arbens's Application*, 4 R.P.C. 143 at p. 149. See also *Hannay's Trade Mark*, 7 R.P.C. 46.

case<sup>21</sup> Cozens-Hardy, L.J., observed: "The word 'Vaseline' is an invented word to describe an invented thing, and it follows that any one was at liberty to make the invented article which was not protected by patent in England, and at liberty to call it by the name attributed to it by the inventor. In the case of the *Linoleum Manufacturing Co. v. Nairn*,<sup>22</sup> Fry, J., applied this principle to the case of a patented article after the expiration of the patent, but I think it cannot be limited to that case".

**Common to the trade.**—A word or device which is common to the trade is obviously not adapted to distinguish the goods of any one trader. The same thing applies generally to combinations of such words or devices.<sup>23</sup> In special cases it is, however, possible that the combination may itself be distinctive by virtue of some special fanciful arrangement.

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(21) *Chesebrough Manufacturing Co.'s Trade Marks*, 19 R.P.C. 342.

(22) (1878) 7 Ch.D. 834.

(23) *Pirie's Trade Mark*, 8 R.P.C. 261; 9 R.P.C. 17, where a combination of two words (Parchment Bank) both common to the trade was held not to be a valid trade mark. In *Joshua Wigful and Sons, Ltd. v. John Jackson & Son, Ltd.*, 33 R.P.C. 97 (Wheat sheaf) the mark was removed from the Register notwithstanding seven years' registration, as the mark was common to the trade at the time of registration.



## CHAPTER V. ACQUISITION AND ASSIGNMENT OF TRADE MARKS.

### (i) ACQUISITION.

**In India trade mark rights recognised under common law.**—It has already been pointed out that in India there is no statute law for registration of trade marks as in England and other foreign countries and that the rights of trade marks owners are determined under the Common Law.<sup>1</sup> In *Hannah v. Jaganna'h & Co.*,<sup>2</sup> the Calcutta High Court observed. "In India the law of trade marks is not governed by statute; there is no statutory system of registration, and the rights and liabilities in connection with trade marks are determined by reference to the principles of the common law of England". The law, therefore, stands as it was in England prior to the Trade Marks Act of 1875. "The same consideration of policy which prior to the regulation of trade marks by statute, induced the English Courts to protect them and to recognise in a manufacturer or selector a right under certain limitations to the distinguishing mark or title under which he offered his goods to the public, and to mulct in damages any other person who intentionally infringed a trade mark so adopted, have induced the courts in this country to accept as consonant with equity and justice the general rules which obtain in commercial countries respecting trade marks."<sup>3</sup> In *Nooroodeen Sahib v.*

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(1) See *British American Tobacco Co., Ltd. v. Mahboob Buksh*, 38 Cal. 110; *Banarsi Das v. Emperor*, A.I.R. 1928 Lah. 186; *Von Wulff v. Jivandas & Co.*, A.I.R. 1926, Bom. 200; *Jawala Prasad v. Munna Lal Serowjee*, 37 Cal. 204; *Pakir Mahomed v. Emperor*, A.I.R. 1929, Rang. 322; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461; *Lotus, Ltd. v. Mt. Nasimunnassaba Begum*, A.I.R. 1934 Cal. 600; *Jamal Noor Mohamed Sait Co. v. Abdul Kareem & Co.*, A.I.R. 1934, Mad. 211. In *Somerville v. Schembri*, (1887) 12 App. Cas. 453, the Privy Council said, that in Malta, where there was no law establishing the registration of trade marks, the rights of the parties were dependent upon the general principles of commercial law as enunciated by leading English cases decided before the passing of the first Trade Marks Act of 1875. Legislation for registration of trade marks has since been passed in Malta, see Ordinances 11 of 1899 and 7 of 1907.

(2) 19 C.W.N. 1.

(3) *Lovergne v. Hooper*, 8 Mad. 149.

*Charles Souden*,<sup>4</sup> Benson, J., observed that there was no system of registering trade marks in India and that a person might use any mark or combination of marks or symbols that he liked, unless some other person had acquired by user a reputation which coupled his name with the mark or combination of marks or symbols. In that case the user acquires a property in the mark or combination, which the law will protect just as much as it were a registered trade mark. And, in *The Imperial Tobacco Co., of India, Ltd. v. Albert Bonnan and Bonnan and Co.*,<sup>5</sup> the Privy Council have laid down that the ordinary principles of jurisprudence with regard to trade marks and those forbidding the passing-off of goods apply to India.

**Title acquired by prior user.**—Under the common law title to a trade mark is acquired by prior user. The plaintiff must show that he has the right of prior user in the mark, as against his rivals in the trade. The mark may be a new one used for the first time in the market by the plaintiff, or may be one which had been abandoned by its previous owner. In the latter case, the abandonment must be so effectual that its use by a subsequent person, is not calculated to deceive the public. In either case the claimant to the mark must show that his user has been continuous, and that the trade mark is distinctive. Where a word is merely descriptive or laudatory of the goods, the fact that the mark was first adopted by the plaintiff to denote his goods and had been continuously used by him for this purpose, will not entitle him to exclusive ownership.

**Prior invention or mere advertisement does not constitute user of a trade mark.**—A mere intention to use a trade mark will not constitute user of that mark. In other words, a mere invention of a trade mark does not create any right of property in the mark. It is the person who first actually uses the mark and not the one who first thought of it, or designed it, that acquires an exclusive right to use the mark.<sup>6</sup>

A mere advertisement of a trade mark in the press or on bill heads, invoices and price lists is not, user of that mark. In *Maxwell v. Hogg*,<sup>7</sup> Lord Justice Cairns said: "All the definitions

(4) 33 Mad. 402; 15 Mad.L.J. 45.

(5) A.I.R. 1924 P.C. 187.

(6) *Badische Aniline und Soda Fabrick v. Tejpall Godoo*, 5 Bom.L.R. 1025; *Sommerville v. Schembri*, 12 App. Cas. 453; *Gobinda Chandra Roy v. Abdul Rashid*, A.I.R. 1928 Cal. 235.

(7) L.R. 2 Ch. 307; 36 L.J.Ch. 433.

which have been given in this Court of the nature of the right to protection in the case of trade marks, seem to me to be opposed to the idea that protection can be given where there has been no sale, or offering for sale, of the articles to which the name is to be attached". His Lordship added: "I am prepared to hold without any hesitation, that the mere intention, and the declaration of intention, to use a name will not create any property in that name, and to hold also that there can be no protection in this court for the intended name during the course of manufacture of the article, which is to bear the name".<sup>8</sup> It was held in that case that any amount of expense which the plaintiff had incurred in advertisements, or other trade announcements about the articles bearing the mark in question, before, however, such goods had actually been manufactured and sold, or offered for sale, could not confer title to the mark.

In a recent case,<sup>9</sup> a foreign company, manufacturers of peppermints, applied for registration of the word "Val" as a trade mark in class 42, for all substances used as food or ingredients for food. The registration was opposed by the company's sole agent in England on the grounds that the word had been invented by him, that the company was instructed to manufacture the goods solely for him and that he had incurred heavy expenses in advertising and placing the goods on the market. It was held by the Comptroller-General that the mere fact that the agent had invented the word did not give him any claim to the mark, and that the mark should be registered in the joint names of the agent and the manufacturer.

**Mark must be used on or in connection with vendible articles.**—In order to constitute user as a trade mark it is thus essential to prove that the mark had been actually used upon or in connection with vendible articles, and that the articles bearing that stamp or trade mark, have already been sold, or offered for sale, in the market. When the mark had never been put forth to the world by the complainant, he cannot restrain the sale by

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(8) See S. 37 of the Trade Marks Act which provides for the removal of a mark from the Register on the ground of non-user. See also *Batt & Co. v. Dunnett*, 16 R.P.C. at p. 413, where Lord Halsbury remarked: "The Trade Marks Acts are not for copyright in marks; they are to protect trade marks. If you have no goods you are claiming copyright only, you are not claiming for the purpose of protecting your trade."

(9) *Application by Naamloose Vennootschap Fabriek van Chocolade en Suikerwerken J. C. Klene & Co.*, 40 R.P.C. 103. See also *Re "Tarantella" Trade Marks*, 27 R.P.C. 573, 762.

another, of goods branded or stamped with that mark.<sup>10</sup> In *Spencer's case*,<sup>11</sup> Lord Esher, M.R., stated the condition for determining whether a mark was in use as a trade mark thus: "What is the test? It seems to me that *Palmer's case*<sup>12</sup> says this, 'Is it usual in the trade?' How does a man use a trade mark in his trade? By putting it on his goods. By using it either by stamping it on his goods, or by putting a label on his goods. You do not use a trade mark by having it shut up in your warehouse; you do not use a trade mark by having it put up in your warehouse; and you do not use a trade mark by advertising it in a newspaper. It is only by putting it on your goods, so that when your goods are sold in the market there is the distinguishing mark'".

In the *Leather Cloth case*<sup>13</sup> Lord Chancellor Westbury said: "There is no exclusive ownership of the symbols which constitute a trade mark, apart from the use or application of them; but the word 'trade mark' is the designation of these marks or symbols as and when applied to a vendible commodity". And, in another case<sup>14</sup> his Lordship said that "an element of the right to the property in a trade mark may be represented as being the fact of the article being in the market as a vendible article, with that stamp or trade mark, at the time when the defendants imitate it".

**Mark may be applied or attached to goods.**—As the object of a trade mark is to give the purchaser a satisfactory assurance of the origin of the goods which he is buying, the mark may be applied or attached to them in any suitable manner, which would serve reasonably to indicate to the public, that the goods are the goods of the proprietor of the mark. In the words of Kay, J., "user as a trade mark means, and must necessarily mean, the impressing of those words either upon the goods, or upon some wrapper or case containing the goods, in such a way that the public would necessarily understand those words to be, and alone to be, the trade mark of the person who uses them."<sup>15</sup> The test is, whether in the circumstances of the case, the mark sufficiently

(10) *Lawson v. The Bank of London*, (1856) 25 L.J.C.P. 188; 4 W.R. 181, Willes, J.

(11) 3 R.P.C. 73.

(12) *Palmer's Trade Mark*, L.R. 24 Ch.D. 504; 32 W.R. 306.

(13) *Leather Cloth Co., Ltd. v. American Leather Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L.J.Ch. 199; 12 W.R. 289.

(14) *McAndrew v. Bassett*, 4 De G. J. & S. 380; 33 L.J.Ch. 561; 12 W.R. 777.

(15) *Richards v. Butcher*, 8 R.P.C. 249.

indicates to the purchasers, that the article is manufactured by the person claiming it as his trade mark, as distinguished from other persons also manufacturing similar articles. The mark may be applied to the goods themselves, or to any covering, label, reel or other thing in or with which the goods are sold, and may be woven, impressed, stamped, painted, or otherwise worked into or affixed or fastened by tallies, cards, labels to the goods or to their coverings. The covering may be any "stopper, cask, bottle, vessel, box, cover, capsule, case, frame or wrapper".<sup>16</sup> A physical connection of the mark with the goods does not appear to be essential; a trade mark appearing in the advertisements and trade circulars, in such manner that it is associated by the public with the goods of the proprietor of the mark, may be protected under the common law.

Where a mark is applied, or attached to the covering, or packing case of the goods, it can constitute user as a trade mark, only if the covering or the packing case is intended to be the thing shown to the purchaser. Thus in *Powell's Trade Mark case*<sup>17</sup> where the expression "Yorkshire Relish" was impressed on the outside of the packing cases containing the bottles of sauce, the bottles themselves bearing a different trade mark, it was held that the words "Yorkshire Relish" had not been used as a trade mark. Lord Justice Bowen said: "The function of a trade mark is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods, to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market. It tells the person who is about to buy, or considering whether he shall buy, that what is presented to him, is either what he has known before under the similar name as coming from a source with which he is acquainted, or, that it is what he has heard of before as coming from that similar source. It is obvious that, if it is to be an indication to the purchaser's eye of what I have stated, it must either be impressed on the goods or so accompany the goods as to produce that effect upon the purchaser. Accordingly, it may be either marked on the goods themselves, or, if that

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(16) Sec. 5 of the Indian Merchandise Marks Act. See also *Singer Manufacturing Co. v. Wilson*, 2 Ch.D. 434; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Budd v. Lucas*, (1891). 1 Q.B. 408, *Richards v. Butcher*, 8 B.P.C. 249; *Moet v. Pickering*, (1878), 8 Ch.D. 372; *Findlater, Mackie, Todd & Co v. (Henry) Newman & Co.*, 19 B.P.C. 235.

(17) 10 B.P.C. 63, 195.

is not possible or convenient, it may be marked on the vehicle of the goods and may be and sometimes, I dare say, is marked upon a covering or exterior, such as a packing case. But, when you are considering a mark upon the vehicle as distinct from a mark upon the goods, you must ask yourself carefully—is this mark used as a trade mark; is its object and use to indicate to the purchaser what I have suggested? The alternative view of a mark placed outside a packing case may be that its object is not to indicate anything at all to the purchaser, but to indicate something to those who are handling the packing case either for the purpose of carriage or storage; or it may be to indicate not that the goods are the goods of a particular firm's manufacture, but to indicate the name of the thing inside, to show what is inside the box."

**Not necessary to prove public recognition where mark is distinctive.**— In *Richards v. Butcher*,<sup>18</sup> Lord Esher said that in order to constitute user as a trade mark, two tests must be satisfied, namely, first, that the mark must be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor, and, secondly, that the public must have recognised the goods so marked as his goods. "You must show that you used it in the market for the purpose of distinguishing your goods," observed his Lordship, "and, I think, you must show that the market accepted it as a distinguishing mark of your goods—then you used it as a trade mark." In expressing this opinion Lord Esher did not differentiate between inherently distinctive, and *prima facie* non-distinctive, trade marks, although, as Lord Justice Lawrence says, the learned Master of the Rolls must have had in mind cases of the latter type. It is, however, well settled under the common law that, in order to constitute user, while every mark must be used upon or in connection with goods in order to constitute user as a trade mark, identification of the mark exclusively with the proprietor's goods by the public is also necessary, only where the mark is *prima facie* non-distinctive. In case of an inherently distinctive trade mark, it is sufficient to show that the mark has been used by the proprietor in his business upon or in connection with some vendible article, and it is unnecessary for the proprietor to prove further that the public have associated the mark exclusively with his goods.<sup>19</sup> The volume

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(18) 8 R.P.C. at p. 254. Followed in *Massachusetts Saw Works' Application*, 35 R.P.C. 137.

(19) The non-necessity in case of a distinctive mark to establish its reputation and exclusive association with the goods of the owner has not been

of business or the length of user is immaterial in such a case. There is a series of well-known decisions in which this principle of law has been clearly laid down. Thus in *Hall v. Barrows*,<sup>20</sup> Sir John Romilly observed: "It has sometimes been supposed that a manufacturer can only acquire such a property in a trade mark as will enable him to maintain an injunction against the piracy of it by others, by means of a long-continued user of it, or, at least, such a use of it as is sufficient to give it a reputation in the market where such goods are sold. But I entertain great doubt as to the correctness of this view of the case. The interference of a Court of Equity cannot depend on the length of time the manufacturer has used it. If the brand or mark be an old one, formerly used, but since discontinued, the former proprietor of the mark undoubtedly cannot retain such a property in it, or prevent others from using it, but, provided it has been adopted by a manufacturer, and continuously, and still used by him to denote his own goods when brought into the market and offered for sale, then I apprehend, although the mark may not have been adopted a week, and may not have acquired any reputation in the market, his neighbours cannot use that mark. Were it otherwise, and were the question to depend entirely on the time the mark has been used, or the reputation of it had been acquired, a very difficult, if not an insoluble inquiry, would have to be opened in every case, namely, whether the mark had acquired in the market a distinctive character denoting the goods of the person who first used it". This statement of law "was not questioned when the case came before the Court of Appeal, and has ever since been accepted as a correct

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clearly recognised in some Indian cases, as is seen for instance from the following passage from the judgment of Sir Arnold White, C. J., in *Mahomed Esuf v. Rajaratnam Pillai*, 33 Mad. 402:—"I think it may be said to be now well settled that a dealer in, or a manufacturer of, a particular article, who adopts a name for that article, whether the name be a purely fancy name or a descriptive name, cannot restrain another dealer from using the same name simply upon the ground that the article so named has acquired a reputation, even though it may be that the public have grown accustomed to buy the article in question relying on the name and without examining the quality of the article. For a man to be entitled to restrain another from using a particular name with reference to a commodity, he must, I think, as the law stands, be in a position to show that the public have grown to associate that particular name with himself as the manufacturer of, or dealer in the article." See also observations of Davies, J., in *Noorodeen Sahib v. Charles Souden*, 15 Mad.L.J. 45; 33 Mad. 402; *Badische Aniline und Soda Fabrick v. Tejpall Godoo*, 5 Bom.L.R. 1025.

(20) 32 L.J.Ch. 548. See also *McAndrew v. Bassett*, (1864) 4 De G. J. & S. 380; *Maxwell v. Hogg*, (1867) L.R. 2 Ch. 307.

statement of the law on this point.”<sup>21</sup>

The question was raised and discussed at length in *Nicholson & Sons, Ltd.'s Application*.<sup>22</sup> After reviewing the earlier authorities, Lawrence, L. J., observed in the Court of Appeal, that “it was firmly established at the time when the Act of 1875 was passed, that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with his goods, irrespective of the length of such user and of the extent of his trade”, and that, “it is not necessary to embark upon an enquiry whether and when first the mark became recognised by the public as denoting the goods of the trader, unless the mark proposed to be registered is *prima facie* non-distinctive, and, consequently, does not become a trade mark at all, until by reputation in the market it has come to denote the goods of the trader using it”. According to his Lordship, where a trade mark is inherently distinctive, “a trader in however small a way of business and however recently his business may have been established” acquires exclusive title to the mark, provided he can prove that he has been using it in business. Lord Justice Romer who concurred, (Lord Hanworth, M. R., dissenting) expressed himself thus: “They (Respondents) say, that in order to constitute user of a trade mark two things must exist concurrently, namely, (1) the intention of the proprietor of the mark to indicate by its use the origin of the goods upon or in connection with which it is used; (2) recognition of the mark as indicating origin on the part of that section of the public with whom the proprietor deals. Now, I do not doubt that for the purpose of ascertaining the nature of the user of a mark one may legitimately take into consideration both the intention of the owner of the mark, and the effect that the user has had upon the public, and the absence of both intention and public recognition would render it difficult, if not impossible, to treat the user as being user as a trade mark. But I can see no reason whatever for regarding both intention and recognition by the public as essential conditions of such user. If a trader uses a mark upon or in connection with his goods with the intention of indicating their origin, surely he is using it as a trade mark from the moment of the first user, which will probably be many months before the public has come to recognize the mark as indicating origin. If public recognition be a requisite of user as a trade mark, the proprietor must necessarily

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(21) Per Lawrence, L.J., in *Nicholson & Sons, Ltd.'s Application*, 48 R.P.C. at p. 452.

(22) 48 R.P.C. 227; 49 R.P.C. 88.



remain in ignorance of whether he is or is not using a trade mark until by some means or another he has ascertained the views of the public upon the matter. How he is to do this has not been explained to me and I do not know. But it is quite clear that he can never ascertain when the public first regarded the mark as indicating origin, and must ever be unable to answer the question, 'When did you first use the mark as a trade mark?' In my opinion a trader is at any rate using a mark as a trade mark when he first uses it upon or in connection with his goods with the intention of indicating origin, assuming of course that it is a mark capable of so doing. In other words, intention without public recognition is enough." On appeal, the judgments of Lawrence and Romer, L. JJ., were upheld by the House of Lords.

**Exclusive association with the plaintiff's goods must be shown where mark is non-distinctive.**—On the other hand, a mark which is *prima facie* non-distinctive must be shown to satisfy both the conditions laid down by Lord Esher in order to constitute user as a trade mark. It will be necessary for the plaintiff in such case to prove that the mark has been applied on or in connection with his goods and the mark identifies his goods to a substantial portion of the purchasing public. In other words, the plaintiff must establish conclusively that the mark has lost its primary descriptive meaning, and has acquired a secondary meaning in connection with his goods. Whether a *prima facie* non-distinctive mark has come to designate exclusively the goods of a particular manufacturer will depend upon the facts of the case. But where a word is merely laudatory, such as, "good," "best," "superfine," etc., it may be impossible for it to acquire a secondary meaning.<sup>23</sup>

**Intention not necessary to constitute user of a trade mark.**—Although practically every trade mark is intentionally used by the proprietor to denote his goods, and distinguish them from the goods of other persons, it is not necessary to consider conscious user on the part of the owner, in order to prove user of a trade mark. Irrespective of the intention of the owner, if the result is, that the public identify the mark exclusively with his goods, he is entitled to restrain his rivals from using the mark on their goods. The test is not what the owner intended, but what is the business result of that which has been done. So, in *Richards v. Butcher*,<sup>24</sup> Mr. Justice Kay said: "User as a trade mark means, not what

(23) *Joseph Crossfield & Sons. Ld.'s Application*, 26 R.P.C. 837.

(24) 8 R.P.C. at p. 44.

the person who uses has in his own mind about it, . . . . . but what the public would understand, when the trade mark, or so-called trade mark, is impressed upon the goods or upon some wrapper or case containing the goods, to be the trade mark. . . . . User of words as a trade mark means, and must necessarily mean, the impressing of the words either upon the goods or upon some wrapper or case containing the goods in such a way that the public would necessarily understand them to be, and alone to be, the trade mark of the person who uses them." Thus in *Nicholson's Trade Mark case*,<sup>25</sup> although the triangle mark was originally used by the firm on barrels for the purpose of identifying the beer inside them, it was held to constitute user as a trade mark. Lawrence, L. J., observed: "In determining. . . . . whether the name 'Nicholson' formed part of the Messrs. Nicholson's Trade Mark, the question is what is the true inference which the Court ought to draw from the fact that the triangle mark and the name have always appeared on the cask-heads together, that is, what would an ordinary buyer conclude?—not what was in the mind of Messrs. Nicholson or what they may have thought was their Trade Mark." And Romer, L. J., after stating that public recognition, without intention of the owner, would constitute user observed: "Supposing a manufacturer, for merely æsthetic or decorative motives, or merely warehouse purposes, uses a mark on or in connection with his goods, and such mark comes to be recognised by the public as indicating origin, has the mark been used as a trade mark? I can see no reason that it has not".

A trade name suggested by the device or word appearing on the plaintiff's trade mark may sometimes be created by the public for the plaintiff's goods. If the goods of a manufacturer, have from the mark or device he has used, become known in the market by a particular name, a rival trader will not be allowed to use any mark which will cause his goods to bear the same name in the market. Thus, in the well-known *Dairymaid case*,<sup>1</sup> the plaintiffs' goods came to be known in the market as "Milkmaid brand", and also "Dairymaid brand", from their trade mark which consisted of a girl with a pail upon her head and another in her hand. The defendant was, on this ground, restrained from using the words "Dairy Maid," as part of his trade mark. Other cases illustrating

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(25) 48 R.P.C. 227; 49 R.P.C. 88.

(1) *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 3 R.P.C. 28.

this rule are:—*Seizo v. Provezende*,<sup>2</sup> *Johnston v. Orr-Ewing & Co.*,<sup>3</sup> *Barlow and Jones v. Johnson & Co.*,<sup>4</sup> *Wilkinson v. Griffith Bros. & Co.*,<sup>5</sup> *Taylor v. Virasami Chetty*,<sup>6</sup> *Currie & Co's Application*,<sup>7</sup> *Hodgson and Simpson v. Kynoch Ltd.*,<sup>8</sup> *Price's Patent Candle Co., Ltd. v. Jeyes' Sanitary Compounds Co., Ltd.*,<sup>9</sup> *Boord and Sons v. Huddart*,<sup>10</sup> *Boord & Son v. Thom and Cameron, Ltd.*,<sup>11</sup> *Pakir Mahomed v. Emperor*,<sup>12</sup> *Danish Bacon Co., Ltd.'s Application*.<sup>13</sup>

**Length of user.**—It has been already stated that the length of user is immaterial for inherently distinctive marks. "The inference of the Court of Equity" observed Romilly, M.R., in *Hall v. Barrows*,<sup>14</sup> "cannot depend on the length of time the manufacturer has used it." In *McAndrew v. Bassett*,<sup>15</sup> Lord Westbury similarly observed: "I am not in this case determining when for the first time property may be said to be established in a trade mark. An element of the right of that property may be represented as being the fact of the article being in the market as a vendible article with that stamp or trade mark at the time when the defendants imitate it".

The length of user may, however, be a material factor in the case of a *prima facie* descriptive mark, in order to prove that the mark has lost its descriptive sense, and has become distinctive of the plaintiff's goods. The length of user may often have to extend over a long period in order to establish this fact. For instance, in the *Yorkshire Relish* case,<sup>16</sup> the mark had been in use for over

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(2) (1866) L.R.1 Ch. 192.

(3) (1882) 7 App. Cas. 219.

(4) 7 R.P.C. 395.

(5) 8 R.P.C. 370.

(6) 6 Mad. 108.

(7) 13 R.P.C. 681.

(8) 15 R.P.C. 465.

(9) 19 R.P.C. 17.

(10) 21 R.P.C. 149.

(11) 24 R.P.C. 697.

(12) A.I.R. 1929 Rang. 322.

(13) 51 R.P.C. 148.

(14) 32 L.J.Ch. 548.

(15) (1864) 4 De G. J. & S. 380.

(16) *Birmingham Vinegar Brewery, Co., Ltd. v. Powell*, (1897) A.C. 710.

twenty-five years and in the *Silverpan Jam* case,<sup>17</sup> for about fourteen years. In both these cases, it was held, that the marks in question had lost their primary meaning and had become distinctive. No rule can, therefore, *a priori* be laid down as to the extent of user required in order to show that a *prima facie* descriptive mark has become distinctive. The length of user required will depend upon the facts of each case, and a number of factors such as the nature of the mark, the nature of the goods on which the mark is used, the quantity of goods sold, and the nature of the advertisement. The test in each case is, whether the mark had become exclusively associated with the goods of the plaintiff in the market. Once this fact is established the legal consequence follows, and it is immaterial whether the length of user was long or short. So, Swinfen Eady, M.R., said: "When it is once clearly established that the name has become distinctive, the fact that it has achieved this purpose in a short time ought not to prevent its registration. . . . Length of user is, in my opinion, only important in considering the question of fact, whether the name mark has really and truly become distinctive of the applicant's goods."<sup>18</sup> The same view has been expressed by the Indian courts. For instance, in *Badische Aniline and Soda Fabrick v. Tejpall Godoo*,<sup>19</sup> the Bombay High Court observed that the actual length of time during which a mark has been employed is not an important ingredient in an action for infringement, provided the mark had become associated with the plaintiff's goods.

**Transitory and spasmodic user does not give title to the mark.**—But where the prior user of the mark by one claimant, is merely "transitory, spasmodic and inconsiderable", it will not vest title in him, as against another claimant who had spent much time and money to make the mark widely popular, and had all

(17) *Faulder & Co., Ltd. v. O. and G. Eushton, Ltd.*, 20 R.P.C. 477. Instances of users reported in cases where surnames have been allowed registration are "Cadbury" 60 years; "Teofani" 22 years; "Lodge" 9 years; "Muratti" 28 years; "Daimler" 18 years; "Avery" 100 years; "Burford" 3 years.

(18) *Burford (H.G.) & Co. Ltd.'s Application*, 36 R.P.C. at p. 147, See also *Licensed Victuallers' Newspaper Co. v. Bingham*, (1888) 38 Ch.D. 139.

(19) 5 Bom.L.R. 1025. See also *Lavergne v. Hooper*, 8 Mad. 149; *Jagarnath & Co. v. Cresswell and others*, 40 Cal. 814; *Dunbar v. Holland Bombay Trading Co.*, 12 S.L.R. 129; *Lakhan Chandra Basak v. Emperor*, A.I.R. 1925 Cal. 149; *Adamjee Hajee Dawood & Co., Ltd. v. Swedish Match Co.*, A.I.R. 1928 Rang. 210; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461.

along been using the mark on his goods. The user must be steady and continuous. The law was clearly laid down in the case of *Boord and Son v. Thom and Cameron Ltd.*,<sup>20</sup> where Lord Dunedin said: "My Lords, I think it is very necessary to keep this firmly in view—that what we are doing in this case is something very different from what one does in examining the evidence in a case say, as to anticipation of a patent. If the right to a trade mark was constituted by the fact that it was, so to speak, an invention, then it is quite clear that as soon as it was proved that the trade mark had been used by anybody, however little the use was, but still had been used at a period prior to that when it was first possible to register it, that would be sufficient to put out of the way the claim to exclusive right of a person who had registered for it. That is not the nature of the right to a registered Trade Mark. . . . Now, property in a mark does not mean a few isolated sales under that mark, but it means, as I take it, that you had sold so much goods under it that the mark had come, in a certain market, to be associated with your goods. . . . I will just say that, taking the matter as a jury would, it seems to me that none of these people have really proved anything more than a very sporadic use of the labels with a cat and barrel on them, and that by none of them is there really any trade proved that would associate their goods with a cat and barrel".

In *Licensed Victuallers' Newspaper Co. v. Bingham*,<sup>21</sup> the plaintiff published the first number of a paper called "The Licensed Victualler's Mirror", and had it registered at Stationers' Hall. Three days after, the defendants started publishing a newspaper under the same name. It was shown that during this period the plaintiffs' sale was negligible, and injunction was consequently refused. Lord Justice Bowen said that, in order to claim exclusive right, the plaintiffs had to show that there was such a sale as would establish in the mind of the public a connection between the name and the plaintiffs' newspaper. "That can only be after a reasonable time. It is urged that the right must exist from the first publication, for, if not, how are you to say what time the right arises? No doubt there is a difficulty in fixing the time when it arises, but that does not authorise us to say that it has arisen before the publication has any reputation at all".

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(20) 24 R.P.C. 697, at p. 720.

(21) 38 Ch.D. 139.

**Mark need not indicate actual ownership of the goods.**—It is well-settled law that a trade mark need not indicate to the public the actual ownership of the goods in question. A trade mark merely guarantees to the purchaser that the goods on which the mark is applied emanate from the same source of trade as the goods that had hitherto borne the same trade mark. The public need not, therefore, know the specific source of the articles bearing the trade mark in question, and indeed, do not often care to know the name of the particular manufacturer of the goods. It is sufficient if they identify the goods on which the mark is applied with a single source, and are able by means of the mark to distinguish the goods emanating from this source from goods emanating from other sources. This principle of law is well illustrated by the *Yorkshire Relish case*,<sup>22</sup> *Edge & Sons, Ltd. v. Niccolls & Sons, Ltd.*<sup>23</sup> and *Dunkhill v. Bartlett & Bickley*.<sup>24</sup>

**User must be in British India.**—In considering the question of prior user it is to the market of this country alone that one has to have regard, and foreign markets are wholly irrelevant for that purpose.<sup>25</sup> It is no objection to the acquisition of a trade mark right by A in India that title to the same mark had been obtained by B in a foreign country prior to A's user in India. In *Von Wulfig v. Jivandus & Co.*,<sup>1</sup> Taraporewala, J., said: "In respect of rights in trade marks and trade names any rights acquired by the parties in England have no effect on the rights of parties in India." In *West End Watch Co. v. The Berna Watch Co.*,<sup>2</sup> the Bombay High Court held that the plaintiffs who were the first users of the mark "Berna" on watches in India were entitled to the exclusive use of the mark as against the manufacturers who had registered the mark in Switzerland. "This is a case" said Sir Basil Scott, C.J., "which is not affected by the successive registration in Switzerland of the Berna trade mark as appearing on the plaintiffs' watches by the different owners of the St. Imier Factory."

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(22) *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, 14 R.P.C. 720.

(23) 28 R.P.C. 582.

(24) 39 R.P.C. 426.

(25) Similar law prevails in England as regards the acquisition of *Common Law marks*. See in re *Riviere & Co.*, 26 Ch. D. 48; *Newman v. Pinto*, 4 R.P.C. 405; 508; *Impez Electrical, Ltd. v. Weinbaum*, 44 R.P.C. 27; *Notox Ltd.'s Application*, 48 R.P.C. 168.

(1) A.I.R. 1926 Bom. 200.

(2) 35 Bom. 425.

In *Lavergne v. Hooper*<sup>3</sup> the plaintiffs who were brandy merchants and exporters in France contended that they had adopted the trade mark of a Maltese Cross to distinguish their brandy, and claimed the sole right to use the mark in any market. The plaintiffs had the right of user of the trade mark in France and also in England where it was registered in their name. It was argued that this fact entitled them to the exclusive use of the mark in India also. The case was, however, decided on a different issue. On the question of user in India their Lordships Turner, C.J., and Muttusami Ayyar, J., observed in the course of their judgment.—“The remedies which are conceded for the protection of trade marks adopted in the home market are also extended to trade marks which have been originally adopted in foreign markets, and it is immaterial that goods bearing such marks are not sold in the home market: *Collins Co. v. Walker*;<sup>4</sup> *Collins Co. v. Brown*;<sup>5</sup> *Collins Co. v. Cowen*”.<sup>6</sup> This view is, however, nothing more than an *obiter dictum* and has been expressly dissented from in the following case.

**Ebrahim Currim v. Essa Abba Sait.**—In *Ebrahim Currim v. Essa Abba Sait*<sup>7</sup> the plaintiff claimed to have been for many years the sole importer into Bombay and Madras of umbrellas bearing the trade mark consisting of a design of a stag. The defendant had recently commenced importing and selling in Madras, umbrellas similar to those of the plaintiffs, whereupon, the plaintiff sued for an injunction and damages. The defendant contended that the trade mark belonged to, and had, since 1884, been used by a Glasgow firm which manufactured the umbrellas, and supplied them to the defendant through another firm. It was argued that, inasmuch as the mark was first used by the Glasgow firm the plaintiff could not lawfully claim title to the mark in India, even though the Glasgow firm had used the mark only in Scotland and had never used the mark in India. In the course of his learned judgment Shephard, J., said: “The question I have to determine is, whether the allegation made by the defendant that the stag trade mark used on the umbrellas, is the trade mark of McIntosh Ferguson & Co., who carry the business at Glasgow, is relevant by way of defence to this suit.... In my opinion.... the prior use in Scotland would not

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(3) 8 Mad. 149.

(4) 7 W.R. 222.

(5) 3 K. & J. 423.

(6) 3 K. & J. 428.

(7) 24 Mad. 163.

justify the Scotch firm and the defendant in saying that the plaintiff's user of the trade mark is illegal or otherwise than an exclusive user."

Referring to the view taken by Turner, C. J., and Muttusamy Ayyar, J., in *Lavergne v. Hooper*,<sup>7-a</sup> which has already been referred to, Mr. Justice Shephard said: "I do not think this statement can be treated as more than a dictum.....In point of law the authorities cited do not support the proposition which I am asked to affirm. In *Collins Co. v. Brown*<sup>8</sup> the point taken on the demurrer was that the plaintiffs were a foreign company and therefore not entitled in England to any rights in respect of their trade marks and the demurrer was overruled. Nothing was, or could be decided as to the circumstances that the trade mark was not used in England, because the bill alleged that articles bearing it had been sold to persons in England. I can hardly believe that the learned judges of this court intended to hold on the authority of these cases that a man can maintain an action for infringement of his trade mark without proof that his goods have ever been brought into the market. In *re Riviere & Co.'s Trade Mark*<sup>9</sup> relates to the same trade mark. There the Madras firm alleging that they had formerly been supplied by Riviere & Co. with brandy bearing the Maltese Cross and had requested them to get it registered in England and in France, objected to the registration of Riviere & Co., as owners of the Maltese Cross in connection with brandy; and because the former had never used the mark in England it was held on demurrer by Pearson, J., that they were not persons "aggrieved within the meaning of the Act. On appeal, it was held that the Madras firm might possibly be 'aggrieved' although they were not themselves entitled to register in respect of the mark. This case so far from supporting the defendants' position, is like several others which were cited as authority for the proposition that 'user' as understood by the Act, means user in England. This is put most clearly by Stirling, J., in *Jackson v. Napper*<sup>10</sup> where registration was refused in the case of particular articles in respect of which user in England had not been proved and allowed as to others in respect of which there was proof, although there was a similar mark already on the Register." His Lordship concluded his learned judgment with the following words: "The

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(7-a) 8 Mad. 149.

(8) 3 K. & J. 423.

(9) L.R. 26 Ch.D. 48.

(10) 35 Ch.D. 162 at p. 170.



protection which the law affords to traders using a trade mark in this country would be seriously diminished if immunity from action were secured to rival traders, who, having brought goods into the market with the same mark, were able to prove that in some quarter of the globe some other trader had been in the habit of using the mark for a period longer than that alleged by the plaintiff."

**Ullmann & Co. v. Leuba.**—Another leading case bearing on this point is *Ullmann & Co. v. Cesar Leuba*.<sup>11</sup> This was an appeal to the Privy Council from the decision of the Supreme Court of Hongkong for an action for infringement of certain trade marks on watches. These marks originated with the firm of Bovet in Siwtzerland whose watches acquired great reputation in Hongkong. The firm subsequently went into liquidation and the goodwill of its business together with the trade marks in question was sold by the liquidator to the plaintiff firm Leuba, who, thereafter, carried on the business and continued to use the trade marks. The Hongkong business of selling watches belonged thereafter to Madame Bovet to whom the plaintiffs were supplying all their watches for the Hongkong market. The marks had been registered by the firm of Bovet in Switzerland and England and were assigned to the plaintiffs when they bought the business. The plaintiffs contended that they were entitled to the exclusive use of the marks in Hongkong. It was shown by the defendants that in Hongkong the business, on the incidents of which the plaintiffs relied, was *de facto* not the plaintiffs', and was not carried on for them, but belonged to Madame Bovet. It was contended that the plaintiffs had, accordingly, not acquired exclusive title to the marks in Hongkong and should be non-suited. This contention was accepted by their Lordships of the Privy Council, who observed that the relation in which the plaintiffs stood to Madame Bovet was simply that of a manufacturer to a customer, and that the plaintiffs had not, in the circumstances, shown sufficient interest to bring the action. "It is quite true" said their Lordships "that the respondents are interested in the success of Madame Bovet's business, but this can never put them in her shoes in vindicating her rights against wrongdoers."

**Cowie & Co. v. Patel Bros.**—The rulings in the above cases were approved, and followed by the Rangoon High Court in *Cowie*

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(11) 25 R.P.C. 673. See also *Ingenohl v. Wing On & Co. (Shanghai)*, *Ld.*, 44 R.P.C. 343.

*& Co. v. Patel Bros.*<sup>12</sup> The plaintiffs were importing and selling in Burma iron panels with the mark of a horse and a peacock or two peacocks and claimed exclusive use of these marks. The defendants admitted importing iron panels with similar marks, but denied the plaintiffs' title to the trade mark. It was contended on their behalf that they had imported, and could lawfully do so, cast iron panels from England with the design complained of as it was one of the stock designs of the manufacturers in England. The defendants applied for a commission to Scotland to take evidence of the Directors and servants of the Burnback Foundry Co., Ltd., to support their case. The plaintiffs, however, contended that such evidence as was sought to be taken in Scotland, was wholly irrelevant, because, even assuming the defendants' statement to be correct, it would be no defence to the suit, as the plaintiffs claimed prior user in Burma. Beasley, J., held that the question whether the manufacturers in Scotland have or have not used the trade mark in Scotland or in England or elsewhere than in Burma, could have no bearing whatever in the case, and that the only question for decision was, whether the plaintiffs or the defendants were the prior users of the mark in Burma. As those questions should be decided solely by local evidence the application for taking evidence abroad was dismissed with costs.<sup>13</sup>

**Aliens may acquire title.**—In general, any person who is capable of acquiring other species of property, can acquire a trade mark. The term person includes any corporation or company.<sup>14</sup>

There is no restriction as regards the nationality of the person who may acquire title to a trade mark in India. The law in this respect follows the English law. In the early English case, *The Collins, Co. v. Brown*,<sup>15</sup> where the trade mark of an American firm of edge tool manufacturers was infringed in England by an English maker, demurrer by the defendant on the ground of the plaintiffs' alienage was overruled by Vice-Chancellor Wood. His Lordship said: "If a man has been in the habit of using a particular mark for his goods for a long time, during which no one else has used a similar mark, and then another person begins to use the same mark, that can only be with a fraudulent intent; and any

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(12) A.I.R. 1924 Rang. 333.

(13) See also *Christy & Co. v. Tipper & Son*, 21 R.P.C. 95, where a commission to America to prove user of the mark in that country was refused, as being unnecessary to prove knowledge of user by people in England.

(14) *Pakir Mahomed v. Emperor*, A.I.R. 1919 Rang. 322.

(15) (1857) 3 K. & J. 423; Seb. Dig., p. 84.

fraud may be redressed in the country in which it is committed, whatever may be the country of the person who has been defrauded." In *Collins Co. v. Cowen*,<sup>16</sup> which was also decided at the same time, the same Vice-Chancellor observed as follows: "I apprehend that every subject of every country, not being an alien enemy—and even to an alien enemy the court had extended relief in cases of fraud—has a right to apply to this court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right—a right recognised, I imagine, everywhere in the world, or at least in every civilized community—of saying, 'We being the manufacturers of certain goods, claim that another man shall not manufacture goods, and put upon them our trade mark, and then pass them off as manufactured by us.'" And, in *Collins Co. v. Reeves*,<sup>17</sup> Vice-Chancellor Stuart said: "The plaintiffs, if they have an exclusive right to the use of the trade marks in question, are entitled to the protection of this court in the enjoyment of such use. Though they are aliens, they are entitled to sue in this court against any fraudulent invasion of their right".

The trade mark rights of aliens have always been recognised and protected by the Indian courts. One of the earliest reported cases is *Orr-Ewing v. Chooneeloll Mullick*,<sup>18</sup> in which it was held by Morgan, J., that the plaintiffs, although a firm of foreign manufacturers, were entitled to an injunction restraining the defendant from infringing their trade mark rights acquired in India. The following cases may also be cited where the courts have recognised the rights of trade mark owners irrespective of their nationality:—*Taylor v. Virasami Chetty*,<sup>19</sup> *Orr-Ewing & Co. v. Grant, Smith & Co.*,<sup>20</sup> *Lavergne v. Hooper*,<sup>21</sup> *Ralli v. Fleming*,<sup>22</sup> *Reddaway v. Smidt*,<sup>23</sup> *West End Watch Co. v. The Berna Watch Co.*,<sup>24</sup> *Wulfig (von) v. Jivandas & Co.*,<sup>25</sup> *Imperial Tobacco Co. v. Albert*

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(16) (1857) 3 K. & J. 428; Seb. Dig., p. 84.

(17) 28 L.J.Ch. 56; Seb. Dig., p. 91. See also *Collins Co. v. Walker*, 7 W.R. 222; Seb. Dig., p. 95; *Farina v. Cathery*, Seb. Dig., p. 164; *Key v. Lecouturier*, 25 B.P.C. 265; *Grant v. Levitt*, 18 R.P.C. 361.

(18) (1865) Cor. 150; Seb. Dig., p. 141.

(19) 6 Mad. 108.

(20) 2 Hyde 185.

(21) 8 Mad. 149.

(22) 3 Cal. 417.

(23) 9 C.W.N. 281.

(24) 35 Bom. 425.

(25) A.I.B. 1926 Bom. 200.

*Bonnan*; <sup>1</sup> *Badische Aniline and Soda Fabrick v. Maneckji Shapurji Katrak*.<sup>2</sup>

**Rights of importers and dealers.**—Since the law recognises the prior user of the mark in British India as the only person who has an exclusive title to the mark, it naturally follows that an importer or selector of goods may acquire such title. “The plaintiff’s goods need not be manufactured by the plaintiff. They may be goods which he purchases or which he imports or otherwise acquires, and which he sells under some get up which conveys that they are goods which, whether made, imported, or sold by him, carry with them the advantage of the reputation that the plaintiff’s well-known firm are responsible for their quality or their character.”<sup>3</sup> In the *Imperial Tobacco Co. of India, Ltd. v. Albert Bonnan and Bonnan & Co.*,<sup>4</sup> the Privy Council observed: “It is possible for an importer to get a valuable reputation for himself and his wares by his care in selection or his precautions as to transit and storage, or because his local character is such as that the article acquires a value by his testimony to its genuineness; and if therefore goods, though of the same make are passed off by competitors as being imported by him, he will have a right of action.”

In *Damodar Ruttonsey v. Ruttonsey Hormusji Adarjee*<sup>5</sup> the plaintiff who imported Will’s cigarettes had by an agreement with the manufacturers reserved to himself an independent right to the trade mark used on the imported goods sold in the Indian market. It was shown that the public associated the goods bearing the mark with the importer, and that the popularity of the cigarettes was entirely due to the exertions of the plaintiff. It was held by Strachey, J., that the plaintiff had acquired exclusive title to the trade mark and his decision was confirmed on appeal. In *Taylor v. Virasami Chetty*<sup>6</sup> the plaintiff had been importing and selling shirting impressed with a trade mark consisting of five *talwars* or swords. The defendant had also recently imported shirting impressed with the mark of five *talwars* which mark, the plaintiff alleged, was an infringement of his trade mark. It was shown

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(1) A.I.R. 1924 P.C. 187.

(2) 17 Bom. 584.

(3) *Dental Manufacturing Co., Ltd. v. de Trey & Co.*, 29 R.P.C. 617, Buckley, L.J.

(4) A.I.R. 1924 P.C. 187.

(5) Unreported (Cited in 30 Bom. at p. 78 and 35 Bom. 432).

(6) 6 Mad. 108.

that the plaintiff was the first to use the mark in the Madras market and that the goods bearing the said mark came to be exclusively associated with the plaintiff's goods and were known as "Katti or Talwar goods". The court held that the plaintiff had acquired an exclusive right to the use of the "talwar" device and a perpetual injunction was granted against the defendant. In *Ralli v. Fleming*<sup>7</sup> Mr. Justice Markby observed that it was only an extension of the general law of trade marks that a trader who merely imported goods could claim exclusive title to a mark. "The confidence reposed in the skill, care and honesty of a particular firm may give a special value to goods imported by them."

In *The West End Watch Co. v. The Berna Watch Co.*<sup>8</sup> the plaintiffs had been importing into and selling in India watches manufactured at St. Imier factory in Switzerland. The watches bore the names "Berna" and "West End Watch Co." on the dial, and came to be known in the Indian market as "Berna watches". The plaintiffs subsequently began to import watches from other manufacturers, and ceased giving orders to the St. Imier factory. The defendants, thereafter, opened an office in Bombay and commenced selling "Berna" watches. Injunction was granted restraining the defendants from using the mark "Berna" on their watches on the ground that it was the importers' mark. In the course of the learned judgment Sir Basil Scott, C.J., said: "the importer, who by advertising and pushing the sale of goods under a particular mark secures a wide popularity for the mark in relation to the goods sold by him, is entitled to the protection of the court for that mark in the country of importation, even against the producer of the goods." His Lordship further observed that, although, the word "Berna" originated with the manufacturers it was proved that the buyers were not interested to inquire at what factory the imported watches were made, and that the word "Berna" had become associated in the minds of the public with a popular kind of watch sold by the plaintiffs.

The importer's title to the exclusive use of his trade mark in India is discussed in the following cases:—*Orr Ewing v. Chooneeloll Mullick*,<sup>9</sup> *Lavergne v. Hooper*,<sup>10</sup> *Barlow v. Gobindram*,<sup>11</sup>

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(7) 3 Cal. 417.

(8) 35 Bom. 425.

(9) *Coryton (Bengal)*, 150.

(10) 8 Mad. 149.

(11) 24 Cal. 364.

*Noorooddeen Sahib v. Charles Souden*; <sup>12</sup> *Ebrahim Currim v. Essa Abba Sait*; <sup>13</sup> *Cowie & Co. v. Patel Bros.*; <sup>14</sup> *Holland Bombay Trading Co. v. Buktcar Mull and Bal Kissen*; <sup>15</sup> *Vadilal Sakalchand v. Burditt & Co.*; <sup>16</sup> *Heiniger v. Droz*; <sup>17</sup> *Imperial Tobacco Co. of India, Ltd. v. Albert Bonnan and Bonnan & Co.*; <sup>18</sup> *Badische Aniline and Soda Fabrik v. Maneckji Shapurji Kutrak*; <sup>19</sup> *Pakir Mahomed v. Emperor*; <sup>20</sup> *John Smidt v. Reddaway & Co.*; <sup>21</sup> *Latif v. Emperor*; <sup>22</sup> *Dunbar v. Holland Bombay Trading Co.* <sup>23</sup>

**Agent does not acquire title to the manufacturer's mark.—**

But a trade mark which represents not the importer's reputation but the manufacturer's is under the control and protection of the latter, not of the former. The importer cannot, in the circumstances, have any cause for action against the infringer of the mark, as he is not in the legal sense aggrieved at the infringement of a trade mark, which does not belong to him but to the manufacturer. In such cases the importer will be non-suited. An importer can only protect a trade mark representing his own reputation and indicating importation by him. <sup>24</sup> As Lord Justice Fry said in *re Apollinaris Company Ltd.'s Trade Marks*, <sup>25</sup> "the mark of a manufacturer, pure and simple cannot be assumed by an importer from the manufacturer" as "other goods of the manufacturer might reach the hands of other dealers who might justly affix to them the manufacturer's mark." Otherwise, "a manufacturer in Paris using a trade mark well-known in England could allow A to register it as his trade mark, and thereby prevent B and C who bought from the Paris maker from selling in

(12) 15 M.L.J. 45.

(13) 24 Mad. 163.

(14) A.I.R. 1924 Rang. 333.

(15) 8 C.W.N. 421.

(16) 30 Bom. 61.

(17) 25 Bom. 433.

(18) 51 Cal. 892; A.I.R. 1924 P.C. 187; 29 C.W.N. 81.

(19) 17 Bom. 584.

(20) A.I.R. 1929 Rang. 322.

(21) 9 C.W.N. 281; 32 Cal. 401.

(22) 39 All. 123.

(23) 12 S.L.R. 129; A.I.R. 1919 Sind 93.

(24) See observations of Lord Justice Fry in *re Apollinaris Company Ltd.'s Trade Marks*, (1891) 2 Ch. 186. See also *Dental Manufacturing Co., Ltd. v. de Trey & Co.*, 29 R.P.C. 617; *Richards v. Butcher*, 7 R.P.C. 288.

(25) (1891) L.R. 2 Ch. 186.

England.” So, in *Heiniger v. Droz*<sup>1</sup> it was held that, although the plaintiff was the sole importer in India of the watches having the mark complained of, he had failed to show that the value of the trade which he carried on, was due to the reputation acquired by, and attaching to, the trade mark, as a guarantee of importation by him, and not merely as a guarantee of manufacture by somebody else; the plaintiff was, accordingly, not entitled to the injunction asked for.

“**Jori Mal**” case.—In *Vadilal Sakalchand v. Burditt & Co.*,<sup>2</sup> the plaintiffs were importers of piece-goods and their label contained the picture of a youth and girl, in fancy costume (“Jori Mall”). The plaintiffs’ orders for goods with the label were executed by Messrs. Ashwell & Co., in London, whose successors in business, were the defendants. The name of the plaintiff company was printed on the blank borders of the picture. At the same time, Messrs. Ashwell & Co., had put two similar tickets by the side of the label with their own name on them. The defendants proceeded to place the label with the picture on goods manufactured for and sold by them, leaving the border of the label blank, or inserting on the border, their own name, or by special request, the names of the constituents, by whom the goods were ordered. It was not expressly stipulated that Messrs. Ashwell & Co. should not supply goods under the label to constituents other than the plaintiffs. It was held that, in the absence of a contract with the manufacturer, a vendor of goods had no exclusive right to a mark which merely denoted that he was the seller of goods manufactured by a certain company, even though he may have designed the mark.

**Hirsch v. Jonas.**—In *Hirsch v. Jonas*,<sup>3</sup> which was followed in the above case, the plaintiff who was a London cigar merchant imported cigars made by Genir, of Havanna. At the plaintiff’s suggestion the cigars were labelled “Gloria de inglaterra”, to which Genir added his own name. These cigars were supplied solely to the plaintiff until shortly before the commencement of the action, although there was no contract for such exclusive supply. The defendants, who were the new London agents of Genir, began to sell cigars similarly labelled. The plaintiff’s motion for an injunction was refused. Jessel, M.R., said: “I can

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(1) 3 Bom.L.R. 1; 25 Bom. 433.

(2) 30 Bom. 61.

(3) 3 Ch.D. 584; 45 L.J.Ch. 364; Seb. Dig., p. 296.

understand a man saying 'I am not the actual manufacturer of goods but the selector of goods, and my reputation for cleverness and selection is so great that goods marked with the mark to show that they had been selected and approved of by me, will fetch a higher price in the market'. If Hirsch had put on 'gloria de inglaterra Havannah cigars selected by Hirsch' he might have had a case to prevent other people imitating that. It would show that the cigars selected were approved of by him. If he got a great reputation in that way, I can understand he would have a right of protection for that which indicates to the public that the cigars were selected and approved of by him. That is not his case. There is nothing on the boxes to show anything about Hirsch at all. All he says is that the trade knows this mark as denoting cigars sold by him, which I dare say it does. It appears to me at present that he has no case whatever and there is no use my granting an injunction."

**Richards v. Butcher.**—In *Richards v. Butcher*<sup>4</sup> the plaintiff had obtained by an agreement with Messrs. Heidsieck & Co., the producers of a well-known champagne, the exclusive right to sell in England the brands of wine manufactured by them. An action was brought against the defendant for infringing the trade marks "Monopole" which had been registered by Messrs. Heidsieck & Co. and used by them on wines sold in England by the plaintiff. The defendant contended that the suit could not be maintained, as the plaintiffs were not the registered owners or assignees of the trade marks in question. The plaintiffs were non-suited. Mr. Justice Kay, observed: "Messrs. Heidsieck have contracted that they will not sell any of their wine to any other persons in England except Mr. Richards; but if, by any means whatever, another person in England gets Heidsieck's wine, if he buys in France, or buys it in Germany, or in England, or buys it of the plaintiffs, or buys it of anybody else, he has a right to sell it; it is an article of commerce in which he has a perfect right to deal. It is said, we admit, as, of course, the plaintiffs are bound to admit, that every purchaser of Heidsieck's wine, or every purchaser of Heidsieck's wine in this country could not maintain a suit for such an injunction as we have brought, but we can do so because

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(4) 7 R.P.C. 288. See also *Application by Naamlooze Vennootschap Fabriek van Chocolade en Suikerwerken, J. C. Klene & Co.*, 40 R.P.C. 103; *Lacteosote, Ltd. v. Alberman*, 44 R.P.C. 211; *John Sinclair's Trade Mark case*, 49 R.P.C. 123; *Dental Manufacturing Co., Ltd. v. de Trey & Co.*, 29 R.P.C. 617.



by bargain with Messrs. Heidsieck's we have exclusive right. Let me examine what that means. It means no more than this, that Messrs. Heidsieck bargained for value no doubt, with the plaintiffs. that they would not sell to any other Englishman for sale in this country except to them. How does that give them a right to restrain which other purchasers of Heidsieck would not have had? I cannot follow the argument. They cannot prevent any other purchaser of Heidsieck from selling. Any other purchaser of Heidsieck has as much right to sell in this country as they have. Messrs. Heidsieck could not prevent them themselves. . . . Therefore the utmost that that bargain gives the plaintiffs is a right to bring an action against Messrs. Heidsieck, if Messrs. Heidsieck should consign to any other person for sale in this country their wine except to the plaintiffs."

**Imperial Tobacco Co. v. Bonnan.**—A tradesman may thus acquire goods from a manufacturer and sell them in competition with the manufacturer himself or his agent even in a country into which the manufacturer or his agent has hitherto been the sole seller of the goods. In the *Imperial Tobacco Co. of India, Ltd. v. Albert Bonnan and Bonnan & Co.*,<sup>5</sup> the defendants had purchased huge stocks of Will's Gold Flake cigarettes from surplus stores sold by the British Army Canteen authorities, the sale being subject to the condition that they were not to be resold in the United Kingdom. The defendants imported these cigarettes into India for sale. The plaintiffs instituted a suit for passing-off basing their claim on the ground that they had acquired exclusive title to the mark in India. The main issues raised were, whether the plaintiffs were entitled as against the defendants to the exclusive use of the mark or get-up by reason of such sole importation and sale, and whether they could prevent the defendants from selling cigarettes with such get-up, though they had, in fact, been manufactured by the British American Tobacco Co., who were the successors of the original firm of W. D. & H. O. Wills. The case was heard by Pearson, J., who found on the evidence that "the reputation of the brand of Gold Flake cigarettes in India is the reputation of the maker and not of the plaintiff company as importers." His Lordship said that "the reputation originated in days of Messrs. W.D. & H.O. Wills, the original manufacturers,

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(5) A.I.R. 1924 P.C. 187. A suit for malicious prosecution brought by Alfred Bonnan against the Imperial Tobacco Co., after the decision in the above case was dismissed with costs by the Privy Council. *Albert Bonnan v. Imperial Tobacco Co. of India, Ltd.*, A.I.R. 1928 Cal. 1; A.I.R. 1929 P.C. 222.

and the efforts of the plaintiff company have been directed not to the creating or acquiring (if such a thing is possible) an importer's reputation for themselves in the brand but in maintaining and developing the reputation of the brand as a manufacturer's brand." The decree was affirmed by Sanderson, C.J. and Richards, J. The Chief Justice said: "In my judgment the sole representation made by the plaintiffs' user of the covering of the cigarettes was a representation that the cigarettes were the Gold Flake cigarettes manufactured by the successors of the well-known firm of W.D. & H.O. Wills. There is no evidence to justify the alleged representation (on which the plaintiffs relied) that cigarettes bearing the said wrapper or covering had come through a particular channel or had been imported by the plaintiffs. In the same way the defendant by using the wrapper or covering was merely representing the cigarettes as Gold Flake cigarettes manufactured by the successors of the well-known firm of W.D. & H.O. Wills, viz., the British American Tobacco Co. This was perfectly true representation and the defendant was in no way passing-off or attempting to pass-off the cigarettes sold by him as the plaintiffs' goods." The appeal by the plaintiffs was rejected by their Lordships of the Privy Council. "The claim of the appellant company", said their Lordships, "is that it can stop a trader to whom goods have been lawfully sold under a particular description and by whom they have been lawfully bought under that description, from reselling them under the same description. Such a claim sounds extravagant."

**Title cannot be acquired by wrongful user.**—Inasmuch as a trade mark right is an equitable right the plaintiff who seeks the intervention of the court must come with clean hands. A person cannot be protected in the use of a trade mark the purpose and effect of which is to swindle the public. He cannot complain that, owing to the fraudulent competition by other traders, his own fraudulent profits are diminished. In other words, he cannot claim an exclusive privilege for the purpose of deceiving the public. A wrongful or fraudulent user gives no title to a trade mark even though such user had extended over a long period. A trade mark is a mode of warranting the origin of goods to which it is attached, or their trade association, and it is of the essence of the trade mark that its representation should be true.<sup>6</sup> In *McAndrew v. Bassett*,<sup>7</sup>

(6) *The British American Tobacco, Co., Ltd. v. Mahboob Buksh*, 15 C.W.N. 280; 38 Cal. 110.

(7) 4 De G. J. & S. 380.

Lord Chancellor Westbury said that one of the essential elements for constituting an infringement of the right to a property in a trade mark was that the mark had been applied by the plaintiffs properly, which meant that they had not copied any other person's mark, and that the mark did not involve any false representation. Nor can the plaintiff plead that the misrepresentation is so grossly false that the public are not likely to be deceived by it. "I cannot receive it as a rule, either of morality or equity", said Lord Westbury in the *Leather Cloth case*,<sup>8</sup> "that a plaintiff is not answerable for a falsehood, because it may be so gross and palpable as that no one is likely to be deceived by it. If there be a wilful false statement I will not stop to inquire whether it is too gross to mislead." The Lord Chancellor held in the above case that the plaintiffs were disentitled by reason of the mis-statements contained in their stamp.

In *Sen v. Oakes*<sup>9</sup> the plaintiff imported bicycles manufactured at Glasgow and sold them as the product of a non-existent company called the "Warrior Cycles Company, Birmingham". In refusing to grant an injunction, Woodroffe, J., observed: "I am of opinion that the appeal must be decreed and the suit must be dismissed on the ground that the mark of which protection is sought contains a misrepresentation. I need not consider whether it is necessary that the misrepresentation should be material. It seems to me to be right, that in a case of this kind, where the Court's protection is asked, that it should demand the strictest accuracy and that any mis-statement should disqualify for relief. For the court should not have to enter into such inquiries in the case of those, who wilfully state what is not the fact."

#### **Rights limited to class of goods for which user is acquired.—**

A trade mark can only be acquired by user in respect of the goods on which the mark has been used. In *Hall v. Barrows*,<sup>10</sup> Lord Chancellor Westbury said: "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract; thus an iron founder who has a particular mark for his

(8) *The Leather Cloth Co. (Limited) v. The American Leather Cloth Co. (Limited)*, 4 De G. J. & S. 137; 33 L.J.Ch. 199.

(9) 24 C.W.N. 155. See also *Abdul v. Mahamadali*, 3 Bom.L.R. 220, where injunction was refused as the plaintiff's label was a deliberate combination of the trade marks of his rivals.

(10) 4 De G. J. & S. 150; 33 L.J.Ch. 204; 12 W.R. 322; Seb. Dig., p. 121.

manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods." The right to a trade mark is a limited one in the sense that the use of the same mark in connection with a different article is not an infringement of such rights. For, where the goods are not of the same description the mark is not likely to cause deception of the public and there cannot be any passing-off. In *Ainsworth v. Walsmsley*,<sup>11</sup> Vice-Chancellor Wood said: "If a manufacturer does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods and caused his goods to circulate with this mark upon them, the Court has said that no one shall be at liberty to defraud that man by using that mark, and passing-off goods of his manufacture as being the goods of the owner of that mark." In *Somerville v. Schembri*,<sup>12</sup> Lord Watson similarly observed: "The acquisition of an exclusive right to a mark or name in connection with a particular article of commerce cannot entitle the owner of that right to prohibit the use by others of such mark or name in connection with goods of a totally different character, and such use by others can as little interfere with his acquisition of the right. In the present case it is beyond dispute that these cigarettes made by the appellant's firm were favourably known in the market where they were sold under the appellation of "Kaiser-i-Hind". The use of the name by others as a name for ships, or as a Trade Mark for hats, soap or pickles, could not impede this acquisition of an exclusive right to use that as a Trade Mark for their cigarettes."

It is therefore possible that the title to a trade mark in one class of goods may belong to one person while the title to the identical mark in a different class of goods may belong to another. A person who has the title to the trade mark in one class of goods cannot, then, use the mark in connection with the second class of goods. So, in the case of *Upper Assam Tea Co. v. Herbert & Co.*,<sup>13</sup> where the proprietors of a mark which had been used and registered

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(11) L.R. 1 Eq. 518; 35 L.J.Ch. 352; 14 W.R. 363; Seb. Dig., p. 152.

(12) 12 App. Cas. 453; 4 R.P.C. 179. See also, *Badische Aniline und Soda Fabrick v. Tejpall Godoo*, 5 Bom.L.R. 1025; *Thomas Bear & Sons (India) v. Prayag Narain*, A.I.R. 1935 All. 7. See Chapter VI.

(13) 7 R.P.C. 183.

for coffee in 1876, began, in 1889, to apply it to tea, they were restrained by the court from so doing on a motion by the plaintiffs who had registered a similar mark for tea in 1877.

**Classification of goods under the English Act.**—The principle of common law set forth above limiting title to a mark to the class of goods for which right of user has been acquired finds statutory recognition in the English Act. Goods have been divided into fifty classes<sup>14</sup> and Rule 5 provides that if any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Registrar. It will be observed that in many cases a class comprises a number of very different kinds of goods and a trade mark may be registered for one or more classes. Registration in a class does not, however, confer a right to sue in case of infringement of goods of kinds other than those for which the registered proprietor has actually used the mark. In several cases the courts have passed orders confining the registration to the particular goods or description of goods (and not necessarily to all the goods included under the class) with which only the registered trade mark had been used. The effect of registration in any particular class was explained in a recent case<sup>15</sup> by Mr. Justice Farwell, in the following passage: “At first sight that might appear to indicate that, if a person registered a trade mark in a particular class he obtained a monopoly for that mark in connection with any of the goods comprised within that class in which he was registered. That, however, need not necessarily be so. The various classes in which the various articles are divided by the Trade Marks Act are, in many cases, extraordinarily wide. There are included in one class all kind of articles which in themselves differ widely from each other, but which are included because they have some common source, are made from the same material, or some such reason as that. If a person chooses to register a mark in a

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(14) For the recently proposed International Scheme of classification of goods, see Appendix XVII.

(15) *C. & T. Harris (Calne), Ltd. v. F. S. E. Harris*, (1934) 51 R.P.C. 98. Held that there was no infringement and no passing-off as the plaintiff's reputation extended only to British bacon (Harris' mark) and the defendant had made clear to his customers that he traded in Danish bacon. Similar observations were made by Lindley, L.J., in the *Australian Wine Importers' case*, 6 R.P.C. 311, “For the purpose of deciding whether two sets of goods are of the same description, we must not, it appears to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in different classes, and goods of different description in the same class.”

class which is a wide one, without limiting it in any way at all, he may find that he does not get protection for the whole class, as he may not have a monopoly of the mark in connection with some of the goods or articles which come within that class. In cases where the mark has, in fact, been used by the registered owner in connection with or upon a particular class of goods and no others, that protection may not extend to prevent other persons using the mark in connection with articles in the same class, so long as they are clearly different articles, easily distinguishable from one another." A leading authority for this proposition is *Edwards v. Dennis*.<sup>16</sup> In that case, the plaintiff had registered the word "Neptune" for goods under class 5 but had used it only for iron sheets. The same mark was subsequently used by the defendant for iron wire, and although class 5 included both iron sheets and iron wire, the court refused to grant an injunction, and ordered the Registrar to restrict the registration of the plaintiff's mark to iron sheets only. This decision was based on the ground that the articles in question were dissimilar as far as their appearance and use went, although they were of the same material and were included under the same class.

**Trade mark right in India is a right to Industrial Property as defined by the Convention.**—In *Wulfig (von) v. Jivandas & Co.*,<sup>17</sup> the question arose whether a right to a common law trade mark in India is a right to Industrial Property in the same sense as a right in a registered trade mark is in England and other countries. The plaintiffs had for several years prior to 1914 manufactured and sold certain chemical compounds under the well-known names "Sanatogen" and "Formamint". During the war the plaintiffs' London firm from which the above compounds

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(16) 30 Ch.D. 454. See also *Braby & Co.'s Application*, 21 Ch.D. 223; *Upper Assam Tea Co. v. Herbert & Co.*, 7 R.P.C. 183; *Hargreaves v. Freeman*, 8 R.P.C. 237; *Batt & Co.'s Trade Mark*, 2 Ch. 432; 15 R.P.C. 262 at p. 534, 16 R.P.C. 411; *Suter, Hartmann & Rahtjen's Composition Co. Ltd.'s Trade Mark*, 19 R.P.C. 42; *Leiner's Application*, 20 R.P.C. 253; *Anglo-Swiss Condensed Milk Co.'s Trade Marks*, 20 R.P.C. 509, 21 R.P.C. 261; *Hare's Trade Mark*, 24 R.P.C. 263; *Paine & Co. Ltd.'s Trade Mark*, 25 R.P.C. 329; *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R.P.C. 45; *Volkart Bros' Trade Mark*, 31 R.P.C. 498. In the following cases the marks were held to be calculated to deceive although registered in different classes:—*Australian Wine Importers' Tm.*, 6 R.P.C. 311; *Eno v. Dunn & Co.*, 10 R.P.C. 261; *Turney & Son's Trade Mark*, 11 R.P.C. 37; *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R.P.C. 105; *Finlay v. Shamrock Co.*, 22 R.P.C. 301. See Chapter VI.

(17) A.I.R. 1926 Bom. 200. See Chapter VI, where the theory of property right in trade marks is discussed.

were imported to India, was confiscated and sold by Government under the Enemy Amendment Act to Genotosen Limited. The latter firm, therefore, began to export to India the said compounds. The plaintiffs alleged that after the war they started importing Sanatogen and Formamint from Germany and that their original exclusive title to these two marks was restored by the Treaty of Versailles. The defendants imported in 1923, some consignments of substances under the names "Sanatogen" and "Formamint", which were not of the plaintiffs' manufacture. It was contended on behalf of the defendants that the right to a mark acquired by user did not come under the term 'industrial property' defined by the Article of the International Convention, and that the plaintiffs' right in India to the said marks could not be revived after the war in view of the fact that other persons had meanwhile used these marks. The learned Judge said that a right to a trade mark acquired by user in India is a right to industrial property, and that the right to a trade mark in whatever way acquired in a British country, is a right of industrial property coming under the Conventions of Paris and Berne. Such a right acquired before the war and suspended during the continuance of the hostilities was, under the Peace Treaty revived and restored to the original position as it existed on the outbreak of the war. His Lordship held that the plaintiffs were consequently entitled to the rights in the said trade marks as possessed by them at the outbreak of the war, and that the defendants were infringing those rights by selling under the names "Sanatogen" and "Formamint", compounds, which were not of the plaintiffs' manufacture.

#### (ii) ASSIGNMENT.

**Trade Mark assignable only with goodwill.**—"The right to a trade mark may, in general, treating it as a property, or an accessory of property, be sold and transferred upon a sale or transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by a purchaser."<sup>18</sup> "Inasmuch as the Court protects the owner of the mark, he is entitled to authorize another, when he hands over the business to him, to replace that mark on his goods."<sup>19</sup> A trade mark cannot, however, be assigned in gross. It can be assigned only along with

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(18) Lord Cranworth in *The Leather Cloth Co. (Limited) v. American Leather Cloth Co. (Limited)*, 11 H.L.C. 523; 35 L.J.Ch. 53.

(19) Wood, V.C., in *Ainsworth v. Walsley*, L.R. 1 Eq. 518; 35 L.J.Ch. 352; 14 W.R. 363; Seb. Dig. p. 152.

the goodwill of the business in which the mark is used. The law does not recognise any right in a trade mark *per se* separate from the goodwill of the business concerned in the goods for which the mark has been used. Consequently an assignment of a trade mark without the business confers no effective right.<sup>20</sup> "It has been established since the decision in the *Leather Cloth Co. v. American Leather Cloth Co.*", said Mr. Justice Clauson in the *Sirup Famel* case,<sup>21</sup> "that the purchaser of a mark becomes owner of it only if he becomes at the same time the purchaser of the manufactory, or (to put it rather more widely in view of modern developments) the business concerned in the goods to which the mark has been affixed."

The law was stated in *Hannah v. Jagannath & Co.*,<sup>22</sup> by Jenkins, C.J., thus: "It is established that a trade mark cannot be assigned or descend in gross; and this rests on no arbitrary rule, but is a necessary consequence of the inherent nature of a trade mark; for it is a mode of representing the origin of the goods to which it is attached, or their trade association, and the truth of the representation is essential. In its strictest meaning the representation of a trade mark may perhaps only be true of its originator, but usage has sanctioned a more liberal statement based on the principle of identification by succession. And so successors in business have been allowed to use their predecessors' trade marks where the representation continues to be sufficiently true."

The above principle of common law has been embodied in S. 22 of the British Trade Marks Act. A registered trade mark can be assigned only in connection with the goodwill of the business concerned in the goods for which it has been registered. Thus, in *Harness' Trade Mark case*,<sup>23</sup> Farwell, J., observed: "It is necessary that there should be a goodwill to go with the trade mark or it cannot be assigned," and "Mr. Roberts has no title to be on the Register at all in respect of the assignment which he took, because it was an inoperative assignment by reason of there having been no trade or business in Mr. Harness when he executed that assignment." And, for a similar reason, the House of Lords

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(20) *Ullmann & Co. v. Leuba*, 25 R.P.C. 673.

(21) *Lacteosote, Ltd. v. Alberman*, 44 R.P.C. 211.

(22) A.I.R. 1915 Cal. 520; 19 C.W.N. 1.

(23) 17 R.P.C. 40. See also *Johnson's Trade Mark case*, 26 R.P.C.



held in the *Bowden Wire case*<sup>24</sup> that the assignment was void, and ordered that the mark should be expunged from the Register.

**Pinto v. Badman.**—In *Pinto v. Badman*<sup>25</sup> a Mexican cigar manufacturer of the name M.P. Garcia was the owner of a trade mark which consisted of the Spanish words “El Destino”. Garcia then sold the brand to Messrs. Rendon & Co., retaining however, the manufacturing business. It was agreed that Garcia should not sell cigarettes under that brand. On the same day Messrs. Rendon & Co., sold half the rights acquired by them to the plaintiffs Messrs. L. H. Pinto. It was contended by the defendants that the assignment of the trade mark to the plaintiffs was bad as being an assignment in gross. The Court of Appeal held that judgment should be entered for the defendants. Lord Esher, M.R., said that all that the original manufacturer sold was the trade mark, and not any part of the business and that inasmuch as there was nothing sold but the right to the trade mark the plaintiff had not acquired title to the mark. “What Garcia sold to the plaintiffs, when you come to look at it, was the right to put upon their, the plaintiffs’ goods, a mark which would indicate to the public that those goods of the plaintiffs were really goods coming from the manufactory of Garcia, and that in the language of the law is called a fraud upon the public, and is not allowed by the law of England.” And Lord Justice Fry observed: “The question comes to be one of law, and by the English law can a trader, who has used a brand upon a particular article, and who continues to manufacture that article alienate that brand to another person, so as to give that alienee any right whatever? It appears to me that, upon first principles he can have no such right. The brand is an indication of the origin, and if you transfer the indication of origin, without transferring the origin itself, you are transferring a right, if any right at all, to commit a fraud upon the public, and such right is not recognised by the law of England.” After citing the *Leather Cloth Co., Ltd.’s*, case the learned Lord Justice proceeded: “It follows, therefore, that a trade mark can be assigned when it is transferred together with, to use Lord Cranworth’s language, “the manufactory of goods in which the mark has been used to be affixed”. Beyond that, so far as my knowledge goes, and so far as any case that has been cited to us at the bar is concerned, no authority can be produced. Therefore, I conceive, that that is the

(24) *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R.P.C. 45, 580; 31 R.P.C. 385.

(25) 8 R.P.C. 181.

limit of the assignability of trade mark. It can be assigned if it is indicative of origin when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor."

**British American Tobacco Co., Ltd. v. Mahboob Buksh.**—

A leading Indian authority on this point is the *British American Tobacco Co., Ltd. v. Mahboob Buksh*.<sup>1</sup> One Kasim Lall Kabasi a cigarette manufacturer was the proprietor of four trade marks one of which consisted of the words "Sri Durga". It was alleged that Kabasi assigned to the plaintiff company all the trade mark, name, and label known as the "Sri Durga" trade mark, and the goodwill of his said business, so far as the same related thereto. But neither Kabasi's manufactory nor his business was assigned along with the mark. It also appeared that Kabasi was not carrying on in any sense a separate business in respect of each or any of the cigarettes sold under the several brands. The marks were used indiscriminately and no separate accounts were kept. It was held that the assignment was not valid. Jenkins, C.J., said that a mere verbal compliance with the condition that an assignment of goodwill should accompany the transfer of a trade mark was not enough. "In order that the assignment may be valid the trade mark should still continue to be a representation of truth within the limits of deviation sanctioned by the usages of trade and commerce." "Without in any way suggesting that a man or a firm may not have distinct businesses capable of separate assignment, it appears to me that for the purpose in hand it is straining the argument beyond breaking point to urge that a cigarette seller may have as many businesses as the brand of cigarettes he sells."

**Sinclair Ltd.'s Trade Mark.**—The question as to the extent to which goodwill in the business should accompany an assignment of a trade mark was recently brought into prominence in *John Sinclair Ltd.'s Trade Mark case*.<sup>2</sup> The case illustrates the hardships of the commercial community in respect of assignment of trade marks under the existing law, and formed the subject of

(1) 15 C.W.N. 280; 38 Cal. 110.

(2) 49 R.P.C. 123 (*Lacteosote, Ltd. v. Alberman*, 44 R.P.C. 211, was followed). The judgment in the Sinclair case was commented upon by the Goschen Committee in their report, para 105, page 26, and it led to their making some far-reaching recommendations. See Goschen Committee's Report, pp. 26-30. See also *George Dobie & Son Ltd.'s Trade Mark*, 52 R.P.C. 333, where the Sinclair case was followed.

discussion before the Goschen Committee. Messrs. Carreras, Ltd. the well-known tobacco manufacturers, registered in 1923, a trade mark consisting of a figure in eighteenth century costume, with the word "Tatler" written above, in Class 45 in respect of tobacco manufactured or unmanufactured. On the 24th January, 1930, the trade mark "together with the goodwill of the business concerned in the goods with respect to which the said trade mark is registered" was assigned to John Sinclair Ltd., by Carreras Ltd. Before assignment the sale of the Tatler cigarettes by Carreras was comparatively small, being about 89,000 in the year before assignment. Since the assignment Sinclair Ltd. pushed the sales so successfully that they were able to sell about 69 millions of these cigarettes in about a year. The assignee entered into an arrangement with Carreras Ltd., whereby, the latter manufactured all the cigarettes for Sinclair Ltd. The cigarettes were sold under the Tatler mark as the goods of Sinclair Ltd., and their address was printed on the cartons in which the cigarettes were sold. The applicants, Arcadian Company Ltd., contended that the assignment was in contravention of the provisions of S. 22 of the English Trade Marks Act, and moved for expunging the mark from the register. It was held that the assignment was invalid. Mr. Justice Maugham said: "There is no evidence to show that there was in connection with 'Tatler' cigarettes, in the ordinary sense, any separate goodwill possessed by Carreras Ltd., other than that possessed by them in respect of their other brands of cigarettes. I am dealing with the question whether there was a separate goodwill at the moment of time prior to the assignment. It is not suggested that the cigarettes in question were made in a particular warehouse by separate people under separate advice and that, in some way or other, there was something different in the way in which the tobacco was bought and the cigarettes were ultimately made up and put upon the market from what was the case with regard to the numerous other brands of Carreras Ltd. Then I ask this question: 'Supposing, which may well be the case, that Carreras Ltd., or any other one of the big vendors of tobacco in this country, had fifty different marks for cigarettes and marketed all the fifty kinds, and supposing the reputation which the whole fifty bore was due to the skill of the buyer, the blender and the manufacturer, and it may be also of the vendor, could Carreras Ltd., or the hypothetical manufacturer having such fifty brands, assert that he had at the moment of assignment fifty goodwills, one in respect of each of those brands

of cigarettes? To my mind it is quite impossible to answer that question in the affirmative in the case of cigarettes or other similar articles made as the result of the work and skill and discrimination of the same group, or groups, of people. To my mind the only thing that can ordinarily be asserted of such an article as I have here to deal with, unless, indeed, having regard to the mode of user, the true view is that the mark indicated before the date of the assignment that the goods in question were manufactured by Carreras Ltd., as the owners of the mark. Either view is fatal to the claim of the respondents in this case. If it is a true manufacturer's mark the Respondents are subject to the fatal difficulty, the fatal objection, that, although the mark purports to be assigned, the business of manufacturing the cigarettes has not been assigned and Carreras still manufacture them. If the true meaning of the mark was that the cigarettes were vouched for by the owners of the mark, Carreras Ltd., and the only thing that has really been assigned with the so-called goodwill is the right to put the cigarettes on the market, still it seems to me equally clear that no true goodwill has been assigned with the cigarettes, because the reputation of Carreras, which, so to speak, was all that was vouched for by the mark, is no longer vouched for in the hands of the Respondents."<sup>3</sup> The decision was affirmed by the Court of Appeal.

**Title to the mark passes by implication with goodwill.**—Inasmuch as there can be no transfer of a trade mark apart from the goodwill concerned in the goods it follows naturally that the right to use a trade mark will pass with the business and goodwill as an incident unless something appears to show a different intention of the parties. In *Shipwright v. Clements*<sup>4</sup> Vice-Chancellor Malins said: "The sale of a business is a sale of the

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(3) Maugham, J., held that the only severance in the goodwill of a business of a manufacturer permitted by S. 22 is one along the lines of the classes into which goods are classified for the purposes of trade marks registration, as "the goodwill concerned in the goods for which the mark has been registered is a single goodwill." Again, in the Court of Appeal Romer, L.J. observed: "It appears to me that the assignment of the trade mark is invalid, in view of S. 22 of the Act. That the section may lead to inconveniences, and, indeed, in some cases, hardship, I can see; but that is no reason why the court should fail to give effect to the language of the section, language which, in my opinion, is perfectly plain and unambiguous." 49 R.P.C. at p. 139. Referring to this case the Goschen Committee remarks that "this decision took many members of the commercial community by surprise" as many assignments had been made in contravention of S. 22 interpreted in this way.

(4) 19 W.R. 599; Seb. Dig. p. 210.

goodwill. It is not necessary that the word 'goodwill' should be mentioned. The defendant sold the business, and with it everything producing profit." The defendant had in that case assigned to the plaintiff all his interests in the perfumery business without specifically referring to the goodwill or trade mark. The defendant subsequently represented that the old business had been removed to his new place and started selling perfumes with the plaintiff's mark. Injunction was granted by the Court to restrain the defendant from infringing the plaintiff's rights. "In the sale of a business", said the learned Vice-Chancellor "a trade mark passes, whether specifically mentioned or not". So also, in *Levy v. Walker*,<sup>5</sup> Lord Justice James said: "I hold that the sale of the goodwill did convey the right to use of the partnership name as a description of the articles sold in that trade and that that right is an exclusive right as against the person who sold it, and as against all the world, if any person in that world were representing himself as carrying on the same business." *William Currie & Co. v. James Currie & Co.*,<sup>6</sup> is another case where the plaintiff had dissolved the partnership and paid the defendant his share of the assets, but no reference was made in the terms to the goodwill or trade marks. The defendant then carried on business independently and was selling wine with the mark "Prince Charlie" which was the mark of the plaintiff firm before the dissolution of partnership. It was held that the plaintiffs were entitled to an interdict and damages.

**When goods are manufactured by secret processes.**—Where the goods with which the trade mark is associated are manufactured under a secret process, the mark is not assignable unless knowledge of the secret process is transferred to the assignee. An early case on this point was *Cotton v. Gillard*.<sup>7</sup> The defendant invented a sauce and sold it under the name, "Licensed Victualler's Relish." The business was after some time carried on by his son. On the latter becoming a bankrupt his interest in the sauce was bought by the plaintiffs from the trustees in bankruptcy. The defendant, however, retained the secret recipe. He then announced his claim to the trade mark and began selling the sauce. Jessel, M.R., dismissed the plaintiffs' suit for injunction on the ground that the trade mark could not exist or be transferred in

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(5) 10 Ch.D. 436; 48 L.J.Ch. 273.

(6) 15 R.P.C. 339.

(7) 44 L.J.Ch. 90; Seb. Dig p. 267.

gross, and that the plaintiffs were not entitled to apply to an article of their own invention the name and mark appropriated to an article, of the recipe of which they were ignorant.

**The Chartreuse case.**—A well-known case illustrating this rule of law is *Rey v. Lecouturier*.<sup>8</sup> The house of the Order of Carthusian monks situated at "La Grande Chartreuse" in France manufactured according to a secret process a liqueur known all over the world as "Chartreuse." The trade name was registered in England in the name of their procurator, Abbe Rey. Under the French Law of Association of 1901 the French Government expelled the monks in 1903, confiscated their property, and appointed the defendant Lecouturier, as the judicial liquidator of the property. "But two things that belonged to them—the secret of their manufacturing process and the reputation which their liqueurs had acquired in foreign countries, and notably in England—were incapable of being seized or confiscated."<sup>9</sup> The monks then set up business at Terragona in Spain. In an action brought in France by Lecouturier against the plaintiff Rey it was decided by the French Court that the goodwill of the monks' business and their trade marks passed by the Law of 1901, to Lecouturier as liquidator. On evidence of these judicial proceedings the Comptroller-General in England on the application of Lecouturier entered his name upon the Trade Marks Register as the proprietor of the English mark in succession to Rey. Lecouturier sold and assigned the whole of his interest in the business, Trade Marks and goodwill, to a French company, who carried on the business of selling liqueurs manufactured by them at the former distillery of the monks, under the old names, in the old bottles, with similar labels. An action was brought in England by Rey and others on behalf of the monks against Lecouturier and the French purchaser of the monks' business for an injunction to restrain the defendants from using the word "Chartreuse" in connection with the sale of liqueurs, other than those manufactured by the plaintiffs. The plaintiffs also applied for rectification of the Register by expunging the name of Lecouturier. It was held by Joyce, J., that there was no passing-off by the defendants and both the actions were dismissed. The decision was, however, reversed on appeal, and an injunction was granted restraining the defendants from

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(8) (1908) 2 Ch. 715; 25 R.P.C. 265; (1910) A.C. 262; 27 R.P.C. 268.

(9) Lord Macnaghten in the House of Lords, 27 R.P.C. at p. 275. See also *Walker & Sons, Ltd. v. Kego* (No. 2), 38 R.P.C. 31.

passing-off. Lord Shaw said that in no view of the French legislation "could it be maintained that it transferred to the liquidator the secrets within the knowledge of the monks who have proceeded to foreign countries, and, particularly in Spain, have put into operation these business secrets, and are manufacturing according to them. In short, the business of 'Chartreuse' liqueur as such, is carried on by them, and the English Trade Marks are therefore trade marks in respect of a thing the business in which is not, and cannot be conducted by the Appellants. The trade marks are in the latter, the business in the monks. My Lords, such severance is not legally possible. . . . To maintain that there can be goodwill in a business, the secret whereof is not transferred, is, of course, out of the question."

**Where special process or recipe is not shown.**—Where the goods are not manufactured according to any secret process the ordinary rule of law will prevail, and the assignment will be held to be valid. In such cases it is sufficient to show that the goodwill of the business was conveyed along with the assignment of the trade mark. Where it is contended that the goods were manufactured according to a secret recipe known only to the assignors and that recipe has not been handed to the assignees along with the assignment of the business, the onus of proving such statements lies on the party alleging them. In the case of *Mumm & Co.'s Application*<sup>10</sup> the business of a German firm Mumm & Co., who were manufacturers of champagne at Rheims in France was sequestered by the French Government and sold by the official liquidator to a French firm. The purchasers as successors of Mumm & Co applied to the Comptroller in England to register them as proprietors of the registered marks of Mumm & Co. Meanwhile, the members of the old firm who settled in Switzerland had also applied to the Comptroller for alteration of their address in the Register. It was contended that the champagne was manufactured according to a secret process known only to the original firm, but as this allegation could not be established the application of the German firm was refused, and the French purchasers were entered on the Register as the proprietors of the marks.<sup>11</sup>

**Personal marks.**—A trade mark may in special cases indicate that the reputation of the goods bearing the mark depends upon the personal skill or supervision of the originator. It would then

(10) 39 R.P.C. 379.

(11) See also *Smith's Trade Mark case*, 44 R.P.C. 533.

be a fraud on the public if the mark be used by persons other than the original person, and no assignment of such a trade mark would be valid. In *Leather Cloth Co. (Limited) v. American Leather Cloth Co. (Limited)*,<sup>12</sup> Lord Kingsdown said: "Though a man may have a property in a trade mark, in the sense of having a right to exclude any other trader from the use of it in selling the same description of goods, it does not follow that he can in all cases give another person a right to use it, or to use his name. If an artist or an artisan has acquired by his personal skill and ability a reputation which gives to his works in the market a higher value than those of other artists or artisans, he cannot give any other persons the right to affix his name or mark to their goods, because he cannot give to them the right to practise a fraud on the public." And in an American case<sup>13</sup> the Supreme Court of Massachusetts expressed this principle of law in the following terms: "There may no doubt be cases where the personal skill of an artist or artisan may so far enter into the value of a product that a trade mark bearing his name would, or at least might imply that his personal work or supervision was employed in the manufacture, and in such cases it would be a fraud upon the public if the trade mark should be used by other persons, and for this reason such a trade mark would be held unassignable."

**Personal marks when assignable.**—On the other hand, the usages of the trade may be such that no such inference would be drawn from the use of the said mark. The mark may not be "so completely personal as of necessity to import that the goods sold under it have been manufactured by a particular individual."<sup>14</sup> The mark may merely indicate to the public that goods to which it is applied are of a certain standard of quality or that they have been made in a certain manufactory. It is settled law that in these cases the mere fact that the trade mark consists of the name of the former proprietor, who originally manufactured the goods with the trade mark, would not be a bar to the assignment of the mark. Again, in *The Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*,<sup>15</sup> Lord Kingsdown said: "By the usage of trade, the name of a firm is understood not to be confined to those who

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(12) 4 De G. J. & S. 137; 32 L.J.Ch. 721; 33 L.J.Ch. 199; 35 L.J.Ch. 53. See also Lord Westbury's judgment in this case.

(13) Per Charles Allen, J. in *Hoxie v. Chaney*, 143 Mass. 592, cited by Imam, J., in *Hannah v. Jagannath & Co.*, 19 C.W.N. at p. 5.

(14) Per Turner, L.J., in *Bury v. Bedford*, 4 De G. J. & S. 352.

(15) 35 L.J.Ch. 53; 11 H.L.C. 523.



first adopted it, but to extend to and include persons to whom the original partners have transferred their business. The name of a firm continues to be used in many cases long after all the original traders have died or ceased to have any interest in the concern. If a manufacturing house uses the name of a firm and stamps the name of its firm upon its goods, though the name of the firm no longer represents the same person as at first, it is no fraud upon the public. For the same reason, the use of the old trade mark of the firm by the new partners, or their successors, is no fraud upon the public; it is only a statement that the goods are the goods of the firm whose trade mark they bear." The same idea was expressed by Lord Westbury in *Hall v. Barrows*<sup>16</sup> in the following passage: "If a name impressed on a vendible commodity passes current in the market as a statement or assurance that a commodity has been manufactured by a particular individual, it may be that the court could not sell the right to use that name without addition, but if it sold the business or manufacture carried on by the owner of the name it may give to the purchaser the right to represent himself as the successor in business of the first maker and in that way be entitled to use the name." "A name though originally the name of the first maker, may, in time, become a mere trade mark or sign of quality, and cease to denote or to be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article continues to be used for generations after the death of the individual who first affixed it. In such cases the name is accepted in the market either as a brand of quality, or it becomes the denomination of the commodity itself, and is no longer a representation that the article is the manufacture of any particular person."<sup>17</sup>

The law was summed up by Romer, J., in the following passage:<sup>18</sup> "Speaking generally, a purchaser of a business, if he continues it, has the right to use the trade name and trade marks of the business in any way he pleases, which is not calculated to deceive, and in particular, as a rule, the purchaser may mark goods made by him in the course of that business with the name of the vendor, although the vendor, or his old workmen, did not make or assist in making such goods, and by so marking the goods the purchaser would not be considered as doing that which was

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(16) 4 De G. J. & S. 150; 33 L.J.Ch. 204.

(17) Loc. cit.

(18) *Thorneloe v. Hill*, 11 B.P.C. 61 at p. 70.

calculated to deceive his customers or the public. The reason of that is that in most cases (and specially where the purchaser is continuing the business in the vendor's name) the mark might be fairly held to be only a representation that the goods were manufactured in the course of the business without any representation as to the persons by whom that business was being carried on, and there would be no substantial risk of deception. But in cases where deception would arise, or would probably arise from the marking of the vendor's name, or from the way in which it was marked, then the marking would be fraudulent, and the purchaser could not be heard to say, after a course of such fraudulent marking, that thereby his goods so marked had come to represent goods made by him as the vendor's successor in business. For instance, where the goods sold in a business are of an artistic character, and during the vendor's time acquired their reputation, and depended for their value upon his personal skill, then, if his retirement from the business were kept a secret, a purchaser of his business would not be entitled to sell goods not made by the vendor marked with his name."

In *Hannah v. Jagannath & Co.*,<sup>10</sup> the plaintiffs who were carrying on business as jute balers alleged that by an agreement with them the defendants acquired the right to use certain trade marks belonging to the plaintiffs, and that the defendants had later repudiated the agreement refusing to pay royalty. The marks in question were originated by one S. C. Chatterjee, whose successors in business, were the plaintiffs. It was shown that in the jute trade, marks were largely employed as an assurance of quality, and that the plaintiffs' marks had acquired great reputation. It was contended on behalf of the defendants that the marks in question were originally the property of S. C. Chatterjee, whose skill in selecting jute secured for his goods a reputation that was associated with his name, and that, his marks being personal, could not be assigned. It was held, that the fact that the original proprietor of the mark was merely the selector of a natural product did not invalidate the marks, and that the marks were not so personal to the originator as to be inalienable.

**Selection marks.**—Where a person claims a trade mark by virtue of selection of the goods in which the mark is used, he must show that he had exercised real skill and special knowledge of the trade in selecting the goods. It is not enough to show that he had been selling the articles bearing the mark in question, or that he

is a distributor of the goods. The mark must be distinctive of his goods and must be used for the purpose of indicating that they are the goods of the proprietor by virtue of selection. In the recent case *Somerlite, Ltd. v. Brown*<sup>20</sup> the plaintiffs were the assignees of the business and the trade mark "Somerlite" of one R. C. Brown. The defendant had been selling under the mark "Somerlite", paraffin oil supplied formerly by R. C. Brown, but latterly by other firms. The latter samples of the oil were never sent to Mr. R. C. Brown for periodical tests. The court was of opinion that Mr. R. C. Brown was neither a manufacturer nor an importer of oil from a particular supply, and that he merely got the oil from anywhere whence it could be obtained at a cheap price. In these circumstances it was held that the mark was not a selection mark and the decision was affirmed by the Court of Appeal. Maugham, J., said: "I agree that there may be a 'selection' of goods in a general sense. I do not agree that the selection of a large merchant who supplies the goods is the selection of goods, because the phrase runs that they are goods of the proprietor of such trade mark by virtue of selection. That does not mean by virtue of the selection of a merchant, who as a merchant may supply many sorts of goods. In my opinion, the reference to the goods of the owner of the mark 'by virtue of selection' does connote that in some real sense the owner of the mark is truly exercising skill or knowledge in connection with the goods in question; and in my view it is impossible here, upon the evidence to hold that Mr. R. C. Brown ever 'selected' these goods in any true sense from 1923 onward."

**Assignment for a limited period.**—The goodwill of a business may be assigned for a term.<sup>21</sup> The right to the use of the trade mark associated with the business would, during this period, become the property of the assignee. No other person, including the assignor, will be permitted during this period to use the trade mark on goods not manufactured by the assignee. There is also a restriction on the assignee's right to use the trade mark. He shall not be permitted to use the mark on goods not produced in the factory or associated with the business which has been assigned to him. Under the English Trade Marks Act it has been held that, where the assignment is only for a limited period, the assignee shall not be permitted during the period to register the identical trade mark or marks closely resembling them in his own name. In

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(20) 51 R.P.C. 205.

(21) *Hannah v. Jagannath & Co.*, 19 C.W.N. 1.

other words, he does not acquire an absolute and permanent title to the mark. In *Roger's Trade Mark case*<sup>22</sup> a firm having business in Glasgow and elsewhere, licensed to the assignee its Glasgow business for ten years, allowing the latter to use the firm's trade marks in its Glasgow business. The assignee subsequently applied to register a trade mark similar to one of the marks of the assignors for whisky bottled at Glasgow. Registration was opposed by the assignors on the ground that exclusive right to the mark was not allowed to the assignee by the licence, although the latter's right to use the mark during the period of licence was admitted. The application for registration was refused by North, J.

**Assignment limited to class of goods for which right of user exists.**—It has been pointed out that under the Common Law, title to a mark is limited to the class of goods for which right of user exists. Ownership accruing by assignment is subject to the same limitations as ownership before assignment and an assignee's title to the mark is, therefore, confined to the descriptions of goods, in respect of which, the assignor had acquired his title before the assignment. In this respect the statute law in England follows the Common Law. Even where registration of a trade mark, is made in respect of a whole class, assignment of the mark can be made only in respect of the particular goods in the class in respect of which the mark has been used. For instance, in *Edwards v. Dennis*<sup>23</sup> it was held that the plaintiff who was the assignee of a registered mark which had been previously used only for iron sheets could not restrain the defendant from using the same mark for iron wire. The court said that as assignee of the goodwill of a business which had dealt with only iron sheets the plaintiff's right to the mark should be confined to this class of goods. *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*,<sup>24</sup> is another illustrative case. The plaintiffs had by licence permitted the defendants (Bowden Brake Co., Ltd.) to manufacture cycle brakes under certain patents. According to an agreement the former were to supply the Bowden Wire, and the latter to make the other parts of the brake, and sell the finished article. The Bowden Wire Co. subsequently registered a certain trade mark in respect of brakes for velocipedes and other road

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(22) 12 R.P.C. 149, 158.

(23) L.R. 30 Ch.D. 454.

(24) 30 R.P.C. 45, 580; 31 R.P.C. 385.

vehicles, and granted a licence to the Bowden Brake Co., to use that mark on cycle brakes manufactured by them under the patent licence. The plaintiffs (Bowden Wire Co., Ltd.) themselves, manufactured brakes for motor cycles and used the identical trade mark on these goods. After the patent and licence had expired, the defendants continued to use the said mark on their cycle brakes. The plaintiffs brought an action for infringement and the defendants moved to rectify the Register by expunging the mark. It was held by the Court of Appeal that in the circumstances the effect of the licence by the plaintiff was to destroy the distinctiveness of the mark and that the mark was calculated to mislead. An order to expunge the mark from the Trade Marks Register was accordingly passed, and an appeal to the House of Lords was dismissed.

**Indivisibility of goodwill of a business.**—It is a well established principle of common law, that a manufacturer, having a number of trade marks for various goods, cannot assign one or more of them, without also assigning the whole of his business carried on under the mark, which is to be assigned.<sup>25</sup> Divisibility of the goodwill of a business will not be allowed as this will lead to the deception of the public. So, in the *British American Tobacco Co., Ltd. v. Mahboob Buksh*,<sup>1</sup> the assignment of one of the trade marks without assignment of the whole business was held to be invalid. Where a business is composed of manufacturing and vending departments an assignment of the vending department, separate from the rest of the business, is not valid.

**Lacteosote, Ltd. v. Alberman.**—A recent case illustrating the above rule is *Lacteosote, Ltd. v. Alberman*.<sup>2</sup> In 1907, one Famel was manufacturing in France a pharmaceutical preparation known as Sirop Famel. The preparation was sold in France and England under a label which had been registered by him as his trade mark. In 1923 he appointed Messrs. Lacteosote, Ltd., as his sole agents for the sale of this preparation in England, and it was agreed *inter alia* that Famel should not sell or supply 'Sirop Famel' to any persons in Great Britain other than the above firm. In 1924 Famel assigned the trade mark to Lacteosote, Ltd., "together with

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(25) *Application by the Sunbeam Motor Car Co., Ltd.*, 33 R.P.C. 389.

(1) 15 C.W.N. 280; 38 Cal. 110.

(2) 44 R.P.C. 211. Cf. *Impey Electrical, Ltd. v. Weinbaum*, 44 R.P.C. 405; *Smith's Trade Mark*, 44 R.P.C. 533; *Application by Cranbux, Ltd.*, 45 R.P.C. 281.

the goodwill of the business concerned in the goods with respect to which the said trade mark is registered." Messrs. Lacteosote, Ltd., then obtained registration as a trade mark of a label, which was, in substance an English version of the label already registered in 1907 by Famel. The defendant purchased Sirop Famel from the dealers in France, and sold the same in England in bottles bearing a label substantially identical with Famel's registered mark. Thereupon, Lacteosote, Ltd., commenced an action for infringement and passing-off against the defendant, and the latter moved to rectify the Register of Trade Marks by expunging the marks of the plaintiff firm. It was held, that the registration statutes had always kept in line with the principles which guided the Court of Equity, and that the Acts did not permit a mark distinctive of business, composed of manufacturing and vending departments, to be assigned with vending portion separate from the business. Clauson, J., observed: "The first clause of S. 22 does not, in my judgment, enable a mark distinctive of goods emanating from Famel's business to be assigned with a portion of the business, namely, that of vending in Great Britain, that portion being separated from the rest of the business.<sup>3</sup> If it were not so, the result would be that a mark distinctive of goods produced and sold in the business carried on by Famel would become by the assignment distinctive, not of goods produced and sold in the business by Famel, or his successors, but of goods sold in a newly separated and, therefore, different business by persons who succeeded Famel as vendors in Great Britain of the goods but not as producers of them. Such a position seems to me to be inconsistent with the principle that a trade mark is distinctive of goods with which a particular business (whether carried on by the original trader or his successors) is concerned. If the identity of the business is destroyed, the mark is destroyed with it."

**Rights of assignor and assignees.**—When the owner of a trade mark transfers his monopoly right by assignment to one individual, he just changes place with him. The assignee acquires the monopoly as against the rest of the world including the assignor. The assignor has just as much right in respect of his original mark as any other individual against whom the assignee now begins to exercise his monopoly.

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(3) The only severance of vending goodwill from a manufacturing goodwill permitted by Sec. 22 is in respect of foreign markets for a mark belonging to a British business; but in the converse case where the mark belongs to a foreign business with the seat of manufacture in the foreign country the severance of vending goodwill in Great Britain is not valid.

**Rights of assignor and assignee in foreign markets.**—In *Ingenohl v. Wing On and Co. (Shanghai), Ltd.*,<sup>4</sup> the rights in a foreign country of the transferees as between themselves and the transferor came up for decision before the Privy Council. The plaintiff was a German by birth but had become naturalized as a Belgian subject. For many years he had carried on business as a cigar manufacturer in Manilla (Philippine Islands) and had sold cigars under certain trade marks and in boxes with a facsimile of his signature. Later, in 1908, he had established a factory at Hongkong. During the war, the American Alien Property Custodian seized the appellants' Manilla factory in the belief that he was a German and sold it in 1918 to another firm including in the sale all the stock, goodwill and trade marks. The new purchasers of the Manilla business sold to the defendants cigars in boxes similar to those in which the plaintiff had sold them. An action for infringement of trade marks and for passing-off was brought against the defendant for selling such goods at Shanghai. It was shown that, prior to 1918, the plaintiff had made in his Hongkong factory cigars under similar marks and names to those of his Manilla cigars, and that these cigars were sold in China. The plaintiff contended that the assignment by the American Custodian did not affect rights outside the Philippine Islands, and that the sale of cigars under the circumstances would lead the purchasers in China to believe that they were purchasing the plaintiff's goods when they were not. The action was dismissed by the Shanghai Court. At the hearing of the appeal before the Privy Council the defendants gave an undertaking not to use on boxes in which their cigars were sold a particular label or any label on which the appellants' name appeared as the guarantor of the cigars or otherwise. Their Lordships held that the assignment by the Custodian could not transfer the title to trade marks or trade names in China, but it could enable the assignee "as between themselves and the appellant, to say that they were not passing-off goods under a trade name to which they had no title, so long as they abstained from representing the goods as those of Ingenohl himself."

**Partnership.**—Upon the formation of partnership, the trade mark rights of any one of the members will, in the absence of express provisions become part of partnership assets. For, as Lord Justice Turner said, "The whole trade is carried into the

partnership, and the trade mark is but an element of the trade.'"<sup>5</sup> Upon the dissolution of the partnership the trade marks, as forming part of the ownership assets, are saleable as such with the goodwill in the absence of any special agreement. If the business is not sold as such each partner has a right to use the mark. Thus, in *Banks v. Gibson*<sup>6</sup> Romilly, M. R., said: "The name or style of the firm of 'Banks & Co.,' in which the defendant had been engaged for a period of fourteen years, was an asset of the partnership, and if the whole concern and the goodwill of a business has been sold, the name, as a trade mark would have been sold with it. If, by arrangement, one partner takes the whole concern, there must be a valuation of the whole, including the name and style of the firm. But if the partners merely divide the other partnership assets, then each is at liberty to use the name just as they did before."

The same rule has been adopted by the Indian courts. In *Mancherjee Manokaji Poonjiajee v. Framji Manokaji Poonjiajee*,<sup>7</sup> the Bombay High Court observed that, where the partners at the time of dissolving the partnership make no stipulation about goodwill, every one of the partners has a right to carry on the trade in the identical name under which the firm had traded prior to the dissolution, for, the goodwill of the business is an asset of the partnership, to which one member of the firm has no higher right than that of the other. But by so doing he shall not expose the other partners to any risk of liability. In *Morarji v. Madonji*<sup>8</sup> the Court said that, where two partners carry on business in partnership in some shops under the personal name of one of the partners, and at the dissolution of partnership, one partner buys one shop and its goodwill, and the other buys the other shop and goodwill thereof, the partner in whose name the shops were conducted before the dissolution, can restrain the other partner from carrying on business in the old name, if the use of name by the successor in business exposed his former partner to any risk of

(5) *Bury v. Bedford*, 4 De G. J. & S. 352; (1864) 10 L.T. (N.S.) 470.

(6) 34 Beav. 566; 34 L.J.Ch. 591; Seb. Dig., p. 145. See also *Burchell v. Wilde*, (1900) 1 Ch. 551; *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L.J.Ch. 204; *Levy v. Walker*, (1879) 10 Ch.D. 436; *Currie & Co. v. Currie*, 15 R.P.C. 339; *Condy v. Mitchell*, (1887) 37 L.T. (N.S.) 268, 766; Seb. Dig., p. 335; *Townsend v. Jarman*, 17 R.P.C. 649.

(7) 2 Bom.L.R. 1026. See also *Vadilal Sakalchand v. Burditt & Co.*, 30 Bom. 56, Batty, J., at p. 73.

(8) 5 Bom.L.R. 545.



liability. Whether there will be any such risk is a matter which would be decided having regard to the circumstances of each case.

**Retiring partner may start new business under his own name but must not solicit his old customers.**—Where the goodwill of the business is sold, or where one of the partners had sold off his interest in the business on dissolution of partnership, the late owner may start new business using his own name in a lawful manner, provided, there is no agreement with the assignee to the contrary. “The sale of the goodwill of a business, without more, does not imply a contract on the part of the vendor not to set up again a similar business himself.”<sup>9</sup> But the new vendor will not be allowed to use the old name, if it differed from his personal name, or represent that he is still a member of the old firm, or is continuing to carry on the old business. He will also be restrained from soliciting in any manner any person, who, prior to the dissolution, was a customer of the old firm.<sup>10</sup> For, as Lord Eldon said, “the goodwill which has been the subject of sale, is nothing more than the probability that the old customers will resort to the old place.”<sup>11</sup> In *Labouchere v. Dawson*<sup>12</sup> the plaintiff having purchased the brewery business of the defendant, the latter set up new business in another place and solicited his former customers to deal with him and not with the plaintiffs. On motion by the plaintiffs injunction was granted to restrain the defendant from so doing. The Master of Rolls (Lord Romilly) said: “The new firm, the defendant in this case, is entitled to publish any advertisement he pleases in the papers, stating that he is carrying on such business. He is entitled to publish any circulars to all the world to say that he is carrying on such business, but he is not entitled, either by private letter, or by a visit, or by his traveller or agent, to go to any person who was a customer of the old firm and solicit him not to continue his business with the old firm. That is not a fair and reasonable thing to do after he has sold the goodwill.”

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(9) Per Wood, V. C., in *Churton v. Douglas*, 28 L.J.Ch. 841. See also *Hudson v. Osborne*, 39 L.J.Ch. 79.

(10) *Trego v. Hunt*, (1896) A.C. 7; 1 Ch. 462; 64 L.J.Ch. 392; 65 L.J.Ch. 1; 34 W.R. 371; 44 W.R. 225.

(11) *Cruttwell v. Lye*, 177 Ves. 335; Seb. Dig., p. 8. “The goodwill is the probability of the old customers going to the new firm to whom the business is sold.” Per Lord Romilly, M.R., in *Labouchere v. Dawson*, L.R. 13 Eq. 322; 41 L.J.Ch. 427.

(12) L.R. 13 Eq. 322; 41 L.J.Ch. 427.

**Joint ownership by manufacturer and dealer.**—In *Robinson v. Finlay (Ward v. Robinson)*<sup>13</sup> the trade marks were applied to cotton goods, manufactured by Ward, exported by Robinson, and consigned to Galbraith who sold them after bleaching at Rangoon. The trade mark was adopted as the result of joint consultation between the parties. After the interruption of the connection Robinson continued to use the same group of marks, and Ward began to export goods bearing substantially the same marks, through Finlay. Cross actions commenced respectively by Robinson against Finlay and by Ward against Robinson. It was held by the Court of Appeal that, inasmuch as the group of marks had never been used except on goods which had passed through the hands of all the three parties, the group of marks as a whole, was indicative of goods which had passed through that particular course of trade, and that none of the three could claim exclusive title to the mark against the others. Both actions were therefore dismissed with costs. Lord Justice James said: “The case is not like one depending on the relation of master and servant, or principal and agent, but is more like a partnership; that is to say, the mark was adopted by persons, joined in a matter in which they were interested jointly, not as master and servant, but by way of partnership. The *onus probandi* is thrown upon the plaintiff in each case to prove that he has that monopoly and sole right which he alleges to use the marks or combination of marks, and that the defendant is unlawfully using the same.” Lord Justice Branwell said: “Here was a compound matter which the parties agreed to, and upon coming to the arrangement which they did come to, they made no provision as to what would happen when that arrangement ceased to exist between them, and the consequence is that each party must stand upon what one may call his natural rights under the circumstances, that is to say, that each may do what he is not forbidden to do.”

The principle of joint ownership of a trade mark by manufacturer and dealer is also illustrated by “*Tarantella*” *Trade Mark case*.<sup>14</sup> An Italian company had been supplying tinned fruits and vegetables to a firm in England who sold the goods under one or other of two registered marks. The trade marks

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(13) 9 Ch.D. 487; 27 W.R. 294. See also the Indian case *Vadilal Nakalechand v. Burditt & Co.*, 30 Bom. 61 and *Application by Naamloose Vennootschap Fabriek van Chocolate en Suikerwerken, J. C. Klens & Co.*, 40 R.P.C. 103.

(14) 27 R.P.C. 573, 762. (Appeal order discharged by consent).

were designed by the English company and were registered by them in their own name. Both the trade marks were used solely on the goods supplied by the Italian company. Under an agreement between the two companies it was provided that the trade marks belonged jointly to the two firms, and that if either of the contracting parties be unwilling to renew the contract the party willing to continue it will be entitled to the exclusive ownership. On notice being given by the English company to determine the contract the Italian company applied to be entered in the Register as the sole proprietor. It was held by Mr. Justice Eve that the mark belonged to the two firms jointly and that the Italian firm was entitled to be upon the Register together with the English company as joint owners.

**Recommendations of the Goschen Committee.**—It will be seen from the foregoing that in England, under the Common Law, as well as, under the statute law, a trade mark cannot be assigned in gross and that any assignment of a trade mark without the goodwill in the whole business is not valid. There has, however, been a growing feeling of dissatisfaction among the commercial community that the conditions of trade which in the past might have justified this proposition of law, no longer obtain, and, therefore, a radical revision of the existing law in the matter of assignment of trade marks is necessary. This question engaged the attention of the Goschen Committee, appointed in 1933, to review the whole position of Trade Mark Law in England. Certain far-reaching recommendations have been made by this Committee in their report. The keynote of these recommendations is that a trade mark should be made assignable and transmissible even without the goodwill of the whole business in which it is being used, provided such assignment is not likely to cause confusion or deception of the public. A proprietor of several marks may thus be enabled to assign one or more of his marks without at the same time transferring the entire business. These recommendations, if adopted, would constitute a radical change of the basis of statute law on which assignment of a trade mark is now allowed in England.

## CHAPTER VI.

### LAW OF PASSING-OFF.

**Historical.**—Long before the first Trade Marks Act of 1875, came into force it was settled law in England, that a trader has a right to restrain a rival trader from fraudulently passing-off spurious goods as the goods of the former, and from using for this purpose his get-up, trade mark or trade name, or a close imitation of any or all of them. Although the law of passing-off is essentially the creation of the 19th century, it is often stated that the beginnings of this law could be traced to *Southern v. How*, a very early case, decided in 1618, and first reported in Popham's Reports in 1656. For instance, Lord Chancellor Halsbury said in 1900, that the right to a passing-off action was a "very familiar and well-known form of action" and "one which has been a well-recognised cause of action certainly for the last two hundred and fifty years." After quoting Dodderidge, J., in *Southern v. How* as reported in Popham's Reports the learned Lord Chancellor said "going back, therefore, as far as the reign of Elizabeth the form of action in which if the right of a man to have the reputation of selling that which is his manufacture as his manufacture, the right to prevent other people fraudulently stating that it is their manufacture when it is not—if that right is infringed there is a remedy. That has, as I have said, ever since the reign of Elizabeth, been established in our courts as being a right of action upon which anybody may sue who has a ground for doing so."<sup>1</sup>

**Southern v. How.**—It may, however, be noted that *Southern v. How* has itself no direct bearing on the law of passing-off, as it was an action for deceit under the Common Law, in which a purchaser sued for the sale of the counterfeit jewels by the defendant

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(1) *Magnolia Metal Co. v. Tandem Smelting Syndicate, Ltd.*, 17 R.P.C. 477 at p. 483. Popham's Report of *Southern v. How*, was referred to in *Blanchard v. Hill*, (1742) 2 Atkyns 484; *Crawshay v. Thompson*, (1842) 4 Man. & G. 357; *Burgess v. Burgess*, (1853) 22 L.J.Ch. 675; *Hall v. Barrows*, (1863) 32 L.J.Ch. 548; *Hirst v. Denham*, (1872) L.R. 14 Eq. 542. For a discussion of this case, see 'Historical Foundations of the Trade Mark Law' by Schechter (1925).

through his servant. Nevertheless, Popham's Reports<sup>2</sup> containing an account of this case states that in the course of his judgment Dodderidge, J., referred to an earlier case decided in the reign of Elizabeth, in which a clothier, whose goods had acquired reputation complained that a rival trader "used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved that the action did well lie." On the other hand, Croke's Reports<sup>3</sup> states that the action was not brought by the clothier whose mark had been misused but by the defrauded purchaser, while Bridgman's Reports<sup>4</sup> does not refer to this earlier case at all. In any case the reference to the clothier's case by Dodderidge, J., in *Southern v. How*, as reported in Popham's Reports, could at best be treated only as a dictum.

**Blanchard v. Hill.**—The first reported trade mark case in England appears to be *Blanchard v. Hill*,<sup>5</sup> decided by the Court of Equity, in 1742, in which injunction to restrain the use of the Great Mogul stamp on cards was refused. The case is illustrative of the slow growth of the law of passing-off in England. For, although the use of trade marks by traders to distinguish their goods from the goods of others was common at this time infringement of one's trade mark by another was not recognized by the Court of Equity as an actionable wrong. "Every particular trader," said Lord Chancellor Hardwicke, "has some particular mark or stamp; but I do not know of any instance of granting an injunction here to restrain one trader from using the same mark as another, and I think it would be of mischievous consequence." Referring to *Southern v. How*, which was cited by the Attorney-General, the learned Lord Chancellor observed: "It was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away customers from the other clothier; and there is no difference between a tradesman's putting up the same sign, and making use of the same mark, with another of the same trade." The contention that the plaintiff's interests were prejudicially affected by the misuse of his mark by the defendant was dismissed by the Lord Chancellor with the significant observation that "there is no more weight in this

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(2) p. 144 (1656).

(3) Cro. Jac. 471 (1659).

(4) p. 125 (1659).

(5) 2 Atkyns 484; Seb. Dig., p. 1.

than there would be in an objection to one innkeeper setting up the same sign with another."

**Singleton v. Bolton.**—An important case which was decided shortly after, was *Singleton v. Bolton*.<sup>6</sup> The plaintiff who was manufacturing and selling in succession to his father, a medical preparation under the name of "Dr. Johnson's Yellow Ointment" sought to restrain the defendant from selling another ointment under the same name. The plaintiff was non-suited on the ground that both the plaintiff and the defendant used the name of the original inventor, and that "no evidence was given of the defendant having sold it as if prepared by the plaintiff." Lord Mansfield, C. J., said: "If the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie."

**Intervention of the Court of Equity.**—Although the plaintiff's right to protection against fraudulent use of his trade mark was thus for the first time enunciated in the above case, it was only in the beginning of the 19th century that the intervention of the Court of Equity against infringement of trade marks, became effective in England. The right of a trade mark owner to exclusive use of the mark was clearly recognised at this time, and injunctions were granted to restrain fraudulent infringements. For instance, in *Hogg v. Kirby*,<sup>7</sup> which was decided in 1803, the defendant was restrained from suggesting to the public in a fraudulent manner that his magazine was a continuation of the plaintiff's. In *Crutwell v. Lyc*<sup>8</sup> Lord Chancellor Eldon declared: "There can be no doubt that this court would interpose against that sort of fraud which has been attempted by setting up the same trade in the same place under the same trade sign or name, the party giving himself out as the same person." In *Day v. Day*<sup>9</sup> (1816) where the plaintiff complained that the defendant had placed on his blacking certain labels in imitation of his label, an injunction was granted restraining the defendant from doing so.

(6) (1783) 3 Doug. 293; Seb. Dig., p. 2.

(7) (1803) 8 Ves. 215. See also *Longman v. Winchester*, 16 Ves. 269; Seb. Dig., p. 7; *Edmonds v. Benbow*, (1821) Seb. Dig., p. 16; In re *The Edinburgh Correspondent Newspaper*, (1822) Seb. Dig., p. 16 and *Constable & Co. v. Dr. Brewster*, (1824) Seb. Dig., p. 19.

(8) (1810) 17 Ves. 335; Seb. Dig., p. 8. In *Byron v. Johnston*, Seb. Dig., p. 11, the defendant was prevented from publishing in Lord Byron's name certain poems which were not of his composition.

(9) Eden on Injunction, edition of 1821, p. 314; Seb. Dig., p. 10. See also *Day v. Binning*, (1931) Seb. Dig., p. 22; *Henry v. Price*, (1831) Seb. Dig., p. 23.

**Relief by the Common Law Courts.**—The intervention of the Common Law Courts came later, and it was only in 1824 in *Sykes v. Sykes*<sup>10</sup> that relief was first granted in a trade mark suit by the Court of the King's Bench. In that case the plaintiff had marked his goods 'Sykes Patent' to indicate that they were his goods. The declaration alleged that the defendant had copied the mark on his goods, "wrongfully, knowingly and fraudulently," and "did knowingly and deceitfully sell them," as and for, the goods of the plaintiff's manufacture, and the plaintiff had thereby suffered damage by way of loss of custom and injury to reputation. It was held that an action would lie for the injury, though plaintiff and defendant were both named "Sykes" and neither of them had in fact a valid patent.

An important step was taken in 1833, when the common law court decided in *Blofeld v. Payne*<sup>11</sup> that in an action for passing off, although no specific damage was proved, and the jury found that the defendants' articles were not inferior to those of the plaintiff, the plaintiff was still entitled to some damages "inasmuch as his right had been invaded by the fraudulent act of the defendant."

**Fraud was the basis of action at common law.**—In the trade mark cases tried before the common law courts the gist of the action was regarded as fraud. The plaintiff's remedy was said to be in the nature of an action for deceit, though the only resemblance between a trade mark action and an action for deceit was that the misrepresentation relied on, should in both cases have been made with fraudulent intention; the two actions differed in other respects,<sup>11-a</sup> for instance, the plaintiff was not the party deceived, and nominal damages could be claimed in the absence of any actual damage. The common law courts held that, in order to obtain relief, the plaintiff in a trade mark case, should, necessarily, prove that the defendant had adopted the mark with a fraudulent motive to attract to himself that course of trade or custom, which, without that improper act, would have gone to the plaintiff. Thus in *Crawshay v. Thompson*<sup>12</sup> the plaintiffs alleged that the defendants had "wrongfully, knowingly, and fraudulently" copied the

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(10) 3 B. & Cr. 541; Seb. Dig., p. 19.

(11) 2 L.J.K.B. (N.S.) 68; 4 B. & Ad. 410; Seb. Dig., p. 24.

(11-a) See Lord Parker's judgment in *Spalding Bros. v. Gamage, Ltd.*, 32 R.P.C. at p. 283.

(12) (1842), 4 Man. & G. 357. See also *Morison v. Salmon*, (1841) 2 Man. & G. 385; *Cartier v. Carlile*, (1862) 31 Beav. 292.

plaintiff's mark on iron bars in order to denote that their iron was made by the plaintiff. The court said: "This is in the nature of an action for deceit," and added that in such cases it had been laid down that "the declaration regularly ought to charge that the defendant was *sciens* of the matter by which he deceived; and that he did it *fulso et fraudulenter*." As the plaintiff failed to establish fraudulent intention on the part of the defendant a verdict was found for the defendant. In *Rodgers v. Nowill*<sup>13</sup> Vice-Chancellor Wigram approved of the action of the trial judge in directing the jury to decide as one of the issues whether the defendant had copied the plaintiff's mark with fraudulent intention. A similar opinion was also expressed in the case of *Lawson v. The Bank of London*,<sup>14</sup> and *Hargreaves v. Smith*.<sup>15</sup> In distinguishing an action in equity from one at common law, Lord Westbury said in the well-known case *Edelsten v. Edelsten*<sup>16</sup>: "At law the proper remedy is by an action of the case for deceit; and proof of fraud on the part of the defendant is of the essence of the action." And in *Leather Cloth Co. (Limited) v. American Leather Cloth Co. (Limited)*<sup>17</sup> the same Lord Chancellor observed: "At law, the remedy for the piracy of a trade mark is by an action on the case in the nature of a writ of deceit."

**Basis of relief at the Chancery courts.**—There was at first no distinction in the basis of relief in trade mark suits before the Court of Equity or of Common Law. In the early cases the Chancery courts also regarded a trade mark action as an action in deceit, and required that fraud should be specifically alleged and shown, in order to entitle the plaintiff to relief.<sup>18</sup> Soon, however, the Court of Equity began to recognise the plaintiff's right to protection against infringement of his mark, irrespective of the fraudulent intent of the defendant. This departure from common law was for the first time made in *Millington v. Fox*,<sup>19</sup> in 1838,

(13) Seb. Dig., p. 42; 17 L.J.C.P. 52; 10 L.T. 88.

(14) (1856) Seb. Dig., p. 77; 25 L.J.C.P. 188; 4 W.R. 481.

(15) Seb. Dig., p. 203.

(16) 1 De G. J. & S. 185.

(17) 4 De G. J. & S. 137. See also *Jamieson & Co. v. Jamieson*, 15 R.P.C. 169 (Vaughan Williams, L. J.), and *Addley Bourne v. Swan and Edgar, Ltd.*, 20 R.P.C. 105 (Farwell, J.).

(18) See for instance *Blanchard v. Hill*, Seb. Dig., p. 1; *Yovatt v. Wingard*, Seb. Dig., p. 15; *Knott v. Morgan*, Seb. Dig., p. 27; In *Motley v. Downman*, Seb. Dig., p. 29, Lord Cottenham said that the Court of Equity would not act otherwise than as ancillary to the court of law.

(19) 3 My. & Cr. 338.



by Lord Chancellor Cottenham. The plaintiff complained that his trade mark "Crowley Millington" had been used by the defendant on steel which was not of the plaintiff's manufacture. Although the defendant showed that he had never heard of the name of the plaintiff's firm, and that he had acted innocently, injunction was granted restraining the defendant from continuing to use the mark on steel not of the plaintiff's manufacture. The learned Lord Chancellor said:—"I see no reason to believe that there has, in this case, been a fraudulent use of the plaintiff's marks. It is positively denied by the answer, and there is no evidence to show that the defendants were even aware of the existence of the plaintiffs, as a company manufacturing steel. . . . In short, it does not appear to me that there was any fraudulent intention in the use of the marks. That circumstance, however, does not deprive the plaintiffs of their right to the exclusive use of those names." The learned Lord Chancellor further observed that "there was sufficient in the case to show that the plaintiff had a title in the marks in question; and they undoubtedly had a right to the assistance of the Court of Equity to enforce that title."

**Lord Westbury's observations.**—*Millington v. Fox* has been unequivocally regarded by the Court of Chancery in all subsequent decisions as an authority for holding that it is not necessary for the plaintiff in a passing off action to establish fraudulent intention on the part of the defendant.<sup>20</sup> So in *Clement v. Maddick*,<sup>21</sup> Stuart, V. C., observed that "the absence of a fraudulent intention is no defence against an application to the court for an injunction by the person whose property has been injured." In *Edelsten v. Edelsten*<sup>22</sup> Lord Westbury said that proof of actual deception was not necessary in equity, if the court was satisfied that the resemblance was such as to be likely to cause the one mark to be mistaken for the other. The learned Chancellor observed

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(20) See *Clement v. Maddick*, (1859) 1 Giff. 98; *Dixon v. Fawcus*, (1861) 3 E. & E. 537; *Cartier v. Carlile*, (1862) 31 Beav. 292; *Leather Cloth Co. (Limited) v. American Leather Cloth Co. (Limited)*, (1863) 4 De G. J. & S. 137; *Moet v. Couston*, (1864) 33 Beav. 578; *Wotherspoon v. Currie*, (1870) 42 L.J.Ch. 130; *Ford v. Foster*, (1872) L.R. 7 Ch. 611; *McAndrew v. Bassett*, 33 L.J.Ch. 561; *Singer Manufacturing Co. v. Wilson*, (1877) 3 App. Cas. 376; *Singer Manufacturing Co. v. Loog*, (1882) 8 App. Cas. 15; *Eddaway & Co., Bentham Hemp Spinning Co.*, (1892) 2 Q.B. 639; *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54; *Cellular Clothing Co. v. Maxton and Murray*, (1899) App. Cas. 326.

(21) 1 Giff. 98; Seb. Dig., p. 97.

(22) 1 De G. J. & S. 185.

that the Court of Equity "will act on the principle of protecting property alone, and it is not necessary for an injunction to prove fraud in the defendant, or that the credit of the plaintiff is injured by the sale of an inferior article. Injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief."

**The Singer cases.**—The question was carefully considered by the House of Lords in *The Singer Manufacturing Co. v. Wilson*.<sup>23</sup> The plaintiffs, who were manufacturers of sewing machines, complained that the defendant had marked sewing machines other than those manufactured by the plaintiffs, as "Our Singer machines," and passed them off as and for the plaintiff's machines. It was held by Jessel, M. R., that in a passing-off action fraud should be proved, and injunction was refused as the plaintiffs had not produced any evidence of fraud. This decision was approved by the Court of Appeal, but was reversed by the House of Lords. It was there laid down that since the decision in *Millington v. Fox* it was not necessary for the plaintiff to show evidence of fraud, and that it was sufficient to satisfy the court that the defendant had acted in a manner calculated to deceive. Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade mark." The learned Lord Chancellor added: "A man may take the trade mark of another ignorantly, not knowing it was the trade mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it, knowing it is the trade mark of his neighbour, and intending and desiring to injure his neighbour by so doing. But in all these cases it is the same act that is done, and in all these cases the injury to the plaintiff is just the same. The action of the court must depend upon the right of the plaintiff, and the injury done to that right." And Lord O'Hagan observed: "If a man has acquired legitimately a right to the property in an exclusive use of a name, it is of small account to him, should it be invaded, whether the invasion comes from a purpose to deceive, or from ignorance, or inadvertence, or an honest misconception of the relative rights of the parties, and the law ought not to permit, and will not permit, the continuance of the invasion, whatever may have been its origin."

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(23) Seb. Dig., p. 285. Jessel, M.R., 2 Ch.D. 434; Ct. of App. 2 Ch.D. 448; House of Lords 3 App. Cas. 376. See also *Singer Manufacturing Co. v. Loog*, 18 Ch.D. 395; 8 App. Cas. 15.

The Court of Equity having thus taken the step that its jurisdiction rests upon injury to the plaintiff's right irrespective of the defendant's motive in infringing the mark, trade marks began to be considered as property.<sup>24</sup> Such property right was not, however, recognised by the common law court and fraud continued to be an essential ingredient of a trade mark action before this court down to the time of the amalgamation of the two courts by the Judicature Act of 1873.<sup>25</sup>

**Object of the law of passing-off.**—The law of passing-off action is based on the principle that, while fair and honest competition is lawful and beneficial to the public, unfair competition is calculated to destroy honest business and should not be tolerated. The object of the law is to restrain commercial piracy and to regulate business so that competition between trade rivals is conducted fairly and honestly. As was said in an American case, “‘The survival of the fittest’ in trade and commerce must result from contests legitimately launched and ethically directed. Of course, the law does not undertake to regulate every aspect of business. Nor does it interfere in every case of commercial immorality. . . . Necessarily, there must be limitations, and guiding rules and, necessarily, each case must depend for sustenance upon its own larder.”<sup>1</sup>

(24) The question of property right in trade marks is discussed in a later section.

(25) The history of the law was summed up by Lord Blackburn in *Singer Manufacturing Co. v. Loog* in the following passage:—“‘The original foundation of the whole law is that when one, knowing that goods are not made by a particular trader, sells them, as and for the goods of the trader, he does that which injures that trader. At first it was put on the ground that he did so where he sold inferior goods as and for the trader's; but it is established, alike at law and in equity, that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's even though not inferior. The law as to these trade marks is now regulated by statutes, but before there was any legislation on the subject it was well settled that, where any one adopted a mark so closely resembling the trade mark of the plaintiffs that it would likely be mistaken for it, and put it on his goods and sold them, knowing that, though the persons to whom he sold, them were well aware that they are not the plaintiff's make, yet that they were meant to be sold to others who would see only the trade mark, and were likely to be deceived by its resemblance to that of the plaintiff, he might be properly found to have knowingly and fraudulently sold the goods as and for the plaintiff's goods. And, so far, there was no difference between law and equity. But at law it was necessary to prove that an injury had been actually done; in equity it was enough to show that the defendant threatened to do, and would, if not prevented, do that injury.’”

(1) *American Chain Co. v. Carr Chain Works*, 141 Misc. 303.

**Definition.**—The “law of passing-off” or the “doctrine of unfair competition” as it is termed in the United States has been defined and explained by several eminent judges. In its popular sense the law may be stated thus: A person shall not be allowed to use trade marks, business names, get-up, or labels, in a manner which is calculated to mislead the ordinary purchaser to believe, that his goods are the goods manufactured, or marketed, by somebody else, or that his business is the business of a different person or firm. No man shall in this way be permitted to appropriate the fruits of another’s labour and skill. A shall not sell his goods in such a manner that the public who are acquainted with the goods of B and who intend to purchase them may be led to purchase the goods of A believing them to be the goods of B.

The counterfeit trade mark need not necessarily be applied on the goods. As defined under Article (10-b) of the International Convention unfair competition includes “all manner of acts of such a nature as to create confusion by any means whatsoever with the goods of a competitor.” There can be passing-off by circulating trade catalogues or price lists or by advertisements which are calculated to deceive and produce the impression that A’s goods are the goods of B. In *Singer Manufacturing Co. v. Loog*,<sup>2</sup> Lord Blackburn observed: “A name may be so appropriated by user as to come to mean the goods of the plaintiffs, though it is not, and never was impressed on the goods, or on the packages, in which they were contained, so as to be a trade mark, properly so called. Where it is established that such a trade name bears that meaning, I think the use of that name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not plaintiffs’, may be the means of passing-off those goods as and for plaintiffs’, just as much as the use of a trade mark.”

The law of passing-off is, however, not confined to cases of pure trade marks.<sup>3</sup> As was said by Lord Justice Romer the law is

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(2) 8 App. Cas. 15. See also *Goodfellow v. Prince*, (1887) 35 Ch.D. 9.

(3) See, for instance, *Shallis v. Freeman & Stirling Press, Ltd.*, 48 R.P. C. 370, where an injunction was granted to restrain the defendants from printing or selling grey hound racing programmes not being the programmes of the plaintiff as stirring cards. In *Ridge v. English Illustrated Magazine, Ltd.*, (1913) 29 T.L.R. 592, the plaintiff, a writer of reputation sued defendants for damages for publishing in their magazine under plaintiff’s name a story of which he was not the writer. It was alleged that the story was of inferior quality and was damaging to plaintiff’s reputation. In summing up the judge directed the jury that if the facts are proved and damages are likely though not specifically proved they could find for plaintiff with

based on "a much wider principle, the principle being that the court will always interfere by injunction to restrain irreparable injury being done to the plaintiff's property."<sup>4</sup> Such property includes, for instance, literary property, such as copyright in a play or film.<sup>5</sup> The owner of the copyright in a play "is entitled to the right of reproduction whether by means of a dramatic performance or by a visual and acoustic representation through the medium of cinematograph film," and is "entitled to prevent any person passing-off as and for a cinematograph version of that work something, which is not, in fact, a version of that work."<sup>6</sup> And it has been held in America that, if a stage play has established a public reputation under a particular title, the use of that title as the title of a cinematographic film may be restrained, even where there is no other similarity between the stage play and the picture play.<sup>7</sup> An action for passing-off is thus possible in these cases, although no infringement of copyright had taken place. Again, the names of charitable societies can be protected under the law of passing-off if it is shown that the adoption of the name by the defendant society was calculated to deceive, and to cause damage to the plaintiff society.<sup>8</sup> In all these cases damage to the plaintiff's property arising from probability of deception of the public by something which the defendants are doing forms the basis of the action. Such damage may have already been committed or there may be a serious risk of it in the future.

A few well-known judicial pronouncements stating the principle of the law may be given here. In a famous passage which has been so frequently quoted by later Judges, Lord Langdale, M.R., laid down the law of passing-off in the

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damages. In *Landa v. Greenberg*, (1908) 24 T.L.R. 441 it was held that the right to a *nom de plume* by which contributions to a newspaper are signed and known may be protected.

(4) *Samuelson v. Producers Distributing Co., Ltd.*, 48 R.P.C. at p. 593.

(5) *Houghton v. Film Booking Offices, Ltd.*, 48 R.P.C. 329; *Samuelson v. Producers Distributing Co., Ltd.*, 48 R.P.C. 447, 580.

(6) *Luxmoore, J.*, in *Samuelson v. Producers Distributing Co., Ltd.*, 48 R.P.C. at pp. 459 and 460.

(7) *Klaw v. The General Film Company* and *Manners v. Triangle Film Co.*, reported in Macgillivray's Copyright cases (1917-23, pp. 86 and 103) and cited in *Samuelson v. Producers Distributing Co.*, 48 R.P.C. at pp. 459 and 460.

(8) *Gurkha Association, Simla, Ltd. v. Mahomed Umar*, A.I.R. 1919 Lahore 193; *British Legion v. British Legion Club (Street), Ltd.*, 48 R.P.C. 555.

following terms: "I think that the principle on which both the Courts of Law and of Equity proceed, in granting relief and protection in cases of this sort, is very well understood. A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practise such deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters or other *indicia*, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person. I own it does not seem to me that a man can acquire a property merely in a name or mark, but whether he has or not a property in the name or the mark, I have no doubt that another person has not a right to use that to attract to himself that course of trade, or that custom which without that improper act, would have flowed to the person who first used, or was alone in the habit of using, the particular name or mark."<sup>9</sup> And in *Croft v. Day*,<sup>10</sup> the same learned Master of the Rolls said: "The principle in these cases is this—that no man has a right to sell his own goods as the goods of another. You may express the same principle in a different form, and say that no man has a right to dress himself in colours, or adopt and bear symbols to which he has no peculiar or exclusive right, and thereby personate another person, for the purpose of inducing the public to suppose either that he is that other person, or that he is connected with and selling the manufacture of such other person, while he is really selling his own. It is perfectly manifest that to do these things is to commit a fraud, and a very gross fraud."

In *Farina v. Silverlock*,<sup>11</sup> Lord Cranworth observed: "I apprehend that the law is perfectly clear, that any one who has adopted a particular mode of designating his particular manufacture, has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking exactly like it, but that they shall not sell it in such a way as to steal (so to call it) his trade mark, and make purchasers believe

(9) *Perry v. Truefitt*, (1842) 6 Beav. 66.

(10) (1843) 7 Beav. 84.

(11) 6 De G.M. & G. 214; 26 L.J.Ch. 11. "The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader." Lord Kingsdown in *Leather Cloth Co., Ltd. v. American Leather Cloth, Co., Ltd.*, 11 H.L.C. 523.

that it is the manufacture to which that trade mark was originally applied."

In *Reddaway v. Banham*,<sup>12</sup> Lord Chancellor Halsbury laid down the law thus: "For myself I believe the principle of law may be very plainly stated, and that is that nobody has any right to represent his goods as the goods of somebody else." And in the well-known *Powell's case*<sup>13</sup> the same Lord Chancellor said: "The proposition of law is one which, I think, has been accepted by the highest judicial authority, and acted upon for a great number of years. It is that of Lord Justice Turner, who says, in terms: 'No man can have any right to represent his goods as the goods of another person. In an application of this kind, it must be made out that the defendant is selling his own goods as the goods of another.' The most obvious way in which a man would be infringing this rule laid down by Lord Justice Turner is, if he were to say in terms: 'These are the goods manufactured by a rival trader; and it seems to be assumed that unless he says something equivalent to that, no action will lie. It appears to me that that is an entire delusion. By the course of trade, by the existence and technology of trade, and by the mode in which things are sold a man may utter that same proposition, but in different words and without using the name of the rival tradesman at all. A familiar example, of course, is when without using any name, by the identity of the form of the bottle or the form of the label, or the nature of the thing sold in the package, he is making the statement not in express words, but in one of those different forms in which the statement can be made by something that he knows will be understood by the public. In each case it comes to be a question whether or not there is the statement made, and if the statement is made, there can be no doubt of the legal conclusion that he must be restrained from representing that the goods that he makes are the goods of the rival tradesman. Then you get back to the proposition which I have read from Turner, L.J."

**Right to manufacture or sell not affected.**—The doctrine is thus based on the broad proposition that equity will not allow one person to palm off his goods as those of another, and thereby cause injury to that person. Two rivals in business, competing with each other, may manufacture the same line of goods, but if one of them had used certain distinctive labels, words or marks, on his

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(12) 13 R.P.C. 218 at p. 224.

(13) *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, 14 R.P.C. at p. 727.

goods to indicate to the public that the goods upon which they are applied are of his manufacture, his competitor in business will not be permitted to mislead the public by fraudulently using such labels, word or marks. As Lord Ardmillan said in one of the early Singer cases,<sup>14</sup> "Singer & Co. have no monopoly of the invention, and no exclusive right to make or to sell the machine. Any one may make it, any one may sell it. But there must be no deception, no sailing under false colours, no unfair and delusive assumption of a trade mark, or of a name appropriated and known as a trade mark." And in the well-known Yorkshire Relish case,<sup>15</sup> Lord Justice Lindley similarly observed: "It must never be forgotten that a trade mark only confers, on the person whose mark it is, a right to say, "Do not imitate my mark in connection with goods like mine, so that yours may be mistaken for mine." There is no exclusive right to the mark, except in connection with such goods to prevent deception or mistake. Still less does a trade mark confer any exclusive right to make or sell the kind of goods denoted by the mark. Unless a person has a patent for his goods, similar goods may be made and sold by any one; and they may be better or worse, dearer or cheaper, than those denoted by the mark. The mark is only a protection against mistakes in taking one person's goods for another's and the right conferred by a trade mark is only to prevent its use, if its use deceives or misleads, or is proved to be calculated so to do." And, in *The Singer Manufacturing Co. v. Loog*,<sup>16</sup> Lord Justice James said: "Whatever name is used to designate goods anybody may use that name to designate goods; always subject to this, that he must not, as I said, make, directly or through the medium of another person, a false representation that his goods are the goods of another person."

**Fraudulent intent need not be proved.**—The decisions in *Millington v. Fox*<sup>17</sup> and in the Singer cases<sup>18</sup> discussed in the earlier sections established once for all that in a passing-off action the plaintiff need not show any fraudulent intent or guilty knowledge

(14) *Singer Manufacturing Co. v. Kimball and Morton*, (1873) 10 Scot. L. Rep. 173; Seb. Dig., p. 247. See also *Singer Manufacturing Co. v. Loog* 8 App. Cas. 15; *Leonard and Ellis' Trade Mark*, (1884) 26 Ch. D. 288.

(15) *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, 13 R.P.C. at p. 250.

(16) (1882) 18 Ch.D., p. 412; 52 L.J.Ch. 481; 8 App. Cas. 15.

(17) 3 My. and Cr. 338.

(18) *Singer Manufacturing Co. v. Wilson*, (1871) 3 App. Cas. 376  
*Singer Manufacturing Co. v. Loog*, (1882) 8 App. Cas. 15.



on the part of the defendant. As Brett, L.J., said: "It is not at all necessary according to the authorities and according to the doctrines of the court, to suppose there was any intention of fraud existing or that there would be any in the future."<sup>19</sup> The broad proposition was established that, in order to obtain relief, it is not necessary to prove any fraudulent intention, and that it is sufficient if the plaintiff proves his proprietary right to the mark, and its actual infringement. This principle of law is now well settled.<sup>20</sup> The law was summarised in *Reddaway & Co. v. Benthams Hemp Spinning Co.*,<sup>21</sup> by Lord Justice Lindley, who, in overruling the decision of the lower court, observed: "I am convinced that the learned Judge had not present to his mind the equitable doctrine established by Lord Cottenham in *Millington v. Fox* and recognised and acted on by the House of Lords in *Johnston v. Orr Ewing*. To obtain an injunction in a case like the present, it is not necessary to prove an intention to mislead, nor to prove that any one, in fact has been misled. All that need be proved is that the defendant's goods are so marked, made up, or described by him as to be calculated to mislead ordinary purchasers and to lead them to mistake the defendant's goods for the goods of the plaintiffs." In *Saxlehner v. Apollinaris Co.*,<sup>22</sup> Kekewich, J., stated the law in similar terms: "If in a case like the present, the defendants' goods on the face of them, and explained by surrounding circumstances, are calculated to deceive, it seems to me

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(19) *Hendriks v. Montagu*, (1881) 17 Ch.D. 648.

(20) See *Johnston v. Orr-Ewing*, 7 App. Cas. 219; *Clement v. Maddick*, 1 Giff. 98; *Borthwick v. The Evening Post, Ltd.*, (1888) 37 Ch.D. 449; *Slazenger & Sons v. Feltham & Co.*, 6 R.P.C. 531; *Eno v. Dunn & Co.*, 6 R.P.C. 379, 7 R.P.C. 311; *Bodega, Co., Ltd., and Riviere v. Owens*, 6 R.P.C. 236, 7 R.P.C. 31; *Montgomery v. Thompson*, 8 R.P.C. 361; *Paine & Co. v. Daniell & Sons' Breweries, Ltd.*, 10 R.P.C. 217; *Reddaway v. Banham*, 13 R.P.C. 218; *Saxlehner v. Apollinaris Co.*, 14 R.P.C. 645; *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*, (1898) 1 Ch. 539; *Cellular Clothing Co. v. Maxton & Murray*, 16 R.P.C. 397; *Chivers & Sons v. Chivers & Co., Ltd.*, 17 R.P.C. 420; *Grant v. Levitt*, 18 R.P.C. 361; *Carr & Sons v. Crisp & Co., Ltd.*, 19 R.P.C. 497; *Bourne (Addley) v. Swan and Edgar, Ltd.*, 20 R.P.C. 105; *Faulder & Co. v. O. & G. Rushton, Ltd.*, 20 R.P.C. 477; *Iron-Ox Remedy Co., Ltd. v. Co-operative Wholesale Society, Ltd.*, 24 R.P.C. 425; *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, 24 R.P.C. 27; *Yeatman v. Homberger & Co.*, 29 R.P.C. 561, 645; *Perry & Co., Ltd. v. T. Hessin & Co.*, 29 R.P.C. 101, 509; *Spalding (A.G.) & Bros. v. A. W. Gamage, Ltd.*, 32 R.P.C. 273; *O. T. Ltd. v. Cumming & Co.*, 32 R.P.C. 69; *Reliance Rubber Co., Ltd. v. Reliance Tyre Co., Ltd.*, 42 R.P.C. 91; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461.

(21) 9 R.P.C. 503.

(22) 14 R.P.C. 645 at p. 654.

that no evidence is required to prove the intention to deceive, nor ought time and money be expended on any such evidence. The sound rule is, that a man must be taken to have intended the reasonable and natural consequences of his acts, and no more is wanted." So also in *Bourne v. Swan & Edgar Ltd.*,<sup>23</sup> Farwell, J., observed: "It has been pointed by many judges that the injury to the plaintiff is the same whatever the intention of the defendant may have been, and there are cases in which the defendant either did not know of the existence of the plaintiff's marks when he originally took it or honestly believed that he had not in fact done anything which could mislead the public." So, Vice-Chancellor Hall said in the "Silverpan" Jam case<sup>24</sup> that "if the defendants use a description which is calculated or likely to pass off goods as being of the plaintiffs' make when they are not, it is unnecessary to dive into their minds and establish any *animus furandi* or anything of that sort. It is enough if they use the words which are calculated to deceive—the Court will stop them." An illustrative case is *Upmann v. Elkan*<sup>25</sup> where it was held that the plaintiffs were entitled to an injunction notwithstanding the defendants' contention that they did not deal in the goods but acted merely as forwarding agents.

**Actual deception or special damage need not be shown.—**

As the action is in the nature of a *quia timet* action the plaintiff need not show that any case of actual deception had taken place or that he had suffered special damage. It is enough if he satisfies the court that the defendant sells his goods marked in a manner so as to lead purchasers to believe, or to create a probability of their believing, that they are buying the goods of the plaintiff.<sup>1</sup> As Farwell, J., said: "If the facts are such that the court can properly infer from the very nature of the two businesses, and the name that confusion must result, then the court acts on that conclusion apart from any evidence of actual confusion that has

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(23) 20 R.P.C. 105.

(24) *Faulder & Co., Ltd. v. O. & G. Rushton, Ltd.*, 20 R.P.C. 477 at p. 482.

(25) L.R. 12 Eq. 140; L.R. 7 Ch. 130.

(1) *Hookham v. Pottage*, 20 W.R. 720; 8 Ch. App. 91; *Thorley's Cattle Food Co. v. Massam*, (1880) 14 Ch.D. 763; *Reddaway v. Bentham Hemp Spinning Co.*, 9 R.P.C. 503; *Liebig's Extract of Meat Co., Ltd. v. Chemists' Co-operative Society, Ltd.*, 13 R.P.C. 736; *Smidt v. Reddaway & Co., Ltd.*, 9 C.W.N. at 290; 32 Cal. 401; *Abdul Salam v. Hamidullah*, 15 I.C. 116; *Muniswami Mudaliar v. Rajagopala Mudaliar*, A.I.R. 1928 Mad. 759; *Reddaway v. Hartley*, 48 R.P.C. 283; *The Clock, Ltd. v. The Clock House Hotel, Ltd.*, 52 R.P.C. 386 (Farwell, J.).

taken place in the past.”<sup>2</sup> The plaintiff has merely to prove “that the defendant has made use of a term which has acquired a special signification in respect of the plaintiff’s goods without having taken steps to prevent any misleading on the part of the public.”<sup>3</sup> The question is not whether any purchaser has been deceived, but whether he is likely to be deceived. For, as Sarjant, L.J., said, fraud is only one of the elements of the probability of deception.<sup>4</sup> This principle has been followed from the time when *Millington v. Fox*<sup>5</sup> was decided, and the decision had been approved in the House of Lords in *The Singer Manufacturing Co. v. Wilson*,<sup>6</sup> and *Cellular Clothing Co. v. Maxton and Murray*.<sup>7</sup> In *Reddaway v. Bentham Hemp Spinning Co.*,<sup>8</sup> the plaintiffs were non-suited at the trial by Cave, J., on the ground that they could not prove an intention to mislead or show that any one had in fact been deceived. On appeal the non-suit was set aside, and a new trial was ordered, on the ground that in such an action it was only necessary to satisfy the court that the defendants’ goods were so marked, made up, or described as to be calculated to deceive. Lord Justice Lindley observed: “The fact that no proof can be given that any one has been misled will be some evidence to show that no one is likely to be misled. But the absence of such proof is by no means conclusive;” and again, “To obtain an injunction in a case like the present, it is not necessary to prove an intention to mislead, nor to prove that anyone, in fact, has been misled.”

The same rule applies to business names. Thus in *Rodgers & Sons, Ltd. v. Hearnshaw*<sup>9</sup> where the plaintiffs proved that the name “Rodgers” was known universally as referring to their goods, injunction was granted, although the defendants pointed out that

(2) *British Legion v. British Legion Club (Street), Ltd.*, 48 R.P.C. at pp. 563 and 564. “If the court . . . comes to the conclusion that confusion is inevitable in the future and that that confusion must result in substantial damage to the plaintiffs, the plaintiffs are entitled to relief, notwithstanding that no confusion has actually been proved and no actual damage has been suffered.” *The Clock, Ltd. v. The Clock House Hotel, Ltd.*, 52 R.P.C. at p. 393 (Farwell, J.).

(3) *Bourne v. Swan and Edgar, Ltd.*, 20 R.P.C. 105 (Farwell, J.).

(4) *McDowell’s Application*, 43 R.P.C. at p. 339.

(5) (1838) 3 My. & Cr. 388.

(6) (1877) 3 App. Cas. 376.

(7) (1899) 16 R.P.C. 397.

(8) 9 R.P.C. 503.

(9) 29 R.P.C. 349. See also *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*, (1899) App. Cas. 83 and *Grant v. Levitt*, 18 R.P.C. 361.

there was not a single instance of confusion between the two goods. In *Woolworth & Co., Ltd. v. Woolworths (Australasia) Ltd.*,<sup>10</sup> the defendant company was incorporated for the purpose of buying in England for the Woolworths, Ltd. of Australia, goods similar to those dealt with by the plaintiff company. In granting an injunction Farwell, J., said:—"The evidence that has been called before me has not satisfied me that down to the present time there has been any serious confusion at all. . . . That, however, does not conclude the matter." His Lordship then proceeded to say:—"The fact that there has not been confusion during the first nine months of the defendant company's existence, does not in any way entitle the defendant company to succeed in this action, because my task is not only to decide whether there has been confusion in the past, but whether the names so nearly resemble one another as that the defendant's name is calculated to deceive. That is a question of the future. I have got, taking all the circumstances into consideration, to determine whether there will be the possibility of such confusion as will lead to damage to the plaintiff company, and whether the possibility is so great that the plaintiff company is entitled to the relief which it seeks."

The principle on which the court acts was laid down by Sir George Jessel thus: "What the law did prevent was fraud; and it prevented not only actual fraud, that is, fraud intentionally committed but it also prevented a man from carrying on business in such a way, whether he knew it or not, as to represent that his business was the business of another man."<sup>11</sup> The reason is obvious. "The very life of a trade mark depends upon the promptitude with which it is vindicated."<sup>12</sup> A plaintiff is not therefore bound to wait and see whether any member of the public has actually been deceived, and is justified in bringing the suit at the earliest possible moment directly an attempt is made by the defendant to pass other goods as the plaintiff's. Again, any delay which may be incurred in obtaining evidence of special damage may render the damage irreparable. So, in *Faulder & Co., Ltd. v. O. and G. Rushton, Ltd.*,<sup>13</sup> Vice Chancellor Hall observed: "It was said that

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(10) 47 R.P.C. 337.

(11) *Merchant Banking Co. of London (Limited) v. The Merchants' Joint Stock Bank*, (1878) 9 Ch.D. 560.

(12) *Johnston v. Orr-Ewing*, 13 Ch.D. 434.

(13) 20 R.P.C. at p. 490. See also *Price's Patent Candle Co., Ltd. v. Jeyes' Sanitary Compounds Company, Ltd.*, 19 R.P.C. 17; *Teofani & Co., Ltd. v. Teofani*, 30 R.P.C. 76, 446; *Forth and Clyde and Sunnyside Iron Com-*

nobody was deceived. There are a good many observations to be made about that. A man who finds that his trade is being infringed frequently says, "I will go to the court at once, and stop it immediately," and under those circumstances it is not likely that there would be evidence of any person being actually deceived, because his object is to stop it immediately." And, in *Robert Middlemas and Percy James Wood (trading as Walters & Co.) v. Moliver & Co.*,<sup>14</sup> Eve, J., said, "It is of great importance to a trader, when he ascertains that goods which he alleges infringe his rights are being put on the market, at once to nip, if he can, the process in the bud, and it may well be that the promptitude with which the plaintiffs acted in this case has in fact prevented cases of confusion arising."

#### Probability of deception constitutes sufficient cause of action.

—It is thus sufficient if the plaintiff shows that the defendant had offered for sale his goods marked in a manner which is likely to mislead the public into purchasing them believing them to be the plaintiff's goods. "In an application for an interdict it is not only not necessary to prove any pecuniary damage, but it is not necessary to prove that any injury has been actually inflicted. A threat of injury is a sufficient ground for an application for an interdict, and in like manner a reasonable apprehension of injury from the proceedings of the parties complained against is also in many circumstances a very good ground for such an application."<sup>15</sup> In *Spalding (A.G.) & Bros. v. A. W. Gamage, Ltd.*,<sup>16</sup> Lord Parker said:—"This principle is stated by Lord Justice Turner in *Burgess v. Burgess* and by Lord Halsbury in *Reddaway v. Banham* in the proposition that nobody has any right to represent his goods as the goods of somebody else. It is also sometimes stated in the proposition that nobody has a right to pass off his goods as the goods of somebody else. I prefer the former statement, for whatever doubts may be suggested in the earlier authorities, it has long been settled that actual passing-off of a defendant's goods for the plaintiffs' need not be proved as a con-

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*panies, Ltd. v. Sugg (William) & Co., Ltd.*, 45 R.P.C. 382; *Samuelson v. Producers Distributing Co., Ltd.*, 48 R.P.C. 447, 580.

(14) 38 R.P.C. 97.

(15) *Per Lord President Inglis in Singer Manufacturing Co. v. Kimball and Morton*, 10 Scot. L. Rep. 173, Seb. Dig., p. 247. See also *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Iron-Ox Remedy Co., Ltd. v. Co-operative Wholesale Society, Ltd.*, 24 R.P.C. 425.

(16) 32 R.P.C. at p. 283.

dition precedent to relief in Equity either by way of an injunction or of an enquiry as to profits or damages.”

Injury to the plaintiff's business may be caused either by way of loss of custom or by way of loss of reputation, and it is therefore sufficient for the plaintiff to show the probability of either of them. So in *Harrod's, Ltd. v. R. Harrod, Ltd.*,<sup>17</sup> Lord Justice Sarjant in the Court of Appeal said:—“I think that Byrne, J., in his decision went on too narrow a ground, because he thought that it was necessary, in order that the plaintiffs should succeed, that they should show there was some probability of their being involved in actual pecuniary liability to the customers of the defendants. It seems to me it was quite enough for him to have found, as was obviously the case there, that the proceedings of the defendants involved a risk of probability of injury to the trade reputation of the plaintiffs.”

**Notice of action need not be given to the defendant.**—The rule that a plaintiff in a passing-off action need not wait until actual deception occurs has been followed so closely by the courts that it has been held that it is not incumbent on the plaintiffs in the action even to inform the defendant before the commencement of the suit. So, in the early case *Pierce v. Franks*<sup>18</sup> it was held that the plaintiff had not exceeded his right in filing his bill without previous communication with the defendant, and that the plaintiff was entitled to the cost, notwithstanding the defendant's statement that he would have submitted if application had been made to him. The reason underlying this rule was explained in *Upmann v. Forester*<sup>19</sup> by Chitty, J., thus: “A plaintiff in these cases is placed in circumstances of difficulty, because, if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere, and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented.” The rule was explained in substantially similar terms in *Faulder & Co., Ltd. v. O. and G. Rushton, Ltd.*,<sup>20</sup> by Vice Chancellor Hall. “It was said that no letter was

(17) 41 R.P.C. at p. 87.

(18) 15 L.J. Ch. 122, Seb. Dig. p. 41.

(19) 24 Ch.D. 231 (1883).

(20) 20 R.P.C. at 490. “Why should a person assailed and injured by unfair competition teach his opponent how far he may safely go in undermining a rival business which he wishes to destroy? Why should he throw away the only chance of obtaining by process of law redress for injury already done.” Lord Macnaghten in *Weingarten Bros. v. Charles Bayer & Co.*, 22 R.P.C. 341 at p. 350.

written before the commencement of the action. But then there was an easy way of stopping the writ. As a matter of courtesy it is usual and proper that a letter should be written for the purpose of warning the proposed defendant of what is going to be done, so as to give him an opportunity of explaining or withdrawing. But in cases where a man is caught taking another man's trade or property, sometimes it is desirable to go on without delay so as to cut it short, and in this case possibly the plaintiffs wanted to make sure of the evidence that they could get before anything could be done which might interfere with proof of their case."

**Innocent infringement is no defence.**—The owner of a trade mark is entitled to protection against an innocent as well as against a malicious infringer. Injunction will be granted, notwithstanding the fact that the defendant did not know that the plaintiff was the owner of the mark at the time of the infringement. *Millington v. Fox*<sup>21</sup> which is the earliest authority on the point has already been referred to. "It does not signify, for the purpose of the plaintiffs' right to relief, whether the defendant had acted with a fraudulent intention or not; it is enough if, even without any unfair intention, he has done that which is calculated to mislead the public."<sup>22</sup>

In *Singer Manufacturing Co. v. Wilson*<sup>23</sup> Lord Cairns observed:—"The argument that fraud must be proved assumes that the trade mark of the plaintiff has been adopted and used by the defendant, but contends that this use of it is to continue without restraint even after the improper use has been pointed out, merely because in the first instance, it took place ignorantly or inadvertently. This argument appears to me to be founded on a misapprehension. The action of the court must depend upon the

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(21) 3 My. & Cr. 338 (1838). See also *McAndrew v. Bassett*, 33 L. J.Ch. 561; *Clement v. Maddick*, 1 Giff. 98; *Dixon v. Fawcus*, 3 E. & E. 537, *Cartier v. Carlile*, 31 Beav. 292; *Leather Cloth Co. (Limited) v. American Leather Cloth Co. (Limited)*, 4 De G. J. & S. 137; *Moet v. Couston*, 33 Beav. 578, *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15; *Powell v. The Birmingham Vinegar Brewery Co. Ltd.*, (1896) 2 Ch. 54; *Cellular Clothing Co. v. Maxton & Murray*, 16 R.P.C. 397.

(22) Per Kindersley, V.C., in *Glenny v. Smith*, 13 W.R. 1032 (1865); Seb. Dig. p. 144.

(23) 3 App. Cas. 376. See also *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, 24 R.P.C. at p. 31. "The defendants' conduct may have been perfectly innocent, but if as a matter of fact, the get-up is such that the Defendants' carton so nearly resembles the Plaintiffs' in distinctive features and is calculated to deceive, of course the Plaintiffs will succeed on the point of get-up" Clauson, J.; *Hampshire & Co., (1927) Ltd. v. General Kaputine Syndicate, Ltd.*, 47 R.P.C. 437 at p. 443.

right of the plaintiff, and the injury done to that right. What the motive of the defendant may be, the court has very imperfect means of knowing. If he was ignorant of the plaintiffs' right in the first instance he is, as soon as he becomes acquainted with them and persevered in infringing upon them, as culpable as if he had originally known them. I have never known any serious doubt entertained on this subject since the case of *Millington v. Fox*." So also, in *Cochrane (Sir Henry) v. McNish & Son*<sup>24</sup> the Privy Council observed: "The respondents erred unwittingly at first. But as they persisted in their error after their attention was called to the fact that they were infringing the appellant's rights, their conduct, in the eye of the law, amounts to fraud, and they must be held responsible for the consequences." And, in *Saxlehner v. Apollinaris Co.*,<sup>25</sup> Kekewich, J., said that the proposition that nobody has any right to represent his goods as the goods of somebody else is perfectly general. "There is no limit as regards name, origin, honesty of manufacture or sale, or otherwise. It matters not, therefore, how a Plaintiff's goods come to acquire a particular value, or how a Defendant's goods have come to adopt that value. If, in fact, the Defendant is selling his goods as those of the Plaintiff, he is doing what the law will not allow, and the Plaintiff is entitled to relief against him."

The law was stated by Cotton, L. J., in *Turton & Sons, Ltd. v. Turton*,<sup>1</sup> thus: "Of course, that (passing off) may be done unintentionally, but where there is a manifest and natural meaning in the words used that the goods are the goods of somebody else, and the man who uses those terms uses not his name only, but somebody else's, he would be stopped from doing so as soon as he is aware of the facts which make the *prima facie* intention and result of what he is doing, passing off his goods as the goods of somebody else. It was formerly said that no action could be maintained unless a man had done so fraudulently and intentionally, but when he finds out that the natural construction of what he is doing, when the facts are known, is to represent his goods to

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(24) 13 R.P.C. at p. 107. See also *Harrison v. Taylor*, (1865) 12 L.T.N.S. 339; *Clement v. Maddick*, 1 Giff. 98, Seb. Dig. p. 97; *Bodega Co. (Limited)* and *Biviere v. Owens*, 6 R.P.C. 236, 7 R.P.C. 31; *Baker v. Rawson*, 8 R.P.C. 107; *Paine & Co. v. Daniells & Sons' Breweries, Ltd.*, 10 R.P.C. 217; *Champagne Heidsieck et cie. v. Scotto & Bishop*, 43 R.P.C. 101.

(25) 14 R.P.C. at p. 652.

(1) 42 Ch.D. 128 (1889).



be somebody else's, then he should be stopped, even though he had originally done that unintentionally and innocently." So also, in *Chivers & Sons v. Chivers & Co., Ltd.*,<sup>2</sup> Farwell, J., observed that "fraudulent intention is not material, partly because a man is presumed to intend the natural consequence of his own act and partly because although he may have acted in ignorance in the first instance, yet if he continues that course of conduct after he has got knowledge of the facts, he then becomes guilty of the fraud, because he knows then in what the fraud consists."

**Conduct of the innocent infringer after notice of plaintiff's right.**—Where a trader has innocently adopted a trade mark which is calculated to deceive by its similarity to another's trade mark, his continuing to use after complaint has been made would constitute evidence of fraud.<sup>3</sup> As to what an innocent infringer is expected to do after he becomes aware of the plaintiff's right was stated in *Upmann v. Elkan*<sup>4</sup> by Lord Romilly, M.R., thus: "It is his duty at once to give all the information required, and to undertake that the goods shall not be removed or dealt with until the spurious brand has been removed and to offer to give all facilities to the person injured for that purpose. If, after that, the person injured files a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit, he will not get from such defendants the costs of the suit, and he may have to pay them." In the above case a firm of forwarding agents in London received from correspondents abroad several boxes of cigars with counterfeit trade marks. On application by

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(2) 17 R.P.C. 420. "In the result it is perfectly immaterial to my mind, for the purposes of the decision of this case, whether they (defendants) were fraudulent or not, . . . it is perfectly immaterial whether they intended it or not." Lord Halsbury in *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*, (1899) App. Ca. 83. "If the taking of a name were originally innocent, persistence after the knowledge may become fraud," *Harrod's, Ltd. v. R. Harrod*, 41 R.P.C. 47, Sarjant, L.J. "The fact that there is no fraud, the fact that the Defendant company has acted in good faith does not protect it from an order against it by the court, if I am satisfied that the names are so similar that there is a serious risk of confusion which will cause damage to the plaintiff company." Farwell, J., in *Woolworth & Co., Ltd. v. Woolworths (Australasia), Ltd.*, 47 R.P.C. at p. 340.

(3) *Orr-Ewing & Co. v. Johnston & Co.*, (1880) 13 Ch.D. 434.

(4) L.R. 12 Eq. 140. Where a party has established his object by unnecessary litigation costs may not be awarded, *Millington v. Fox*, 3 My. & Cr. 338; In *Moet v. Couston* (1864), 33 Beav. 578 an injunction was granted but not account of profits against the innocent infringer.

the owners of the marks the agents gave information as to the consignors, and offered either to send back the cigars or erase the marks. As the agents had given sufficient information they were not required to pay costs. In *Catterson & Sons, Ltd. v. Anglo-Foreign Manufacturing Co. Ltd.*,<sup>5</sup> the defendants who were commission agents ordered incandescent mantles from a German manufacturer and directed that they might be made up in the same form as a sample of the plaintiff's case, which had been handed to them by their customer. The defendants alleged that they did not know that the sample case was the case in which the plaintiffs were in the habit of making up their goods. But as they did not admit the plaintiff's right and merely stated that they had taken the matter up with the manufacturer and customer, the plaintiff's motion for an interlocutory injunction was granted with costs. Warrington, J., said that it appeared to him that the defendants' "letter was not a proper letter to have been written by persons who had innocently forwarded what was in fact a gross fraud." Where certain circulars containing a mis-statement had been issued it was held that it was the duty of the defendants to set right their mistake at the earliest available opportunity," notwithstanding that there had not been any actual fraud or intention to deceive on the part of the defendants, and the infringement was due to inadvertence on the part of a careless manager. The defendant's offer to pay nominal damages and to give an undertaking not to use the mark except in connection with the plaintiff's goods was not in the circumstances held to be sufficient.

In the *Masbro* case<sup>7</sup> an action was brought to stop a Co-operative Society from supplying a substitute in response to orders for the plaintiffs' goods. On the first day of the trial the counsel for the defendants said that they never had claimed that it was proper to supply these goods without explanations, and that they were perfectly willing to give an undertaking that they would not do so. The court held that there was no justification for rejecting that very reasonable offer and refused to grant an injunction and order as to costs. In *American Tobacco Co. v. Guest*<sup>8</sup> the defen-

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(5) 28 R.P.C. 74. See, *Vokes, Ltd. v. Evans and Marble Arch Motor Supplies, Ltd.*, 49 R.P.C. 140.

(6) *Yeatman v. Homberger & Co.*, 29 R.P.C. 561 & 645; See also, *Spalding & Bros. v. Gamage, Ltd.*, 30 R.P.C. 388, 31 R.P.C. 125, 32 R.P.C. 273.

(7) *Lever Bros, Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, 29 R.P.C. 33, 225.

(8) 9 R.P.C. 218.

dants who had purchased in the market five hundred spurious cigarettes in the belief that they were in fact the Plaintiff's cigarettes, had returned all the cigarettes bought except twenty and were willing to submit to any order. Costs of the action were not allowed. In *Kodak, Ltd. v. Thomas Illingworth & Co., Ltd.*,<sup>9</sup> several instances were proved of sales of the defendants' goods when the plaintiffs' goods were ordered. The defendants, while alleging that passing-off, if any, was by salesmen acting contrary to directions given to them, expressed willingness to give an undertaking and damages but refused an apology for publication. Interlocutory injunction was granted by Tomlin, J. In *Societe Francaise v. West Central Wireless Supplies*<sup>10</sup> the defendants innocently sold under the plaintiffs' trade name "Sferavox" a single loud speaker not of the plaintiffs' but denied that the plaintiffs were entitled to an injunction or to damages. They had exhibited in their window a loud speaker not of plaintiffs' manufacture under the name "Sferavox." Injunction was allowed with costs, notwithstanding that the plaintiffs had asked for damages to which they were not entitled.

It may be mentioned here that since *Edelsten v. Edelsten*<sup>11</sup> it is settled law in England that an innocent infringer is liable only for nominal damages. But wilful persistence by defendants in infringing a trade mark after their attention is called to it amounts to fraud and actual damages or an account of profits will then be ordered.<sup>12</sup>

**Where proof of actual deception may be material.**—Although it is not necessary for the plaintiff to establish a single case of actual deception where the court is satisfied that there would be probability of confusion between the two marks, evidence as to a few clear cases of deception of the public would be material where the court expresses doubt as to whether the defendant's mark is calculated to deceive.<sup>13</sup> Where, therefore, the marks had been in use for several years side by side and no case of actual deception had occurred, the court may find it difficult to believe

(9) 43 R.P.C. 33.

(10) 45 R.P.C. 276.

(11) 1 De G. J. & S. 185.

(12) See Chapter on Damages.

(13) "In a passing-off case it is, of course, not necessary to prove intention to deceive or actual deception; but the absence of both is highly important." Lord Robertson in *Weingarten Bros. v. Charles Bayer & Co.*, 22 R.P.C. at p. 352.

that the defendant's mark is calculated to deceive. "If you did prove" said the Master of the Rolls in *Christiansen's Trade Mark case*<sup>14</sup> "as a fact that this (trade mark) had been used for years, and if you could prove and did prove that nobody ever had been deceived, that would go a great way certainly to modify one's own opinion, because if one found that people had not been deceived one would not be obstinate about it." So, in *Rodgers v. Rodgers*<sup>15</sup> injunction was refused on the ground that no case of deception had occurred, although the goods of the plaintiff and the defendant had been on the market for several years. Mellish, L.J., said: "In my judgment in order to make out a clear case when it has lasted for such a great number of years as this, the plaintiff ought to prove satisfactorily that persons have actually been deceived." So also in *Lambert's Trade Mark case*<sup>16</sup> although the two marks had been existing side by side for nearly 200 years it was not shown that any one had been deceived during this long period, Mr. Justice North said that, while he did not hold for a moment that proof of actual deception was essential, yet the absence of it, when it might have been proved, was a matter deserving consideration. And, in *Baker v. Rawson*<sup>17</sup> the same learned Judge observed: "My mind is very much influenced by the fact that neither in Wolstenholme's time nor since, has any case of deception been actually proved. I am quite aware of the authorities upon the subject, that it is not necessary to prove such a case, and the probability of deception may be made out without any such case being proved, but, on the other hand, if there is a doubt on the subject as to whether a mark is likely to deceive or calculated to deceive or not, the production of two or three clear cases of

(14) 3 R.P.C. at p. 62. See also, *Alex. Pirie & Sons Ltd's Application*, 49 R.P.C. at p. 216, 50 R.P.C. 147.

(15) 31 L.T.N.S. 285 (1874). See also, *Cope v. Evans*, L.R. 18 Eq. 138 (1874); *Phillips v. Ogden*, 12 R.P.C. 325; *Nicholson & Sons Ltd's Application*, 48 R.P.C. 227; *Jays's, Ltd. v. Jacobi and Limburg*, 50 R.P.C. 132; *C. & T. Harris (Calne), Ltd. v. F. S. E. Harris*, 51 R.P.C. 98.

(16) 5 R.P.C. 542. See also, *Talbot's Trade Marks*, 11 R.P.C. 77; *The London General Omnibus Company v. Lavell*, 18 R.P.C. 74 (Court of Appeal); *McCaw, Stevenson & Orr, Ltd. v. Lee Bros.*, 23 R.P.C. 1; *Holbrooks Ltd's Application*, 26 R.P.C. at p. 796; *Andrew & Co., Ltd. v. Kuehnrich*, 30 R.P.C. 677; *Duncan Alerdice & Co., Ltd. v. Edmund and John Burke, Ltd.*, 33 R.P.C. 341; *Willesdon Varnish Co., Ltd. v. Young and Marten, Ltd.*, 39 R.P.C. 285, *Hutchinson's Application*, 41 R.P.C. 538; *Ardath Tobacco Co., Ltd. v. Sandorides, Ltd.*, 42 R.P.C. 50.

(17) 8 R.P.C. 89. In *Macmillan v. Ehrmann Bros., Ltd.*, 21 R.P.C. p. 365, where Buckley, L.J., said: "No single person of any sort or

deception would be of the utmost importance, and I cannot fail to attach some weight to the fact that, there being great doubt in other respects, no case of deception of any kind is found." Injunction was therefore refused. On the other hand, in *Facsimile Letter Printing Co., Ltd. v. Facsimile Typewriting Co.*,<sup>18</sup> interlocutory injunction was granted restraining the defendants from using the name, instances of confusion having occurred. It is thus always advisable for the plaintiff to establish a few cases of actual deception wherever possible. And, it has been held that a certain amount of delay in getting such evidence will not constitute a bar to the plaintiff's right of action.<sup>19</sup> Where the marks are used abroad, the absence of evidence as to cases of confusion may be explained by the difficulty in procuring witnesses from the foreign countries.<sup>20</sup>

**Particulars of fraud to be given in the pleadings.**—In all cases where the party pleading relies at the trial on fraud it is essential that it should be put forward clearly in the pleading.<sup>21</sup> The object of this rule is to prevent the defendant being taken by surprise at the trial. Where the plaintiff alleges that various persons had been deceived by the defendant's goods the names and addresses of such persons form material facts of the case and must be disclosed to the defendant. The rule was stated thus by Kekewich, J.: "The courts have uniformly endeavoured to prevent the plaintiff or the defendant, as the case may be, from prying into the brief of his opponent, or finding out what is to be the evidence which is to be produced at the trial. On the other hand, the courts have uniformly said that the plaintiff or the defendant is entitled to be told any and every particular which

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description has been called who said: "I read the defendants' list, and I thought that what they were offering was the plaintiffs' whisky and I ordered from the defendants under that belief." I do not say that that concludes the case either. If I find that the words are calculated to induce that belief, I might find that without evidence of cases in which it had that result, but the fact that there is no evidence at all that it ever had that result is, of course, a very important factor in arriving at a conclusion as to this." *Coleman & Co., Ltd. v. Stephen Smith & Co., Ltd.*, 29 R.P.C., at p. 89, Cozens Hardy, M.R., See also, *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps, Ltd.*, 45 R.P.C., at p. 36.

(18) 29 R.P.C. 557. See also, *Smith's Application*, 40 R.P.C. 77.

(19) *Lee v. Haley*, L.R. 5 Ch. 155, 18 W.R. 242.

(20) *Wilkinson v. Griffith Bros. & Co.*, 8 R.P.C. 370.

(21) Civil Procedure Code, Order VI, Rule 4. If the particulars of the alleged fraud are not set forth in the plaint the plaint may be rejected under Order VII, Rule 11.

will enable him to properly prepare his case for the trial, so that when the trial comes on he may not be taken by surprise.”<sup>22</sup>

While a plaintiff must, in general, be limited to the case which he puts forward in his plaint the court may allow him to amend the pleading under certain circumstances.<sup>23</sup> For instance, in *Muniswami Mudaliar v. Rajagopala Mudaliar*<sup>24</sup> the owner of a journal known as “Ananda Bodhini,” complained that the defendant had recently started a similar periodical under the name “Ananda Guna Bodhini,” and that the use of this name was calculated to deceive the public. When the case came up for trial the plaintiff sought permission to amend his plaint by alleging fraud. It was held that the omission to refer to fraud in the plaint was due to an oversight and that in the interests of justice the amendment ought to be allowed. The rule was stated by Astbury, J., thus<sup>25</sup>: “An amendment of the pleading may be allowed where it is only an amplification of their original statement that the defendants have been fraudulently passing off, or attempting to pass off their goods as Plaintiffs’, and where no harm could be done which is not capable of being compensated for by costs. The costs of the application and the costs occasioned by the amendment must be borne by the plaintiffs.”

#### Probability of deception presumed in cases of fraud.—

Although fraudulent intention need not be shown it will be useful for a plaintiff in a passing-off action to ascertain whether the defendant had adopted the mark with *bona fide* or fraudulent intention. “If a mere comparison of the goods, explained by surrounding circumstances, is not sufficient, then it is allowable to prove from other sources that what is, or may be, apparent innocence was really intended to deceive”.<sup>1</sup> Where fraud is established “the court would readily assume that the defendant would be likely to succeed in his design, however much it might on the face of it appear to a lawyer that he had sufficiently distinguished the designation which he has applied to his

(22) *Humphries v. Taylor Drug Co.*, 5 R.P.C. 687.

(23) *See*, Civil Procedure Code, Order 6, Rule 17.

(24) A.I.R. 1928 Mad. 759.

(25) *India Rubber Gutta-percha and Telegraph Works, Ltd. v. Country Golf Co.*, 42 R.P.C. 225.

(1) *Per Kekewich, J.*, in *Saxlehner v. Apollinaris Co.*, 14 R.P.C., at p. 654.

goods from the plaintiffs''<sup>2</sup>. If you are driven to this conclusion'' said Lindley, L.J., ''that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do.''<sup>3</sup> Success will generally be presumed where there is intention to defraud. For, as Farwell, L.J., observed: ''It does not lie in the mouth of a rogue, when he is found to be a rogue as a fact, to say that his roguery was so clumsy that it could not possibly succeed.''<sup>4</sup> ''If I once came to the conclusion that fraud had been intended I should restrain the defendants altogether. It is no defence to say: ''We tried to commit a fraud and failed.''<sup>5</sup> In *Royal Insurance Co., Ltd. v. Midland Insurance Co., Ltd.*,<sup>6</sup> Cozens-Hardy, M.R., observed: ''I am aware that in an action of this kind it is not necessary to prove fraud on the part of the defendant, if you prove and satisfy the court that what the defendant is doing is calculated to deceive, and to prejudice the plaintiffs in their trade or business. Still the presence of fraud makes an enormous difference. Given a case of fraud, the court does not allow the defendant to say that his intention to take what was not his, and to damage the plaintiffs, would be ineffective. The Court assumes that the rogue was skilful enough to devise a scheme which would have the effect which he desired, or, in other words, he is not allowed to say that his fraudulent act would not have the effect which he desired that it should have.'' In the case of *Lloyd's v.*

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(2) *Beddaway v. Hartley*, 48 R.P.C., at p. 299, Lawrence, L.J. ''If the object was to deceive, then the Court will presume as against the wrong doer that the means employed to cause deception were calculated to effect that purpose. . . . It follows from this reasoning that if the plaintiffs imitated the whole or part of Dewhurst's mark with the object of deceiving the Court will presume as against the plaintiffs that the imitation as adopted was calculated to deceive. It is only if the fraudulent design be negated that it becomes material to enquire whether the resemblance was calculated to deceive.'' per Sale, J., in *Nemi Chand v. Wallace*, 34 Cal. 495; 11 C.W.N. 537.

(3) *Slazenger & Sons v. Feltham & Co.*, 6 R.P.C., at p. 538. ''If you establish that the motive was to try and imitate, you may well infer from that, that a man who was going to do a scoundrelly action for his own benefit would take care to do it effectually, and you might infer, therefore, that if the motive was to defraud, the person defrauding would take care to see that what he did was done effectually.'' Romer, L.J., in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, 17 R.P.C., at p. 56.

(4) *Chivers & Sons v. Chivers & Co., Ltd.*, 17 R.P.C. 420.

(5) *Lambert & Butler, Ltd. v. Goodbody*, 19 R.P.C. at p. 381, Farwell, L.J.

(6) 26 R.P.C., at p. 97.

*Lloyd's (Southampton), Ltd.*,<sup>7</sup> the plaintiffs brought an action against the defendants for an injunction to restrain them from representing that they were carrying on business as Lloyd's agents. Warrington, J., said that the defendants were making an "impudent attempt to obtain by the use of this name, some benefit from the reputation attaching in the shipping world to the name of 'Lloyd's'", but he refused to grant an interlocutory injunction on the ground that on the evidence there was no "reasonable probability of such deception being practised." The Court of Appeal, however, held that the evidence was amply sufficient to enable the court to say that the defendants were using the plaintiffs' name for a fraudulent and improper purpose and that the injunction should therefore be granted. Cozens-Hardy, M. R. observed: "I agree as to the attempt, but I can stop it. If I find that a man, taking a particular name under which to trade, is a knave, I give him credit for not being also a fool, and I assume that there is a reasonable probability that his knavish purposes will succeed. In *Iron-Ox Remedy Co., Ltd. v. Co-operative Wholesale Society, Ltd.*,<sup>8</sup> the plaintiffs had been selling a proprietary medicine under the name 'Iron-Ox tablets'. The defendants, being unable to obtain the plaintiffs' goods for sale, caused to be made and supplied to their retail customers a substitute under the designation of "Compound of Iron oxide tablets", which contained iron-oxide practically useless as a drug, and also other and useful drugs, with the avowed intention of competing with 'Iron-Ox tablets'. There was no complaint of similarity of get-up and the plaintiffs had no objection to the pill being described as oxide of iron tablet. Injunction was granted on the ground that the defendants action would lead to confusion, and was for that purpose deliberately chosen. Parker, J., said, "In considering a question of this sort it is always very material to know the precise circumstances under, and the precise reasons for which the trade description to which objection is made, has been adopted. If the conclusion is once arrived at, that the description was adopted not with the object of fairly describing the goods to which it is applied, but with the object either of actually misleading the public, or taking an undue advantage of the business connection, or the

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(7) 29 R.P.C. 433. See also, *Walter v. Ashton*, 2 Ch. 282; *Harrod's, Ltd. v. R. Harrod, Ltd.*, 41 R.P.C. 74.

(8) 24 R.P.C. 425. See also *John Brinsmead & Sons, Ltd. v. Brinsmead*, 30 R.P.C. 493; *Hennessy & Co. v. Keating*, 25 R.P.C. 125, *Seeley & Co., Ltd. v. Embosotype Manufacturing Co.*, 41 R.P.C. 160.



expenditure, of a rival trader, it does not, I think, require much further evidence to justify the conclusion that the public is likely to be misled.”

**Close similarity in goods may not be insisted on where fraud is shown.**—The general rule is that the owner of a trade mark in one class of goods cannot complain if the mark is used by the defendant in a different class of goods.<sup>9</sup> However, where fraud is shown, the courts will not look minutely whether or not the nature of the business carried on by the defendant is very similar to that of the plaintiff. Injunction may be granted even if there be only slight similarity or connection between the two goods. A case illustrating this point is *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*<sup>10</sup> The plaintiffs had been using the word “Dunlop” on pneumatic tyres for cycles and their accessories, such as pumps and inflators, while the defendant company dealt in oils and lubricants for cycles. The words “The Dunlop” were printed in bold letters on the labels, the name of the lubricants being in small type. In granting an injunction, Romer, J., said, “The word ‘Dunlop’ is put in a very prominent way. I am satisfied that he does that with a view of inducing customers to believe that these goods, if they are not the goods of the plaintiffs, are goods used in some way with their sanction, or connected in some way with them so as to get the benefit of the plaintiff’s name. It appears to me that the plaintiffs are entitled to say that the word ‘Dunlop’ ought not to be allowed to be used under those circumstances with those objects by the defendant; that it would injure them in their business very considerably if it is not stopped. They themselves are sellers of cycle accessories, though as a matter of fact up to the present time they have not sold burning oil or lubricants. But they may do so, and in the meantime it appears to me that they are entitled to come into court and say that a name substantially identical with theirs ought not to be allowed to be used by the defendant in the way in which he is using it. I therefore think that the plaintiffs are entitled to some relief.”

*Eastman Photographic Materials Co., Ltd. v. (John) Griffiths Cycle Corporation, Ltd.*,<sup>11</sup> is a similar case. The plaintiff company

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(9) *Turners Motor Manufacturing Co., Ltd. v. Miesse Petrol Car Syndicate*, 24 B.P.C. 531; *Nugget Polish Co. Ltd. v. Harboro Rubber Co.*, 29 B.P.C. 133; *Tokalon, Ltd. v. Davidson & Co.*, 31 B.P.C. 74; *Wilson’s and Mathieson’s, Ltd. v. Meynell & Sons, Ltd.*, 46 B.P.C. 80.

(10) 16 B.P.C. 12.

(11) 15 B.P.C. 105. See also *Australian Wine Importers’ Trade Mark*, 6 B.P.C. 311.

were making special cameras for use on bicycles and these were well known as "Bicycle Kodaks". The defendants registered the word 'Kodak' for bicycles and advertised them as "Kodak cycles". It was held that the defendants were trying to get fraudulently the reputation of the Eastman Photographic Materials Co., and injunction was, accordingly, granted and an order was made to expunge the mark from the Register.

**Fraud presumed where similarity is close and is not explained.**—An intention to deceive may be inferred from the circumstances of the case though no case of actual deception is proved.<sup>12</sup> Where the court finds a close resemblance between the two marks and the differences are unexplained, fraud will generally be presumed.<sup>13</sup> "Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds, as it almost does find in such cases as this, that there is no reason for the resemblance, except for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading."<sup>14</sup>

The rule was clearly explained by Mr. Justice Sale in *Nemi Chand v. Wallace*.<sup>15</sup> Where there is a close similarity between two marks the onus is on the proprietor of the later trade mark to show that he had adopted the mark with *bona fide* intention.

(12) *County Chemical Co. Ltd. v. Frankenburg*, 21 R.P.C. 722.

(13) *Johnston v. Orr-Ewing*, 7 App. Cas. 219; *Sanitas Co. v. Condy*, 4 R.P.C. 195, 530; *Slazenger & Sons v. Feltham & Co.*, 6 R.P.C. 531; *Smith & Wellstood v. The Carron & Co.*, 13 R.P.C. 112; *Taylor v. Virasami Chetty*, 6 Mad. 108; *Madhavji Dharamsey Manufacturing Co., Ltd. v. Central India Spinning, Weaving and Manufacturing Co., Ltd.*, I.L.R. 41 Bom. 49, *Nemi Chand v. Wallace*, 11 C.W.N. 537; *Moolji Sicea & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678; *Aswini Kumar Pal v. Emperor*, A.I.R. 1930 Cal. 728; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461; *Mohideen Bawa v. Rigaud Perfume Manufacturers*, A.I.R. 1932 Rang. 114; *Ebrahim Currim & Sons v. Abdulla Sahib*, A.I.R. 1934 Mad. 226; *Jamal Noor Mohamed Sait Co. v. Abdul Kareem & Co.*, A.I.R. 1934 Mad. 211; 57 M. 600.

(14) *Per Wood, V. C.* in *Taylor v. Taylor*, 23 L.J.Ch. 255; Seb. Dig., p. 67. In *Mohideen Bawa v. Rigaud Perfume Manufacturers*, A.I.R. 1932 Rang. 114, Page, C. J., observed:—"Why is it that it so happens that the label and get-up of B-1 resembles A-1 so closely? Because the defendants deliberately intended to put B-1 on the market in such a form that the incautious buyer might be deluded into thinking that B-1 was A-1." In *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461 the Court said:—"There seems no doubt that step by step he (defendant) has altered it (trade name) into closer and closer resemblance to the plaintiff's. These changes seem obviously designed for the purpose indicated and certainly show a lack of *bona fides* on the part of the defendant."

(15) 11 C.W.N. 537.

If he fails to show that the inception of the mark was innocent "it becomes idle and unnecessary to enquire whether the imitation was calculated to deceive." For the resemblance must have been either designed or innocent and accidental, and whether it was the one or the other the defendant alone knows and can prove if he desires. "If they, having the opportunity, deliberately abstain from showing that the resemblance adopted by them was accidental and innocent, it necessarily follows that it was the result and outcome of deliberate design and intention."<sup>16</sup>

**Presumption of probability of deception may be rebutted.—**

Where fraudulent intent on the part of the defendant is shown or is presumed, the onus lies on him to prove that the mark has not deceived any one, and is not likely to deceive an average customer using average caution. In *Ford v. Foster*,<sup>17</sup> Lord Justice James said:—"The plaintiff makes this *prima facie* case—that he has a plain trade mark, a material and substantial part of which has been taken by the defendants. Then the onus is, under those circumstances, cast upon the defendants to relieve themselves from that *prima facie* liability." The rule was explained in *Newman v. Pinto*<sup>18</sup> by Lord Justice Fry in the following passage:—"When you find a deliberate design to deceive and we are asked to believe that the design has failed, and that nobody has been deceived by it, I say, speaking for myself, that the burden of proving that rests with the greatest weight on the shoulders of him who asserts that the intended deceit has failed. Those who conceive a design for the purpose of deceiving, and who ask the courts to hold that the design is innocent must prove it. I agree that there are cases in which statements originally false may become so common that no human being can be deceived by them. It may be, in that case, that the words, which originally carried a significance which was

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(16) The judgment was upheld on appeal. Maclean, C. J., observed:—"It would be too great a strain upon our credulity to ask us to believe that all this was done by accident and not by design. Why did not the Plaintiff or some of his employees go into the box and explain how these goods came to have these marks? Why has it not been explained how we find the same heading, the combination of the green and the black and silver labels, and the same way of imprinting the number of yards? Why do the Plaintiff's marks come so near the Defendant's marks, and why does he not come forward to explain how it is that these marks bear such a strong resemblance to each other, or the circumstances under which his goods with these marks upon them came to be imported into this country?" 11 C.W.N. 537.

(17) L.R. 7 Ch. 611.

(18) 4 B.P.C. 508 at p. 520.

false, have become harmless and innocent; but it is for those who assert it to prove it.”

**Presumption of fraudulent intent not made where the mark is common to the trade.**—Fraudulent intention cannot be presumed against the defendant, notwithstanding the close similarity of the two marks if the points of resemblance complained of are common to the trade. The legitimate use of the mark in the trade must be taken into consideration in deciding the question of probability of deception.<sup>19</sup> Thus, in *Schweppes, Ltd. v. Gibbens*<sup>20</sup> the plaintiff sold soda water in bottles with a label which was of chocolate colour with a white border and a red medallion in the centre of the label. The words “Schweppes soda water” were printed on the label in white characters. The defendant subsequently began selling soda water in bottles with a somewhat similar label, of chocolate colour with a medallion on which the words “Gibben’s soda water” were printed prominently in white. It was shown that a chocolate label with printing in white was common to the trade. The suit was dismissed on the ground that the defendants’ label was not calculated to deceive. Similarly, in *Adamjee Hajee Dawood & Co., Ltd. v. Swedish Match, Co.*,<sup>21</sup> where the similarities between the two labels consisted in the use of the word ‘star’ and the figure of a star, injunction was refused on the ground that they were common to the trade.

**Fraudulent intent per se not actionable.**—An intention to deceive without the actual or probable use of the means to deceive would not constitute a legal damage and would not therefore be sufficient ground for granting an injunction. As Lord Watson observed<sup>22</sup>:—“Motive cannot in itself constitute fraud, although it may incite the person who entertains it to adopt proceedings, which, if successful, would necessarily lead to a fraudulent result; and it is not the motive but the course of procedure which leads to that result, which the law regards as constituting fraud.” Intention

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(19) *Lyndon’s Trade Mark*, 3 R.P.C. 102; *Farrow’s Trade Mark*, 7 R.P.C. 260.

(20) 22 R.P.C. 113, 601. See also *In re Hyde & Co.’s Trade mark*, 7 Ch.D. 724 (1878); *Baker v. Rawson*, 8 R.P.C. 89; *Payton & Co. Ltd. v. Snelling, Lampard & Co.*, 17 R.P.C. 58; *Hennessey & Co. v. Titus Ward & Co. Ltd.*, 17 R.P.C. 58; *Hennessey & Co. v. Keating*, 25 R.P.C. 125; *William Co. v. Bronnley & Co. Ltd.*, 26 R.P.C. 765; *Jones Bros., Ltd. v. Anglo-American Optical Co.*, 29 R.P.C. 1, 361; *Perry & Co., Ltd. v. Hessin & Co.*, 29 R.P.C. 509.

(21) A.I.R. 1928 Rang. 210.

(22) *King v. Henderson*, (1898) App. Ca. 720.

to deceive is thus immaterial without evidence of actual or prospective injury to the plaintiff's business resulting from the defendant's conduct. So, in *Reddaway v. Banham*,<sup>23</sup> Lord Esher, M. R., said that the law does not take notice of a fraudulent intention in a man's mind if he does nothing to carry out the fraud.

The law was stated by Lord Loreburn thus<sup>24</sup>:—"As regards the charge of passing-off, put it as you will, it must be established that the defendant's goods were calculated to mislead purchasers into the belief that they were the plaintiffs' goods. It is said in this case that the defendants intended to deceive—not that the goods were calculated even innocently to deceive—but that there was fraudulent intention on the part of the defendants. That is a material fact which would be weighed duly, and to which, no doubt, great weight would be attached by any court if it were established, because, no court would be astute when they discover an intention to deceive, in coming to the conclusion that a dishonest defendant had been unsuccessful in his fraudulent design. When once you establish the intent to deceive, it is only a short step to proving that the intent has been successful, but still it is a step even though it be a short step. To any such charge, there must be, however, two conditions. The first is that it ought to be pleaded explicitly so as to give the defendant an opportunity of rebutting the accusation of intent. The second is that it must be proved by evidence."<sup>25</sup> And with this view the other Lords of the House concurred. Lord Macnaghten said: "When a person comes forward and asks the court to interfere because somebody is stealing or is about to steal his trade, he must prove that persons have actually been deceived or that what the defendant is doing is calculated to deceive."

(23) 12 R.P.C. at p. 89. See also *Perry & Co. Ltd. v. T. Hessin & Co.*, 29 R.P.C., p. 528 (Cozens-Hardy, M. R.); *Dixon & Son, Ltd. v. George Richardson & Co., Ltd.*, 50 R.P.C. 365.

(24) *Claudius Ash, Sons & Co., Ltd. v. Invicta Manufacturing Co., Ltd.*, 29 R.P.C. at p. 475.

(25) "If the intent to deceive be once established it is but a short step, though it is a step, and not an inevitable one, to the conclusion that the intention has been fulfilled, and that the goods are calculated to deceive". *Per Kekewich, J.*, in *Sazlehner v. Apollinaris Co.*, 14 R.P.C. 645. "Even if the motive were bad it would not follow of necessity that the motive had been effectually carried out". *Per Romer, L.J.*, in *Payton & Co., Ltd. v. Snelling, Lampard & Co.*, 17 R.P.C. 48 at p. 56.

(1) The question of fraudulent intention may be material in awarding costs. See, *Dixon & Son, Ltd. v. George Richardson & Co., Ltd.*, 50 R.P.C. 365. See also Lord Lindley's judgment in *Lever Bros, Ltd. v. Beddingfield*, 16 R.P.C. at p. 11, where the successful defendant was not

**False representation for trading purposes necessary.**—The plaintiff has thus to show that the defendant had actually used the false mark on goods for trading purposes. For, the essence of the action is that by the defendants' conduct the plaintiff has been deprived of the profits that would otherwise come to him. In *The London General Omnibus Co. v. Lavell*,<sup>2</sup> Farwell, J., said: "A man may paint his omnibus exactly like the omnibus of the London General Omnibus Co., if he pleases, so long as he does not use it to deprive the company of their passengers. If he keeps it in his back garden I see nothing to prevent him; but the real cause of action is the deceit upon the plaintiff company, not the painting, but the user of the omnibus, as painted." Where, however, the spuriously marked goods are found in large quantity, or where the defendant having the spurious goods is himself a trader in similar goods, the court will presume that the goods are for sale. In *Upmann v. Forester*,<sup>3</sup> the defendant, a China manufacturer, imported a large consignment of 5,000 cigars in cases bearing a false mark purporting to be that of the plaintiff. The defendant was ordered to pay the costs of the action although he stated that the cigars were purchased for his private use and was unaware that the brand was spurious. But in *American Tobacco Co. v. Guest*<sup>4</sup> where a retail dealer innocently purchased a small consignment of 500 cigarettes the defendant was not required to pay the costs of the action. Where the sales have been trivial, or where there had been only isolated instances of passing-off, the courts may refuse to grant any relief.<sup>5</sup>

**Mere imitation may not be actionable.**—Where a plaintiff does not prove actual deception the onus is on him to show that there is such reasonable probability of deception as to justify the interference of the court. The fact that the defendant has imitated the plaintiff's mark is not enough to entitle the latter to an injunction. As Lord Justice Romer said: "It is not sufficient to say 'calculated to deceive.' You must show that it is calculated

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allowed the costs of the action in the lower court on the ground that he had "only himself to thank for the litigation which he deliberately provoked." See Chap. VII.

(2) 18 R.P.C. 74 at p. 78.

(3) (1883) 24 Ch.D. 231.

(4) 9 R.P.C. 218.

(5) See *Leahy, Kelly & Leahy v. Glover*, 10 R.P.C. 141; *Burberrys v. Watkinson*, 23 R.P.C. 141; *Joseph Crosfield & Sons v. Caton*, 29 R.P.C. 47; *Donohoe, Ld. v. Cherry Bros., Ld.*, 26 R.P.C. 545; *Armstrong Oilier Co., Ld. v. Patent Axlebox and Foundry Co. Ld.*, 27 R.P.C. 362.

reasonably to injure somebody, to lead them to do some act, or abstain from doing some act which may possibly injure them. Now there may be a deception, perfectly innocent, which would injure nobody."<sup>6</sup> Where therefore there is no probability that the defendants' articles would be mistaken by the public for the plaintiff's, a mere imitation of the plaintiff's mark would not constitute an actionable wrong.<sup>7</sup> Such imitation deserves no doubt to be condemned on ethical considerations, but as Russell, J., remarked, the question that the court has to decide is, not whether the act complained of is fair, but whether it is actionable.<sup>8</sup> "It is no part of the duty of the court to enforce the observance of the dictates of morality."<sup>9</sup> The court will not, therefore, interfere if the defendant has an abstract right to do what he has done, however opposed to one's moral sense.<sup>10</sup> *Wertheimer v. Stewart, Cooper & Co.*,<sup>11</sup> is an illustrative case. The plaintiff who had devised a novel scheme of advertising the sale of his garden seeds complained that the defendant had issued advertisement in a similar form. It was held that the defendant was justified in doing so, and that he had done nothing which could injure any property right of the plaintiff. Kekewich, J., characterised it as "an unwarrantable attempt to restrain rivalry in trade, and is far and beyond what has been done in any case." Similarly, in *Plotzker v. Lucas*<sup>12</sup> it was held that the use by the defendant of the same descriptive name "Irish linen Company" and of shop dressing of a similar character, were not, in the circumstances, calculated to deceive. The Lord Ordinary observed: "Even if the respondent believed that custom could be attracted by a shop of the particular design which had attracted custom in Glasgow I do not think he would be doing anything illegitimate in

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(6) *Bass, Batokiff & Gretton Ltd's.* (No. 2) Trade Marks (1902) 2 Ch. 579; 19 B.P.C. 529 at p. 544 (C.A.). See also *Goodfellow v. Prince*, 35 Ch.D. 9; *Bodega Co., Ltd. and Riviere v. Owens*, 6 R.P.C. 236; *Levy v. Walker*, Seb. Dig. p. 392.

(7) In *Browne v. Freeman*, (No. 1), 12 W.R. 305 (1864), where the plaintiff sold a secret medicine called 'Chlorodyne' and defendant advertised a medicine of his own manufacture as 'the original Chlorodyne,' injunction was not allowed as the evidence showed that the defendant's article was not mistaken for plaintiff's, but only that the defendant was mistaken to be the first inventor.

(8) *Havana Cigar and Tobacco Factories, Ltd. v. Oddenino*, (1923) 2 Ch. 243; 40 R.P.C. 229. See also Lord Halsbury's observations in *Reddaway v. Banham*, 12 R.P.C. 83; (1896) A.C. 199; 13 R.P.C. 218 H.L.

(9) *Per Wood, V.C. in Batty v. Hill*, 1 H. & M. 264.

(10) *Braham v. Bustard*, 1 H. & M. 447.

(11) 23 R.P.C. 481.

(12) 24 R.P.C. 551.

employing the same means, provided it was only to attract custom and not to divert customers from the complainers.”

The rule is, that there is no monopoly in a name or pictorial representation as such, but a person will not be allowed to imitate the name or mark appropriated by another in such a manner as to be calculated to deceive the public with regard to the goods on which the mark is applied. Thus, in *Johnston v. Orr-Ewing*,<sup>13</sup> Lord Blackburn said, “Counsel argued that the plaintiffs had no monopoly of elephants, and that their clients had a right to use them. So they had, unless they used them so as to mislead, or at least, to be likely to mislead purchasers as to whose the goods were.” And, in a trade name case<sup>14</sup> Farwell, J., observed: “As I understand the law, mere resemblance of the name would not necessarily be sufficient to entitle the plaintiff company to relief, if the scope of the operations carried on by the two companies was so entirely different, that there was no real danger of confusion.” But the mere fact of imitation, taken in conjunction with the surrounding circumstances, may sometimes be itself some evidence of fraud.<sup>15</sup>

**Probability of damage to plaintiff must be shown.**—“A passing-off action is one in which the plaintiff alleges that the defendant is injuring him in his property by wrongfully intercepting trade which but for the defendant’s wrongful acts, would come to the plaintiff in his business.”<sup>16</sup> “Damage or likelihood of damage to property is the gist of all such actions, and unless a plaintiff can prove that his credit or business reputation has suffered damage or that there is a tangible risk or probability of his credit or business reputation suffering damage no action will lie.”<sup>17</sup> There must, therefore, be a possibility of competition and

(13) 7 App. Cas. 551.

(14) *Woolworth & Co., Ltd. v. Woolworths (Australasia), Ltd.*, 47 R.P.C. at p. 344. See also *Society of Motor Manufacturers and Traders, Ltd. v. Motor Manufacturers’ and Traders’ Mutual Insurance Co., Ltd.*, 42 R.P.C. 307.

(15) *Edge v. Johnson*, 9 R.P.C. 134; *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, 13 R.P.C. 235; *Reddaway v. Banham*, 13 R.P.C. 230; *Chetarpal Sharma v. Jagannath Das*, A.I.R. 1922 All. 178; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, 1931 Mad. 461.

(16) *Dental Manufacturing Co., Ltd. v. de Trey & Co.*, 29 R.P.C. 617, Buckley, L.J.

(17) *Society of Motor Manufacturers and Traders, Ltd. v. Motor Manufacturers’ and Traders’ Mutual Insurance Co., Ltd.*, 42 R.P.C. at p. 314, Per Lawrence J. The rule was stated in substantially similar language by Farwell, J., “Damage or the tangible possibility of damage in the future is



consequent loss of custom to the plaintiff's business on account of the defendant's act. In *Woolworth & Co., Ltd. v. Woolworths (Australasia), Ltd.*,<sup>18</sup> Farwell, J., observed: "I must satisfy myself before I can give the plaintiff company relief that there is a serious risk of some confusion and that the plaintiff company will suffer, or may suffer, as the result of such confusion." Unless this test is satisfied an action will not be maintainable. It has, consequently, been held, for instance, that a non-trader may have no cause of action<sup>19</sup> and that a plaintiff may be nonsuited, if he fails to aver in his declaration his trading interest.<sup>20</sup> Again, a mere similarity between two private addresses does not constitute an actionable wrong.<sup>21</sup>

**The risk of possible damage should not be too remote.**—Thus in the *Merchant Banking Co., of London, Ltd. v. The Merchants' Joint Stock Bank*,<sup>22</sup> injunction was refused on the ground that there was no likelihood of injury to the plaintiff's business, as the two banks were located at a considerable distance apart. In the *Society of Motor Manufacturers and Traders, Ltd. v. Motor Manufacturers' and Traders' Mutual Insurance Co., Ltd.*,<sup>23</sup> the plaintiff company was formed with the principal objects of encouraging and protecting the motor trade generally, while the defendant company was incorporated for the purpose of carrying on insurance against damage caused to vehicles. The motion to restrain the defendant company from trading under their name was dismissed and the decision was affirmed on appeal.

of the essence of an action of this kind, and without the evidence of damage, or without the facts being such that the court can rightly infer the real possibility of damage in the future, there can be no cause of action at all." *British Legion v. British Legion Club, (Street), Ltd.*, 48 R.P.C. at p. 563; See also *British Medical Association v. Marsh*, 48 R.P.C. 565; *The Clock, Ltd. v. The Clock House, Ltd.*, 52 R.P.C. 386.

(18) 47 R.P.C. at p. 344. See also the observations of Lord Low quoted by Lord James in *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co.*, 24 R.P.C. at p. 581.

(19) *Delondre v. Shaw*, Seb. Dig., p. 21. (1828) 57 E.R. 777; 2 Sim 237.

(20) *Lawson v. The Bank of London*, Seb. Dig., p. 77; 139 E.R. 1296.

(21) *Street v. Union Bank of Spain and England*, (1885) 30 Ch.D. 156. (similar telegraphic address); *Day v. Brownrigg* (1878) 10 Ch.D. 294, Seb. Dig., p. 387 (Ashford Lodge); See also judgment of Farwell, J., in *The Clock, Ltd. v. The Clock House Hotel, Ltd.*, 52 R.P.C. at pp. 392, 393.

(22) 9 Ch.D. 560; 47 L.J.Ch. 828.

(23) 42 R.P.C. 307. See also *Ormond Engineering Co., Ltd. v. Knopf*, 49 R.P.C. 634; *The Corporation of the Hall of Arts and Sciences (known as the Albert Hall) v. Albert Edward Hall*, 51 R.P.C. 398.

And, in *Attorney General v. Barrett Proprietors, Ltd.*<sup>24</sup> the publishers of the British Pharmacopoeia sought to restrain the defendants from using the letters "B.P." upon or in connection with medicinal and pharmaceutical preparations which were not made according to the British Pharmacopoeia. It was alleged that the use of the letters "B.P." by the defendants on such preparations would result in the failure of the British Pharmacopoeia to be maintained as a standard, and that this failure would involve the plaintiffs in financial loss. Injunction was, however, refused.

Where a doctor complains that some quack medicines are sold as his medicines or as medicines recommended by him, it is thus not enough to show that there has been misrepresentation. In order to succeed in the action he will have further to show that the defendant's act had already caused him pecuniary injury in his profession or is likely to do so. In the well known case *Clark v. Freeman*<sup>25</sup> the plaintiff Sir James Clark, an eminent physician failed to get an injunction to restrain the defendant from selling certain pills described as or purporting to be those of the plaintiff. The decision in this case by Lord Langdale, M. R., has been much discussed.<sup>1</sup> The judgment of the learned Master of the Rolls has been carefully considered recently by Maugham, J., in *British Medical Association v. Marsh*,<sup>2</sup> where his Lordship points out that Lord Langdale's judgment clearly shows, that the reason for the refusal of the injunction in that case was due to the fact that the plaintiff had not shown that he sustained any pecuniary injury or loss of reputation.

**Damage arising from infringing the rights of a third party not actionable.**—Mere damage is obviously not sufficient to support the action. The damage must be attributable to the passing off of other goods as the plaintiff's goods.<sup>3</sup> So, a person is not entitled to an action to restrain a defendant from passing off goods as the goods of a third party. He can bring the action only when the representation is that the goods are his goods. The reason is obvious.

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(24) 50 R.P.C. 45.

(25) 11 Beav. 112; See also *Dockrell v. Doughall* (1887), 80 L.T. 556 where injunction was refused on similar grounds.

(1) See for instance *Williams v. Hodge & Co.*, 4 T.L.R. 175 (1887); *Lee v. Gibbings*, 67 L.T. 263 (1892).

(2) 48 R.P.C. at pp. 572, 573.

(3) Although there is damage to the plaintiff there may be no passing off, see for instance, *Browne v. Freeman*, (No. 1), Seb. Dig. p. 134; *Imperial Tobacco Co. v. Bonnan*, A.I.R. 1924 P.C. 187; *Dental Manufacturing Co., Ltd. v. de Trey & Co.*, 29 R.P.C. 617; *Heiniger v. Dros*, 25 Bom. 433.

The basis of the action is not that the defendant's act constitutes a fraud on the public.<sup>4</sup> "The fraud upon the public is no ground for the plaintiff's coming into the court," declared Lord Chancellor Thurlow, in an early case.<sup>5</sup> "A mere lie on the part of the defendants does not give the plaintiffs any cause of action."<sup>6</sup> The false representation must be an infringement of a right vested in the plaintiff.<sup>7</sup> So in the early case of *Browne v. Freeman*<sup>8</sup> injunction was refused on the ground that the evidence showed that the defendant's article was not mistaken for the plaintiff's, but only, that the defendant was wrongly taken by the public to be the first inventor of the medicine 'Chlorodyne'. For, in an action for passing off the plaintiff is not suing on behalf of the public, but on his own behalf, on the ground that the defendant's conduct would result in injury to the plaintiff's private right.<sup>9</sup> As Lord Justice James said in *Levy v. Walker*,<sup>10</sup> "The Court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion by somebody else. It does not interfere to prevent the world outside from being misled into anything."

**Use may be fraudulent though the description is true.**—In certain circumstances a statement though literally true may still constitute a misrepresentation under the law. In *Brinsmead & Sons, Ltd. v. Brinsmead*<sup>11</sup> Lord Justice Buckley said:—"The law, as I understand it, is this: If a man makes a statement which is true, but which carries with it a false representation and induces the belief that his goods are the plaintiff's goods, he will be restrained by injunction. He cannot rely on the fact that his statement is literally and accurately true, if, notwithstanding its truth, it carries with it a false representation." "If the thing is capable of being understood in a wrong sense and is understood in a wrong sense, then the defendant would be restrained even if he had not a bad intention."<sup>12</sup> The test is whether the result of the user of

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(4) *Native Guano Co. v. Sewage Manure Co.*, 8 R.P.C. 125.

(5) *Webster v. Webster*, Seb. Dig. p. 4; 3 Swanst. 490 (1791).

(6) *Ormond Engineering Co., Ltd. v. Knopf*, 49 R.P.C. 634, (Clauson, J.).

(7) *Batty v. Hill* (1863) 1 H. & M. 264.

(8) (1864) 12 W.R. 305; Seb. Dig., p. 134.

(9) *Grezier and Doyle v. Autran*, 13 R.P.C. 1.

(10) 10 Ch.D. 436.

(11) 30 R.P.C. 493.

(12) *Brinsmead & Sons, Ltd. v. Brinsmead*, 30 R.P.C. p. 510, per Buckley, L. J.

the mark is to enable the defendant to pass off his goods as the goods of the plaintiff, and whether there is any duplicity in the use of the marks, irrespective of the question of fraudulent intention. If the answer is in the affirmative, it is then no defence to say that the defendant is simply telling the truth as to the way or the place in which the goods are made, or as to materials of which they are composed, and that he cannot be held liable for the mistake which the public may make.

A few well known cases illustrating this principle may be considered. In *The Glenfield Starch case*,<sup>13</sup> for instance, the plaintiffs, who were manufacturers of "Glenfield Starch" originally carried on business at Glenfield, a small village, and afterwards moved to another place. The defendant obtained possession of a small plot of land at Glenfield, and began to sell starch manufactured there in packets marked with the word "Glenfield". Injunction was granted restraining the defendant from using the word 'Glenfield' in a manner calculated to deceive the public. Lord Westbury pointed out that the term 'Glenfield' had acquired in the trade a secondary signification different from the primary one and observed: "I have no doubt that this case comes within the principle on which the jurisdiction is founded—the principle being to prevent a party from fraudulently availing himself of the trade mark of another which had already obtained currency and value in the market by whatever means he may devise for the purpose, provided the means are devised in order to give him a colourable title to the use of the word, and provided it be shown from the manner in which he has employed those means that his object was from the beginning to invade the property of the appellants." *Montgomery v. Thompson*<sup>14</sup> was a very similar case. The plaintiffs and their predecessors carried on business as brewers at Stone, a small town, for over hundred years and their ales were known to the public as 'Stone ales'. The defendant erected a brewery at Stone and began to sell ales brewed there as 'Stone ale'. Injunction was granted. In the '*Camel Hair belting*' case<sup>15</sup> it was contended that the defendant's belting was actually made of camel hair, and that he had an inherent right to describe how he made the goods, and

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(13) *Wotherspoon v. Currie*, L.R. 5, H.L. 508; 42 L.J.Ch. 130. See also *Seizo v. Proveende*, L.R. 1 Ch. 192; *Grand Hotel Co., of Caledonia Springs Ltd. v. Wilson*, 21 R.P.C. 117.

(14) 8 R.P.C. 361.

(15) *Reddaway v. Banham*, 13 R.P.C. 218; 1896 A.C. 199. See also *Reddaway v. Smidt*, 9 C.W.N. 281; and *Iron-Ox Remedy Co., Ltd., v. Co-operative Whole-sale Society, Ltd.*, 24 R.P.C. 425.

if, in so doing, he took away the profits of a man who had for his own purpose given that simple description a secondary meaning, that man was not entitled to relief. This argument was however, rejected by the House of Lords. Lord Herschell said in his famous judgment: "I rather demur, however, to the statement of Lord Justice James that the defendant in *Wotherspoon v. Currie* was not telling a lie in calling his starch 'Glenfield starch', as I do to the view that the defendants in this case were telling the simple truth when they sold their belting as camel hair belting. I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification differing from its primary one, and that if it is used to persons in the trade who will understand it, and be known and intended to understand it in its secondary sense, it will none the less be a falsehood because in its primary sense it may be true. A man who uses language which will convey to persons reading or hearing it a particular idea which is false, and who knows and intends this to be the case, is surely not to be absolved from a charge of falsehood, because, in another sense, which will not be conveyed and is not intended to be conveyed, it is true." Lord Macnaghten also used similar language. "Can it be said that the description 'camel hair belting' as used by Banham is the simple truth? I will not call it an abuse of language to say so, but certainly it is not altogether a happy expression. The whole merit of that description, its one virtue for Banham's purposes, lies in its duplicity. It means two things. At Banham's works where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel hair; abroad, to the German manufacturer, to the Bombay mill-owner, to the up-country native it must mean Reddaway's belting; it can mean nothing else. I venture to think that a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it, it is not sterling coin; it has no right to the genuine stamp and impress of truth."

A further illustration of the above rule is to be found in the case of *Gillette Safety Razor Co. v. Franks*.<sup>16</sup> The defendants put in plaintiffs' envelopes used and unusable Gillette safety razor blades thrown away by people after use, covered them up with waxed paper and advertised them for sale as genuine, U. S. A. Gillette blades. Injunction was granted.

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(16) 41 B.P.C. 499. See also *Spalding & Bros. v. Gamage Ltd.*, ('Orb' balls), 30 B.P.C. 388; 31 B.P.C. 125; 32 B.P.C. 278.

**Injunction not granted where there is no probability of deception.**—The court must be satisfied in every case that the defendant's conduct is calculated to cause such deception in the minds of the probable customers as would be likely to lead them into purchasing his goods believing them to be the goods of the plaintiff or cause them to believe that his business is the same or is closely connected with the plaintiff's business. As was said by Lord Macnaghten in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*,<sup>17</sup> "when a person comes forward to restrain a colourable imitation of this sort in a case like this and when he cannot prove that the defendants have tried to steal his trade, he has to make out beyond all question that the goods are so got up as to be calculated to deceive." It will not do for the plaintiff to say, "We were frightened by what might happen and therefore you must stop the thing *in limine*."<sup>18</sup> There must therefore be "an irresistible inference of fact"<sup>19</sup> that the defendant's mark is such a colourable imitation of the plaintiff's that the intervention of the Court is necessary to prevent probability of deception of the public. Otherwise, an injunction will not be granted.<sup>20</sup> "In all cases in

(17) 17 R.P.C. 628 (H.L.); 1901 A.C. 308.

(18) Loc. cit. at p. 634.

(19) *Goodwin v. Ivory Soap Co.*, 18 R.P.C. at p. 392, Romer, L.J.

(20) *Browne v. Freeman*, Seb. Dig., p. 134; *Ainsworth v. Walsmsley*, (1866) L.R. 1 Eq. 518; *Blackwell v. Crabb*, 36 L.J.Ch. 504; *Bradbury v. Beeton*, 39 L.J.Ch. 57; *Cope v. Evans*, L.R. 18 Eq. 138; *Borthwick v. The Evening Post, Ltd.*, 57 L.J.Ch. 406; *Massam v. Thorley's Cattle Food Co.*, 6 Ch.D. 574; *Condy v. Mitchell*, 37 L.T. (N.S.) 268, 766; *Parsons Bros. & Co. v. John Gillespie & Co.*, (1898) A.C. 239; *Beddow & Sons v. Boyd*, 4 R.P.C. 310; *Bodega Co. (Limited) and Riviere v. Owens*, 6 R.P.C. 236; *Great Tower Street Tea Co. v. Smith*, 6 R.P.C. 165; *Lrahy, Kelly & Leahy v. Glover*, 10 R.P.C. 141; *California Fig Syrup Co. v. Taylor's Drug Co., Ltd.*, 14 R.P.C. 564; *Clark v. Sharp*, 15 R.P.C. 141; *Lever Bros. Ltd. v. Beddingfield*, 16 R.P.C. 3; *Coleman & Co., Ltd. v. Brown (John) & Co.*, 16 R.P.C. 619; *Alaska Packers' Association v. Crooks & Co.*, 18 R.P.C. 129; *Goodwin v. Ivory Soap Co.*, 18 R.P.C. 389; *London General Omnibus Co. v. Lavell*, 18 R.P.C. 74; *Aerators, Ltd. v. Tollit and others*, 19 R.P.C. 418; *Carr & Sons v. Crisp & Co., Ltd.*, 19 R.P.C. 497; *Army & Navy Co-operative Society, Ltd. v. Army, Navy and Civil Service Co-operative Society of South Africa Ltd.*, 19 R.P.C. 574; *Star Cycle Co., Ltd. v. Frankenburgs*, 23 R.P.C. 337, 24 R.P.C. 46; *Apollinaris Co., Ltd. v. Duckworth & Co.*, 23 R.P.C. 540; *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 24 R.P.C. 572; *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, 24 R.P.C. 641; *Hennessy & Co. v. Keating*, 25 R.P.C. 125; *St. Mungo Manufacturing Co. v. Viper & Recovering Co.*, 27 R.P.C. 420; *Hopton Wood Stone Firms Ltd. v. Gething*, 27 R.P.C. 605; *Jewsbury & Brown v. Andrew & Atkinson & Ormerod Brothers*, 28 R.P.C. 293; *Coleman & Co., Ltd. v. Stephen Smith & Co.*, 29 R.P.C. 81; *Perry & Co. v. T. Hessin & Co.*, 29 R.P.C. 101, 509; *Ridgway Company v. Amalgamated Press, Ltd.*, 29 R.P.C. 130; *De Long Hook and Eye Co. v. Newey Bros., Ltd.*, 29 R.P.C. 49; *Schwerdtfeger, & Co.*

which one trader seeks an injunction to restrain another trader from using, as attached to goods, a name which the plaintiff trader insists on as his own, he is bound to prove not, perhaps, logically first, or even first in point of time—but he is bound to prove early in his case that the name used by the defendant is either actually the same as that used by him, the plaintiff, or bears so close a resemblance to it that it is calculated to deceive the public, and make purchasers of the goods in question believe that they are purchasing the goods of the plaintiff when they are in fact purchasing the goods of the defendant.”<sup>21</sup> The rule was stated by Parker, J., thus: “If the use of a word or name can be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured or is calculated to injure another in his trade or business. . . . Whatever be the nature of the history of the word or name, in whatever way it has been used, either by the person seeking the injunction or by others it is necessary where there has been no actual deception to establish at least a reasonable probability of deception. In such cases the action is, in effect, a *quia timet* action, and unless such reasonable probability be established, the proper course is in my opinion, to refuse an injunction, leaving the plaintiff to his remedy if cases of actual deception afterwards occur.”<sup>22</sup>

Even in cases where the defendant had deliberately copied the plaintiff's mark an injunction may not be granted if the court is satisfied that there is no likelihood of deception of an average purchaser using average caution.<sup>23</sup> In *Schweppes Ltd. v. Gibbens*,<sup>24</sup> Lord Justice Romer said: “Even if I could assume as against the defendant in this case a fraudulent intent in the design which she may have put on her label, that would not carry me the full length.

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*v. Hart Publishing Co., Ltd.*, 29 R.P.C. 236; *Jones Bros., Ltd. v. Anglo-American Optical Co.*, 29 R.P.C. 1, 361; *Goodall (Charles) & Son., Ltd. v. John Waddington, Ltd.*, 41 R.P.C. 465, 658; *Ardath Tobacco Co., Ltd. v. Sandorides Ltd.*, 42 R.P.C. 50; *Society of Motor Manufacturers and Traders Ltd. v. Motor Manufacturers' and Traders' Mutual Insurance Co., Ltd.*, 42 R.P.C. 307, 314; *Lines Bros., Ltd. v. Farris & Co.*, 43 R.P.C. 64; *Smith's Potato Crisps Ltd. v. Paige's Potato Crisps, Ltd.*, 45 R.P.C. 36, 132; *Hampshire & Co. (1927), Ltd. v. General Kaputine Syndicate, Ltd.*, 47 R.P.C. 427; *Houghton & others v. Film Booking Offices, Ltd.*, 48 R.P.C. 329; *The Attorney General v. Barrett Proprietories, Ltd.*, 50 R.P.C. 45; *Mohamed Noordin v. Abdul Kareem & Co.*, A.I.B. 1931 P.C. 272.

(21) *Goodwin v. Ivory Soap Co.*, 18 R.P.C. 389, Kekewich, J.

(22) *Burberrys v. J. C. Cording & Co.*, 26 R.P.C. 693.

(23) *Lever Bros., Ltd. v. Bedingsfield*, 16 R.P.C. 3.

(24) 22 R.P.C. 113, 601 (H.L.). See also *Smith's Potato Crisps Ltd. v. Paige's Potato Crisps, Ltd.*, 45 R.P.C. 132.

In order to make the defendant liable I should be obliged to come to the conclusion as a matter of fact, that the label she has designed is calculated to mislead." Evidence of actual deception though of material value may not be conclusive and injunction may not be granted, notwithstanding the fact that some persons had been actually deceived by the defendant's mark.<sup>25</sup> For, the persons so deceived may have been too credulous, careless or foolish, or the alleged resemblance may be common to the trade. In *Dimech (William) v. Goffredo Alessandro Chretien*<sup>1</sup> the Privy Council observed: "The oral evidence in the action. . . . proves nothing beyond the possibility of occasional mis-deliveries caused either by post office blunders or by the carelessness of the customers. It falls a very long distance short of establishing inevitable deception by reason of the defendant continuing the use of their firm name."

Where the "supposed consequence is too remote, speculative, or improbable to be imputed to the defendant,"<sup>2</sup> the court will not interfere with the course of the defendant's business. Thus, in *National Starch Manufacturing Co. v. Munn's Patent Maizena and Starch Co.*,<sup>3</sup> the defendants stated that "of all competing corn flours, Maizena alone received a prize medal at the London Exhibition, 1862," when, as a matter of fact, it was only the plaintiff's maizena which received the medal. Injunction was refused on the ground that the defendant's act was not calculated to deceive, the word 'Maizena' having become *publici juris*. Again, in *Cambridge University Press v. University Tutorial Press*<sup>4</sup> the plaintiffs, whose

(25) See, for instance, *Civil Service Supply Association v. Dean*, 13 Ch.D. 512, where Malins, V. C., disregarding the testimony of the lady who had been actually deceived by the defendant's mark, said that looking at the two marks probability of deception was impossible. See also *Fitchell's Ld. v. Loubet & Co., Ld.*, 36 R.P.C. 296; *Smith's Potato Crisps Ld. v. Paige's Potato Crisps, Ld.*, 45 R.P.C. 36, 132; *Mathieson v. Sir Isaac Pitman & Sons, Ld.*, 47 R.P.C. 541; *Houghton v. Film Booking Offices*, 48 R.P.C. 329; *Tallerman v. Dowling Radiant Heat Co.*, (1900) 1 Ch. 1; 69 L.J.Ch. 46.

(1) A.I.R. 1931 P.C. 15.

(2) Lord Selborne in *Singer Manufacturing Co. v. Loog*, 8 App. Ca. 15

(3) 11 R.P.C. 281. In *Tallerman v. Dowling*, (1900) 1 Ch. 1; 69 L.J.Ch. 46, the plaintiff had invented a system of treating diseases by hot air; the defendant, an inventor of a rival system of hot air treatment, circulated among the patients of the plaintiff a pamphlet containing extracts from an article in a medical paper containing a favourable account of the plaintiff's system. The extracts omitted references to the plaintiff's name and were so made as to appear that the article related to the defendant's system of treatment. Some persons had thus been actually deceived, but there was no evidence of damage. Interlocutory injunction was refused as there was no attempt to pass off the defendant's system as the plaintiff's.

(4) 45 R.P.C. 335.



book of "Hazlitt's Selected Essays" had been prescribed for an examination, complained that the defendants had misled the public into believing that their book of Hazlitt's Essays had been prescribed for that examination; the action was dismissed, but without costs.

Where on default in pleading an injunction is granted in general terms, and not in respect of any specific thing, the plaintiff, on a motion to commit, must satisfy the court that the alleged breach of the injunction by the defendant will result in probability of deception of the public.<sup>5</sup>

The question what resemblance constitutes colourable imitation and the modes of comparison adopted have been considered in detail in later sections. In considering whether the resemblance is calculated to deceive the difference in the class of goods on which the two marks are applied, will be a material factor. For instance, a mark which has been used by the plaintiff on boot polish is not likely to cause confusion when used by the defendant on rubber heels,<sup>6</sup> or a mark for shampoo powder with a similar mark for hair tonics.<sup>7</sup> As the Privy Council said in *Somerville v. Schembri*,<sup>8</sup> the use of a particular trade mark by others for hats, soaps, pickles, etc., could not impede the acquisition of an exclusive right to it as a trade mark for cigarettes. Again, as already pointed out, where two marks have been in existence side by side for several years and no case of actual deception had occurred, the court will be reluctant to grant an injunction notwithstanding the alleged similarities between the two marks.<sup>9</sup>

**English Law followed in the Indian courts.**—The courts in India have closely followed the English law as discussed in the preceding sections. Even from early times it was recognised that a plaintiff was entitled to relief though no fraudulent intent on the part of the defendant was proved. In *Graham & Co. v. Kerr*

(5) *Ripley v. Arthur & Co.*, 19 R.P.C. 443.

(6) *Nugget Polish Co., Ltd. v. Harboro Rubber Co.*, 29 R.P.C. 133.

(7) *Tokalon, Ltd. v. Davidson & Co.*, 31 R.P.C. 74. See also *Turner's Motor Manufacturing Co., Ltd. v. Miesse Petrol Car Syndicate, Ltd.*, 24 R.P.C. 531; *Wilson's and Mathieson's Ltd. v. Meynell & Sons, Ltd.*, 46 R.P.C. 80.

(8) 4 R.P.C. 179; (1887) 12 App. Ca. 453; 56 L.T. 454.

(9) *Marquis of Londonderry v. Russell*, 3 T.L.R. 360; *Ford v. Foster*, L.R. 7 Ch. 611; *Rodgers v. Rodgers*, 31 L.T.N.S. 285 (1874); *Christiansen's Tm.*, 3 R.P.C. 54; *Lambert's Trade Mark*, 6 R.P.C. 344; *Baker v. Rawson*, 8 R.P.C. 89; *Talbot's Tm.* 11 R.P.C. 77; *London General Omnibus Co. v. Lavell*, 18 R.P.C. 74; *Cropper Minerva Machines Co., Ltd. v. Cropper, Charlton & Co., Ltd.*, 23 R.P.C. 388.

*Dodds & Co.*,<sup>10</sup> which was decided as early as 1869 Mr. Justice Phear, observed: "It is not enough to say that there was no fraudulent intention. That is no reason why an injunction should not be granted. I do not think I have any option if the marks which the defendants have used are those of the plaintiffs; no matter what their intention was a perpetual injunction would be granted. In the meantime an interlocutory injunction must issue. There is obviously a close imitation." In *Sassoon v. Mills*<sup>11</sup> the court said that to entitle the owner of a trade mark to redress, although fraud was necessary, the fraud need not necessarily consist in an intention to deceive on the part of the defendants, but in an actual deception or in the creation of a probability of deception, independently of any fraudulent intention.<sup>12</sup> In *John Smidt v. Reddaway & Co.*,<sup>13</sup> the court observed: "It is said that there is no evidence that any one has been deceived; but this is not essential. The question is whether the manner in which the defen-

(10) (1869) 3 Beng.L.R. App. 4; *Balfour & Co. v. Kiburn & Co.*, 1 Hyde 270; *Orr Ewing & Co. v. Grant, Smith & Co.*, 1 Bom.L.R. 291; *Lavergne v. Hooper*, 8 Mad. 149; *Smidt v. Reddaway & Co.*, 9 C.W.N. 281; *Munnalal Serowjee v. Jawala Prasad*, 35 Cal. 311; *Imperial Tobacco Co. v. Albert Bonnan and Bonnan & Co.*, A.I.R. 1924 P.C. 187; *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, A.I.R. 1925 Cal. 220; *Lakhan Chandra Basak v. Emperor*, A.I.R. 1925 Cal. 149.

(11) 1 Bom.L.R. 291.

(12) *Badische Aniline and Soda Fabrik v. Maneckji Shapurji Katrak*, 17 Bom. 584; *Abdul Salam v. Hamidullah*, 15 I.C. 116; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931, Mad. 461; *Byramjee Cowasjee v. Vera Sombhai Motibhai*, 36 I.C. 965; *Kheshtupal Sharma v. Pancham Singh*, 37 All. 446; *Balladin and Alladin Firm v. Puranmul Balbehari Lall*, 30 I.C. 633; A.I.R. 1915 L.B. 123; *Lakhan Chandra Basak v. Emperor*, A.I.R. 1925 Cal. 149; *Madhavji Dharamsey Manufacturing Co., Ltd. v. Central India Spinning, Weaving and Manufacturing Co., Ltd.*, 41 Bom. 49; *Ebrahim Currim v. Essa Abba Sait*, 24 Mad. 163; *Nemi Chand v. Wallace*, 11 C.W.N. 537; *National Bank of India v. National Bank of Indore*, A.I.R. 1923 Bom. 119; *Moolji Sioca & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678; *Danish Dairies Milk Export v. Murlidhar & Co.*, A.I.R. 1932 Sind 84; *Morarji v. Madonji*, 5 Bom.L.R. 545; *Smidt v. Reddaway & Co.*, 9 C.W.N. 281; *Jamal Noor Mohamed Sait Co. v. Abdul Kareem & Co.*, A.I.R. 1934 Mad. 211; *Muniawami Mudaliar v. Bajagopala Mudaliar*, A.I.R. 1928 Mad. 759; *Mohideen Bawa v. Rigaud Perfume Manufacturers*, A.I.R. 1932 Rang. 114; *Abdulla Ally Mohamed v. Mohamed Ebrahim & Co.*, 157 I.C. 902; 8 P.R. 121.

(13) 9 C.W.N. 281. See also *Noorodeen Sahib v. Charles Souden*, 15 M.L.J. 45; *Balladin and Alladin Firm v. Puranmul Balbehari Lall*, A.I.R. 1915 L.B. 123; *Madhavji Dharamsey Manufacturing Co., Ltd. v. Central India Spinning, Weaving and Manufacturing Co., Ltd.*, A.I.R. 1916 Bom. 183; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461; *Jamal Noor Mohamed Sait Co. v. Abdul Kareem & Co.*, A.I.R. 1934 Mad. 211.

dants are advertising and selling their goods is calculated to deceive. No doubt the fact that no one has been actually deceived is an element in considering the question of the probability of deception; but it is not conclusive." And, in *Mohideen Bawa v. Rigaud Perfume Manufacturers*,<sup>14</sup> Page, C. J., and Cunliffe, J., said: "If the court is clearly of opinion from an examination of the two bottles with the get-up upon each of them that B-1 is a colourable imitation of A-1, the fact that no witnesses are called to prove that they were deluded into thinking that B-1 was A-1 is not of so much importance." Injunction will be refused in all cases where the court is satisfied that there is no probability of deception of the public by the mark complained of. "To constitute an infringement it is not enough to show a mere possibility of deception. There must be a reasonable probability of purchasers being deceived."<sup>15</sup> Probability of deception will generally be presumed in cases of fraud, but such presumption is rebuttable.<sup>16</sup>

#### Property right as the basis of action in trade mark cases.—

It was stated in an earlier section that the decision in *Millington v. Fox*,<sup>17</sup> effected a great change in the basis of relief in trade mark suits before the Court of Chancery, and that, thereafter, a right of property in trade marks was recognised by this court.<sup>18</sup> The doctrine that protection given to trade marks rests on property was first clearly enunciated in a series of judgments by Lord Chancellor Westbury. In the leading case *Hall v. Barrows*<sup>19</sup> the learned Lord Chancellor stated that the exclusive right in the use of a trade mark is property. "Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of pro-

(14) A.I.R. 1932 Rang. 114.

(15) *Barlow v. Gobindram*, 1 C.W.N. at p. 292, Sale, J.

(16) *Smidt v. Reddaway & Co.*, 9 C.W.N. 281 at p. 288. See also *Badische Aniline and Soda Fabrick v. Maneckji Shapurji Katrak*, 17 Bom. 584; *Muniswami Mudaliar v. Rajagopala Mudaliar*, A.I.R. 1928 Mad. 759; *Jamal Noor Mohamed Sait Co. v. Abdul Kareem & Co.*, A.I.R. 1934 Mad. 211; *Ebrahim Currim & Sons v. Abdulla Saheb*, A.I.R. 1934 Mad. 226.

(17) 3 My. & Cr. 338 (1838).

(18) In a few cases which followed *Millington v. Fox*, a property right in trade mark was denied, and it was stated that the jurisdiction of the Court of Chancery was still founded on fraud, though relief would be granted, irrespective of the fraudulent intent of the defendant. See, for instance, *Perry v. Truefitt*, 6 Beav. 66 (Lord Langdale); *McAndrew v. Bassett*, 33 L.J.Ch. 561 (Wood, V.C.).

(19) 4 De G. J. & S. 150. See also judgment of Sir John Romilly, M.R., in this case in the lower court, 32 L.J.Ch. 548.

perty; for there is no injury if the mark used by the defendant is not such as is mistaken or is likely to be mistaken, by the public for the mark of the plaintiff; but the true ground of this Court's jurisdiction is property." And in *The Leather Cloth Co. (Limited) v. The American Leather Cloth Co. (Limited)*,<sup>20</sup> he observed: "If the plaintiff has an exclusive right to use any particular mark or symbol, it becomes his property . . . and the act of the defendant is a violation of such right of property, corresponding with the piracy of copyright or the infringement of a patent. I cannot therefore assent to the dictum that there is no property in a trade mark. It is correct to say that there is no exclusive ownership of the symbols which constitute a trade mark, apart from the use or application of them; but the word 'trade mark' is the designation of these marks or symbols as and when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called 'property'. The true principle, therefore, would seem to be that the jurisdiction of the court in the protection given to trade marks rests upon property; and that the Court interferes by injunction, because that is the only mode by which property of this description can be effectually protected." And again, "Imposition on the public becomes the test of property in the trade mark having been invaded and injured, and not the ground on which the Court rests its jurisdiction." This view has now been generally accepted as the correct basis of relief in trade mark cases.<sup>21</sup>

**Theory of property right in passing-off actions.**—The doctrine of right of property in trade marks has been critically examined by

(20) 4 De G. J. & S. 137. See also *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (Lord Westbury); *Wotherspoon v. Currie*, L.R. 5 H.L. 508 (Lord Westbury).

(21) See *Clement v. Maddick*, 1 Giff. 98, "This is an application in support of the right to property" (Stuart, V.C.); *Barnett v. Leuchars*, Seb. Dig., p. 149; *Emperor of Austria v. Day and Kossuth*, 3 De G. F. & J. 217, "The jurisdiction of this court in a case of this nature rests upon the injury to property" (Turner, L.J.); *Singer Manufacturing Co. v. Wilson*, 3 A.C. 376; 2 Ch.D. 434, *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15; *Ainsworth v. Walsley*, (1866) L.R. 1 Eq. 518; *Borthwick v. The Evening Post, Ltd.*, (1889) 37 Ch.D. 449; *Powell v. Birmingham Vinegar Brewery Co., Ltd.*, 12 R.P.C. 496 (Stirling, J.). See also Holland's Jurisprudence, Halsbury's Laws of England, Kerr on Injunction, and Pomeroy's Treatise on Equitable Remedies. According to some authorities, however, property right exists only in case of registered trade marks, and an infringement of a common law mark cannot be regarded as a violation of a right in property; see *Bodega Co., Ltd., and Riviere v. Owens*, 6 R.P.C. 236; *Jamieson & Co. v. Jamieson*, 15 R.P.C. 169. See also Pollock, on Torts; Stephens, Commentaries on the Laws of England; Salmond, on Torts; Snell, on Equity.

Lord Herschell in the famous case *Reddaway v. Banham*<sup>22</sup> in the following passage: "The word 'property' has been sometimes applied to what has been termed a trade mark at common law. I doubt myself whether it is accurate to speak of there being property in such a trade mark, though no doubt, some of the rights which are incident to property may attach to it. Where the trade mark is a word or device never in use before, and meaningless, except as indicating by whom the goods in connection with which it is used were made, there could be no conceivable legitimate use of it by another person. His only object in employing it in connection with goods of his manufacture must be to deceive. In circumstances such as these the mere proof that the trade mark of one manufacturer had been thus appropriated by another would be enough to bring the case within the rule as laid down by Lord Kingsdown, and to entitle the person aggrieved to an injunction to restrain its use. In the case of a trade mark thus identified with a particular manufactory, the rights of a person whose trade mark it was, would not, it may be, differ substantially from those which would exist if it were, strictly speaking, his property. But there are other cases which would equally come within the rule that a man may not pass off his goods as those of his rival which are not of this simple character—cases where the mere use of the particular mark or device which had been employed by another manufacturer would not of itself necessarily indicate that the person who employed it was thereby inducing purchasers to believe that the goods he was selling were the goods of another manufacturer."

Lord Parker was also of the same opinion. After citing the above judgment his Lordship said in *Spalding & Bros. v. A. W. Gamage, Ltd.*<sup>23</sup> as follows: "Cases of misrepresentation by the use of a mark, or name or get-up do not exhaust all possible cases of misrepresentation. If A says falsely, 'These goods I am selling are B's goods,' there is no mark, name or get-up infringed unless it be B's name, and if he falsely says 'these are B's goods of a particular quality' where the goods are in fact B's goods, there is no name that is infringed at all. Further, it is extremely difficult to see how a man can be said to have property in descriptive words, such as 'Camel hair' in the case of *Reddaway v. Banham* (L.R. 1906 A.C. 199), where every trader is entitled to use the

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(22) 13 R.P.C. 218.

(23) 32 R.P.C. at p. 284. Cf. The Glenfield Starch case where Lord Westbury was of opinion that the plaintiff had acquired a right of property in the word 'Glenfield.' (*Wotherspoon v. Currie*, L.R. 5 H.L. 508).

words, provided only he uses them in such a way as not to be calculated to deceive. Even in the case of what are sometimes referred to as common law trade marks, the property, if any, of the so-called owner is in its nature transitory, and only exists so long as the mark is distinctive of his goods in the eyes of the public or a class of the public.”

**Property right consists in the goodwill of the business.**—The rights that are incident to property attach to a trade mark or trade name only where the mark or name represents the goodwill or business reputation of the person. So, in *Burberrys v. Cording & Co., Ltd.*,<sup>24</sup> Lord Parker said that “If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property but the property, to protect which it is granted, is not property in the word or name, but property in the trade or goodwill which will be injured by its use.” And, in *Spalding & Bros. v. Gamage, Ltd.*,<sup>25</sup> his Lordship observed: “There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing off actions. The more general opinion appears to be the right is a right of property. This view naturally demands an answer to the question, property in what? Some authorities say property in the mark, name or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in *Reddaway v. Banham* (L.R. 1906 A.C. 139) expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think, strong reasons for preferring the latter view.”

**View taken by the Indian courts.**—The doctrine of right of property in common law trade marks has been generally recognised by the courts in India. In *Orr-Ewing v. Grant, Smith & Co.*,<sup>1</sup> which is an early case, Levinge, J., referred to “the right of property” in a trade mark. In *Mohamed Ishaq v. Alif Khan*<sup>2</sup> the court definitely expressed the view that a trade mark is a species of property. And, in *Ganeshi Lal v. Anwar Khan Mahboob & Co.*,<sup>3</sup>

(24) 26 R.P.C. 693; 100 L.T. 985; 25 T.L.R. 176.

(25) 32 R.P.C. at p. 284.

(1) 2 Hyde. 185.

(2) 98 P.L.R. 1902; 55 P.R. 1902. See also *Moolji Sicca & Co. v. Ramjan Ali*, A.I.R. 1930, Cal. 678; *The British American Tobacco Co., Ltd. Mahboob Buksh*, 15 C.W.N. 280.

(3) A.I.R. 1933 All. 495. See also *Ebrahim Currim v. Ess Abba*

Niamatullah, J., said: "there can be no doubt that the monopoly enjoyed by the proprietor of a trade mark is 'right of property' in view of the gain which accrues from the use of it." The subject was considered in detail by Tarporewala, J., in *Von Wulff v. Jivandas & Co.*<sup>4</sup> After discussing the evolution of the law of trade marks in England and stating that at common law a trade mark was recognised as a species of property by the Court of Equity long before the Registration Act, the learned Judge said that the right in a trade mark in India was a right to industrial property coming under the conventions of Paris and Berne, though there is no legislation for the registration of trade marks in this country.

**Plaintiff's title to the mark, name or get-up must be proved.—**

In every passing-off case the plaintiff must show that he has the right of prior user in the mark alleged to be infringed. In other words, the onus of establishing that he has the exclusive title to the mark is cast upon the plaintiff. "The foundation of a passing off case," said Lord Herschell in the "Two D case,"<sup>5</sup> "is that the

*Sait*, 24 Mad. 163. *Imperial Tobacco Co. v. Bonnan*, A.I.R. 1924 Cal. 216. Cf. *Gasper & Co. v. Leong Chey & Co.*, A.I.R. 1934 Rang. 297, where Leach, J., said: "The plaintiff in a passing off action has to show that the act of the defendant complained of is calculated to lead to the passing off of the defendant's goods for those of the plaintiff, and it does not depend on whether the latter has acquired any right of property in the device under which he sells his goods."

(4) 50 Bom. 402; A.I.R. 1926 Bom. 200.

(5) *Leahy, Kelly and Leahy v. Glover*, 10 R.P.C. at p. 155. "What is it necessary for a trader who is plaintiff in a passing off action to establish? It seems to me that in the first place he must, in order to succeed, establish that he has selected a peculiar—a novel—design as a distinguishing feature of his goods, and that his goods are known in the market, and have acquired a reputation in the market, by reason of that distinguishing feature, and that unless he establishes that, the very foundation of his case fails." *Williams Co. v. Bronnley & Co., Ltd.*, 26 R.P.C. at p. 771 (Cozens-Hardy, M. R.). "The essence of the action is that you must prove that there is a distinctive get-up, which has acquired that secondary meaning in the eyes of the public," (Fletcher-Moulton, L. J.) loc. cit. "In a passing-off case it is incumbent upon the plaintiffs in the first instance to prove that the goods sold under their label and get-up were goods which had a reputation in the market as being goods manufactured and sold by them of which the label and get-up were distinctive and well known in the market," *Mohideen Bawa v. Rigaud Perfume Manufacturers*, A.I.R. 1932 Rang. 114 (Page, C. J., and Cunliffe, J.). See also, *Goodfellow v. Prince*, 35 Ch.D. 9; *Jamieson & Co. v. Jamieson*, 15 R.P.C. 169; *Fels v. Christopher Thomas & Bros., Ltd.*, 21 R.P.C. 85; *Imperial Tobacco Co. (of Great Britain and Ireland) Ltd. v. Purnell & Co.*, 21 R.P.C. 598; *De Long Hook and Eye Co. v. Newey Bros., Ltd.*, 29 R.P.C. 49; *Noorodeen Sahib v. Charles Souden*, 15 M.L.J. 45; *Barlow v. Gobindram*, 24 Cal. 364; *Munna Lal Serowjee v. Jawala Prasad*, 35 Cal. 411; *Vadilal Sakalchand v. Burditt & Co.*, 30 Bom.

party alleging it should prove in the first instance that any name which he claims as his trade name has been so extensively used in connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name, that any one using that name would intend to refer to his goods, and that any one to whom the name was used would understand that his goods were referred to."

The conditions of prior user by which title to a trade mark is acquired under the common law have already been discussed in the last Chapter. Where the mark is *prima facie* non-distinctive the mere fact that a person was the first user will not entitle him to exclusive ownership.<sup>6</sup> He must show further, that the mark has acquired reputation in the market with his goods and has become so associated with them that the public identify these goods by this mark. No action will lie where the plaintiff fails to show that the reputation of the goods is associated with him.<sup>7</sup> So, where the plaintiff was the mortgagee of a business and its trade name but had never used nor intended to use the trade name the action was dismissed.<sup>8</sup>

Evidence of reputation of the mark must relate to the country where the alleged passing off occurs. Thus, in a case<sup>9</sup> where the plaintiff carrying on business as a confectioner in Paris, under the style of "Maison Boissier" complained that the defendant set-up business in England under a similar name, injunction was refused as the plaintiff had no agency in England. So also in *Venkata-chalam v. Rajagopala Naidu*<sup>10</sup> the action was dismissed as the term 'Madras curry powder' had not acquired secondary significance in England where the alleged passing off took place. Where, however, the name of a designer of dresses having business in Paris had acquired sufficient reputation in England by exhibiting them

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61; *Mahomed Esuf v. Rajaratnam Pillai*, 33 Mad. 402; *Mohamed Noordin v. Abdul Kareem & Co.*, A.I.R. 1931 P.C. 272; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461; *Dimech (William) v. Goffredo Alessandro Chretien*, A.I.R. 1931 P.C. 15; *Lotus Ld. v. Mt. Nasimunnassaba Begum*, A.I.R. 1934 Cal. 600.

(6) Title could not be established, notwithstanding first user, in *Payton & Co., Ld. v. Snelling, Lampard & Co., Ld.*, 17 R.P.C. 48, 628; *Williams & Co. v. Bronnley & Co., Ld.*, 26 R.P.C. 481; *White, Tomkins and Courage Ld. v. United Confectionery Co., Ld.*, 31 R.P.C. 430.

(7) *Imperial Tobacco Co. v. Bonnan*, 41 R.P.C. 441.

(8) *Beasley v. Soares*, 22 Ch.D. 660 (1882).

(9) *Robineau v. Charbonnel*, W.N. (1876) p. 160; Seb. Dig. p. 297.

(10) A.I.R. 1932 Mad. 705.



and selling them there by his agents it was held that an action was maintainable to restrain the defendant from using the plaintiff's trade name in England.<sup>11</sup> And in a case<sup>12</sup> where an English company had registered a name similar to that of a well known French firm of motor car manufacturers who had no place of business in England but whose goods had been sold in England injunction was granted restraining the defendants from using the name of the French firm.

The facts of reputation and deception may, in some cases, be inferred from the attendant circumstances; so in *Abdul Kareem Sahib v. Abdul Kareem Sahib*<sup>13</sup> the Court observed: "In cases like the present it seems legitimate to argue that, unless the imitated wrappers had become associated with the goods of a manufacturer of popular articles the defendant would not have undergone the trouble and incurred the risk of so sedulously imitating them." The extent of the sale is also an index to the reputation of the goods.<sup>14</sup>

**Right not affected by loss of title in a foreign country.**—As the sole question is whether the trade mark designates the goods of the plaintiff in the country where the passing off takes place, the plaintiff's right to the mark is not affected by loss of title in a foreign country. *Rey v. Lecouturier*<sup>15</sup> is a leading case on the point. The monks of the Grand Chartreuse Monastery were manufacturing by a secret process a liqueur known as "Chartreuse wine." The Monastery was confiscated by the French Government and sold by the liquidator to a French company who continued to manufacture liqueurs in the same distillery. The expelled monks went to Spain where they commenced to manufacture their 'Chartreuse wine.' It was held by the House of Lords that, as the reputation of the trade name in England continued to be associated with the monks their loss of title to the mark in France did not affect their rights in England, and that they were, consequently, entitled to restrain the French liquidator and his

(11) *Poiret v. Jules Poiret Ltd. and A. F. Nash*, 37 B.P.C. 177.

(12) *La Societe Anonyme Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, 18 B.P.C. 405. See also *The Roberts, Numbering Machine Co. v. Davis*, (1936) 53 B.P.C. 79.

(13) A.I.R. 1931 Mad. 461.

(14) *Anglo-Indian Drug and Chemical Co. v. Swastik Oil Mills Co., Ltd.*, A.I.R. 1935 Bom. 101.

(15) 25 B.P.C. 265, 27 B.P.C. 268.

agent from passing off in England, wine not manufactured by the monks, as Chartreuse wine.

**Right to relief not affected by joint ownership.**—It is not, however, essential that the plaintiff should be the sole owner of the mark. A plaintiff may be entitled to protection against passing off by other traders though there may be others besides himself, who may be equally entitled to the mark. Nor need all the persons who also have a right in the mark be joined as co-plaintiffs in the suit. In *Dent v. Turpin*,<sup>16</sup> where the mark in question belonged to two concurrent users it was held that either of them could sue for an injunction and damages. Injunction was likewise granted in *Southorn v. Reynolds*,<sup>17</sup> where the plaintiff's brother who had an equal right to the mark did not join in the suit. Where there are concurrent users it may, however, be difficult for the plaintiff to show that the use of his mark by others will be calculated to deceive the public.<sup>18</sup>

**Specific name of the plaintiff or the source of the goods need not be known.**—In order that the plaintiff may succeed in a passing off action the mark alleged to be infringed need not have indicated to the purchasers the specific ownership or origin of the goods. It is sufficient, if the plaintiff shows, that the mark in question had been identified by the public with goods of a particular manufacture, and that by means of that mark the purchasers are able to distinguish these goods from other goods of a like character. For, as Justice Fry said in *Siebert v. Findlater*:<sup>19</sup> "The reference to the maker arises only when there is super-added to the thought of the thing the thought of the person who makes it, a thought which seldom arises in the mind of the purchaser, who cares nothing about the maker but only about the thing which he is buying." A consumer is interested in a trade mark only in so far that it is a guarantee that the goods bearing the trade mark will be of the same quality as those previously purchased by him under the same mark, and he is not concerned with the name of the actual manufacturer of the goods. So, Lord Macnaghten said, in the well known *Stone ale case*,<sup>20</sup> "Thirsty folk want beer, not explanations. If the public get the thing they want, or something

(16) (1861) 30 L.J.Ch. 495.

(17) 12 L.T. (N.S.) 75; Seb. Dig., p. 142.

(18) See judgment of Vaughan Williams, L. J., in *Jamieson & Co. v. Jamieson*, 15 R.P.C. at p. 193.

(19) 7 Ch.D. 801, 813.

(20) *Montgomery v. Thompson*, 8 R.P.C. 361; 1891 A.C. 217 (H.L.).

near it, and get it under the old name—the name with which they are familiar—they are likely to be supremely indifferent to the character and conduct of the brewer, and the equitable rights of rival traders”. “It may very well be”, said Lord Chancellor Hatherley, in the *Glenfield Starch case*,<sup>21</sup> “that hundreds of people like Glenfield starch and order it because they think it is the best starch that they ever used, without having heard the name of Mr. Wotherspoon, and without knowing him at all”. Again, in the *Silverpan Jam case*,<sup>22</sup> Hall, V. C., said: “If a man is accustomed to buy a certain brand which has become a catchword, very often he forgets the name of the maker. He might remember jam that he bought, which was undoubtedly Faulder & Co.’s jam, and, wishing to get the same jam again, in asking for ‘silverpan’ he would buy it in the expectation of getting the same brand, that is Faulder’s brand; therefore I am not at all sure it was an absolute necessity that a person asking for ‘silverpan’ should have in his mind the name of Faulder”.

“**Yorkshire Relish**” case.—The question was fully discussed in the well known case *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*<sup>23</sup> The plaintiff had been carrying on business under the style of Goodall, Backhouse, and Co., and he and his predecessors in title had for the last 35 years manufactured in accordance with a secret recipe, a sauce which they had sold under the name of “Yorkshire Relish”. This sauce had been largely advertised and extensively sold. The defendant company began to sell a sauce under the name of “Yorkshire Relish” in bottles, with a label bearing the words “Yorkshire Relish” thereon in a conspicuous manner, and also the words “manufactured by the Birmingham Vinegar Brewery Co., Ltd.,” and other particulars. An interlocutory injunction was granted to restrain the defendants from passing off their sauce as the plaintiff’s by the use of the term “Yorkshire Relish”. The defendant company then changed their original label and used a label in which the words “Holbrook’s” appeared prominently, followed by “Yorkshire Relish” in small letters, and then the words “manufactured by the Birmingham Vinegar Brewery Company Ltd., successors to Holbrook & Co.” The defendants contended among other things that the expression “Yorkshire Relish” did not convey to the public in any manner

(21) *Wotherspoon v. Currie*, L.R. 5 H.L. 508; 42 L.J.Ch. 130.

(22) *Faulder & Co., Ltd. v. O. and G. Rushton, Ltd.*, 20 R.P.C. 477.

(23) 12 R.P.C. 496; 13 R.P.C. 235; 14 R.P.C. 1 & 720.

the idea that the sauce sold under that name was made by Goodall, Backhouse & Co. A perpetual injunction was, however, granted. Lindley, L. J., in the Court of Appeal observed: "A person whose name is not known but whose mark is imitated, is just as much injured in his trade as if his name was known as well as his mark." Lord Chancellor Halsbury observed in the House of Lords, that the evidence in the case conclusively proved that "there is the representation that the article is made by the rival manufacturer when, in fact, it is not, and that the thing is not that which it purports to be, and that the effect of that is to deprive the plaintiff of some trade which he would otherwise get." "It may be true" said the learned Lord Chancellor, "that the customer does not know or care who the manufacturer is, but it is a particular manufacture that he desires. He wants "Yorkshire Relish" to which he has been accustomed, and which, it is not denied, had been made exclusively by the plaintiff for a great number of years. This thing which is put into the hands of the intended customer is not "Yorkshire Relish" in that sense. It is not the original manufacture. It is not made by the person who invented it. Under these circumstances, it is a fraud upon the person who purchases to give him the one thing in place of the other." And, Lord Herschell observed: "I think that the fallacy of the Appellant's argument rests on this; that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacturer by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all."

**Edge & Sons, Ltd. v. Niccolls & Sons, Ltd.**—Another interesting case is *Edge & Sons, Ltd. v. Niccolls & Sons, Ltd.*<sup>24</sup> The plaintiff company had for several years been selling washing blues and tints in a wrapper with a stick protruding, but having no

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(24) 28 R.P.C. 582. See also *McDowell's Application*, 43 R.P.C. 313; 44 R.P.C. 335. Registration of the word 'Nuvol' for lubricating oils was opposed by the Standard Oil Co., who were selling 'Nujol', a medicinal oil. Registration was refused, notwithstanding the contention of the applicants that the lubricants of the opposing firm were marked in England by an independent corporation, the Anglo-American Oil Co., and that the public were ignorant that these lubricants were manufactured by the Standard Oil Co. The decision was affirmed by the House of Lords.

label or name on the wrapper and had largely advertised that their blues had the stick. The defendant company used for their blues and tints a similar get-up and a label on which their name was printed prominently. In granting injunction Lord Gorell said: "No name or description appears upon the wrapper containing the plaintiff's blues and tints, and to many of such persons the plaintiff's name is unknown.....It is not necessary, in my opinion, for the plaintiff to prove that the ultimate purchasers, who are likely to be misled, know the name of the plaintiff's firm. Buyers of the plaintiff's goods, without any label at all, might, if they bought the defendant's goods and noticed the label, still think, having regard to the appearance of the goods, that they were goods which had been long on the market, and that the name of the manufacturer was now disclosed to those who did not previously know it."

**Rights limited to particular goods or business associated with the mark.**—The acquisition of an exclusive right to a mark or name in connection with a particular article of commerce, cannot entitle the owner of that right to prohibit the use by others of such mark or name in connection with goods of a totally different character. In an action for passing off it is, therefore, not sufficient to show that the defendant's trade mark is a colourable imitation of the plaintiff's mark. It must be shown further that the goods of the two traders are sufficiently allied, and that the goods sold by the defendant are so similar to the plaintiff's goods as to be calculated to lead to deception, if sold with the particular trade mark or get-up.<sup>25</sup> Thus in *Lucas Ld. v. Fabry Automobile Co., Ld.*,<sup>1</sup> it was held that the plaintiff's right to the exclusive use of the mark 'Lucas' was limited to cycle and motor accessories made of metal and did not extend to motor tyres. And in *C. & T. Harris (Calne) Ld. v. F. S. E. Harris*<sup>2</sup> an injunction for passing

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(25) It was observed that in India "the classification of goods by the Trade Mark Rules, 1920, can by no means be an infallible guide for the determination of the question, whether or not a particular article is somewhat similar to or of the same description as another, though both may have been classified by the Rules of 1920 in the same class." Iqbal Ahmad, J., in *Thomas Bear & Sons (India) v. Prayag Narain*, A.I.B. 1935 All. at p. 16. See also *Anglo-Indian Drug and Chemical Co. v. Swastik Oil Mills Co., Ld.*, A.I.B. 1935 Bom. 101.

(1) 23 R.P.C. 33.

(2) 51 R.P.C. 98. See also *Hargreaves v. Freeman*, (1891) 3 Ch. D. 39; *Lake and Elliott's Application*, 20 R.P.C. 605 (millennium for carriages and vehicles and 'millennium' for flour and bread); *Turner's Motor Manufacturing Co., Ld. v. Miesse Petrol Car Syndicate Ld.*, 24 R.P.C. 531

off was not successful as the plaintiffs' reputation extended only to English bacon and the defendant had clearly indicated to the customers that he was trading in Danish bacon.

In *Thomas Bear & Sons (India) v. Prayug Narain*,<sup>3</sup> Iqbal Ahmad, J., said: "the right of property in a particular trade mark is confined to goods of similar description to which the mark has been attached, and the use of a trade mark, identical with the mark in which the plaintiff has acquired a right of property, on goods of a description other than that to which the mark of the plaintiff is attached does not constitute an infringement of the plaintiff's right. The reason is obvious. If the goods in which the plaintiff deals are different from the goods to which the defendant attaches the mark, the unwary purchaser is not likely to be misled into the belief that the defendant's goods are the goods of the plaintiff's manufacture. The use of a trade mark in connection with goods of a particular description for an appreciable length of time leads to the association of that mark with those goods in the market, and thus the public is led into the belief that similar goods to which that mark is attached are goods of the person whose mark they bear. But if the same mark is attached to goods of a different description there is not the likelihood or probability of the purchaser being deceived." His Lordship added, "I do not for a moment underrate the importance of industrial and trade security and am alive to the imperative necessity of protecting a dealer, whose goods, by the mark that they bear, have acquired a particular reputation in the market, from being subjected 'to invasion at the hands of an unscrupulous rival.' But it is of equal importance that a firm or company that acquired a right of property in a particular trade mark with respect to particular goods should not be allowed to restrain others from using that mark on goods of a different description and thus jeopardise freedom of trade and stifle the industry of the country. It is to be remembered that in the absence of statutory law on the subject cases of alleged infringement of trade marks have to be decided in

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*Car Syndicate Ltd.*, 24 R.P.C. 531 (Miesse steam motor cars and Miesse petrol motor cars); *Nugget Polish Co., Ltd. v. Harboro Rubber Co.*, 29 R.P.C. 133 (Boot polish and rubber heels); *Tokalon Ltd. v. Davidson & Co.*, 31 R.P.C. 74 (Shampoo powder and hair tonics); *Sunbeam Motor Car Co., Ltd.'s Application*, 33 R.P.C. 389; *Lehmann & Co.'s Application*, 35 R.P.C. 92; *British Cycle and Motor Manufacturers' Union's Application*, 40 R.P.C. 226; *Wilson's and Mathieson's Ltd. v. Meynell & Sons Ltd.*, 46 R.P.C. 80 (porcelain baths and brass taps); *Colman Ltd.'s Application*, 46 R.P.C. 126.

(3) A.I.R. 1935 All. 7.

India according to justice, equity and good conscience, and I consider it unjust to restrain the defendant from using his mark on goods which have not been manufactured so far by the plaintiff company." In the above case the plaintiffs who had acquired title to a trade mark consisting of an elephant for cigarettes sought to restrain the defendant from using a similar mark for chewing tobacco. It was held that the two goods were entirely different and that there was no possibility of the defendant's chewing tobacco being confused with or mistaken as and for the goods of the plaintiffs' manufacture.

*Anglo-Indian Drug and Chemical Co. v. Swastik Oil Mills Co., Ltd.*,<sup>4</sup> is another recent case. The plaintiffs had been selling hair oils, perfumery and toilet requisites under the mark "777," while the defendants began selling bar soap with their name and Swastik mark on one side of the bar and the number "777" on the other. It was argued that, although bar soap is generally used for washing clothes the poorer classes of people in India use it for toilet purposes as well. The action was dismissed with costs. Wadia, J., said: "In India the action is generally limited to a particular kind of goods only, and it is for the plaintiffs to establish by their evidence that bar soap comes under the description of "toilet preparation," or is "allied" to the same, in order to attract to it the benefit of a trade mark which had been used only in connection with such preparations. . . . All that is alleged is that it is an article usually manufactured and sold in India by persons manufacturing and selling such toilet preparations as the plaintiffs have been doing. . . . There is no authority, in support of a claim to a trade mark in India in respect of an article neither manufactured nor sold by the plaintiffs, but which they allege, is allied to their "toilet" preparations."

In the case of literary property such as a novel, or drama an action for passing off may be available even though the two goods are not very similar. Thus, in *Samuelson v. Producers Distributing Co., Ltd.*,<sup>5</sup> it was held that the owner of the copyright of a play sketch was entitled to prevent any person from passing off as and for a cinematograph version of that work something which was not in fact the cinematograph version of that work. In rejecting the contention that the plaintiff had no cause of action as he had no film and as the defendants were not making use of his

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(4) A.I.E. 1935 Bom. 101.

(5) 48 R.P.C. 447, 580.

name, Mr. Justice Luxmoore said: "I do not think it is correct to say that the sketch and the film occupy different spheres of business. To represent contrary to the fact that the cinematograph film is a version of a particular work must be calculated to damage the film rights in the particular work.....In my opinion the owner of a copyright work is entitled to prevent any person passing off as and for a cinematograph version of that work something which is not in fact a version of that work, although no cinematograph version of it has in fact been made." The decision was affirmed by the Court of Appeal.

**Kind of goods need not be identical.**—It is, however, not necessary that the infringement complained of should be in respect of goods of the same kind. As pointed out in an earlier section, in cases of fraud the court will not insist on a very close similarity between the two goods, or the nature of business carried on by the plaintiff and the defendant.<sup>6</sup> In such cases the defendant will be restrained from passing-off not only goods which are of the same kind but also goods having some affinity to the plaintiff's goods. Thus, in *Eno v. Dunn & Co.*,<sup>7</sup> registration of the word "Dunn's Fruit salt baking powder" as trade mark for baking powder was refused by reason of a prior user of the words "fruit salt" for an aperient or medicinal drink. It was observed by Lord Watson in that case that "there would be a supposed connection between the two articles in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the appellant's fruit salt, and purchase it in that belief, so that a batch of badly made baking powder might seriously injure the credit of the effervescing powder." It may be observed that this is an extreme case illustrating the above rule and it occasioned considerable divergence of opinion among the judges who tried the case. In *Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd.*,<sup>8</sup> it was held that the tyre trade generally included dealing in both cycle and motor tyres, and that the defendants' use of the name "Warwick" for

(6) *Lloyd's v. Lloyd's Southampton Ltd.*, 29 R.P.C. 433; *Harrod's Ltd. v. R. Harrod Ltd.*, 41 R.P.C. 74.

(7) 7 R.P.C. 311; (1890) App. Ca. 252.

(8) 27 R.P.C. 161. See also *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*, 16 R.P.C. 12; *Schreeve's Trade Mark*, 31 R.P.C. 24; *Brown & Co.'s Application*, 38 R.P.C. 15; *Walpamur Co., Ltd. v. Sanderson & Co., Ltd.*, 43 R.P.C. 385; *McDowell's Application*, 43 R.P.C. 313; 44 R.P.C. 335; *Savage's Application*, 44 R.P.C. 1; *Samson Cordage Co.'s Application*, 44 R.P.C. 313.



motor tyres would be calculated to mislead persons into the belief that such tyres were of the same make as the well known "Warwick" cycle tyres. Similarly in *Eastman Photographic Materials Co., Ltd. v. (John) Griffiths Cycle Corporation Ltd.*,<sup>9</sup> the defendants were restrained from using the word "Kodak" for their cycles although the plaintiffs were not dealing in cycles. So also, in the unreported case *British American Tobacco Co. (India) Ltd. v. Ismail Sahib*<sup>10</sup> the plaintiffs who were the owners of the "Scissors" mark for cigarettes were successful in an action to restrain the defendants from using fraudulently the scissors mark on *biris*, though the plaintiffs did not deal in *biris*. Wallis, J., observed that the two goods were closely allied and that the damage which the plaintiffs were likely to sustain did not lie in the fact, that their customers would be attracted by the defendants' goods, but that the reputation of the plaintiffs might be adversely affected by the inferiority of the defendants' goods.

The rule was stated by Niamatullah, J., in the following passage: "The plaintiffs, whose goods have acquired a reputation in the market through a trade mark or name with which their goods have become associated, have a right to restrain the defendant from using a trade mark or name which is identical with or similar to that of the plaintiffs, and such right extends not only to the particular goods sold by the plaintiffs, but also to cognate classes of goods, provided the cumulative effect of the similarity of the mark, the commercial connection between the plaintiffs' goods and those of the defendant and the surrounding circumstances is such as to lead the unwary customers to mistake the defendant's goods for those of the plaintiffs. The raw material with which the articles in question are prepared, any affinity in the process employed in manufacturing them, the fact that the production of one can extend from the slight extension of the business of the other, the habits and notions of the customers of the two, and the uses made of the article afford indicia of more or less cogency for determining whether the customers of the defendant's goods are likely to mistake them for those of the plaintiffs. Direct evidence establishing the fact that such impression was created in the past in the minds of certain persons is also of value. The inference to be drawn from all the circumstances should not be speculative, but probable."<sup>11</sup>

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(9) 15 R.P.C. 105.

(10) C. S. No. 159 of 1909 Madras High Court.

(11) *Thomas Bear & Sons (India) v. Prayag Narain*, A.I.R. 1935 All. 7.

**Accessories.**—In the case of accessories it is comparatively easy to establish a definite affinity between the goods in question to warrant an injunction, although the goods may belong to different classes. Injunction was thus granted in *Kodak, Ltd. v. London Stereoscopic and Photographic Co., Ltd.*,<sup>12</sup> restraining the defendants from selling films of their own manufacture as Kodak film, although it was contended that the expression denoted merely films for Kodak cameras. But, in *Neostyle Manufacturing Co., Ltd. v. Ellam's Duplicator Co.*,<sup>13</sup> where the plaintiffs, carrying on business in duplicating machines and accessories for use therewith, sought to restrain the defendants from passing-off ink, paper, and stationery under the name "Neostyle" an injunction was refused. It was held that, although the word "Neostyle" had become identified in England with the plaintiffs' duplicating machines they had never had any exclusive right to the use of the word in connection with duplicator accessories. It is thus possible that a trade mark distinctive for a particular machine may be descriptive when applied to its accessories.

**Mark must distinguish the plaintiff's goods.**—The nature of the mark is of primary consideration in determining the plaintiff's title to a trade mark. It is now well settled that if the mark is inherently distinctive it is not necessary to establish that the mark has acquired wide reputation. The mere fact that the plaintiff is the first and continuous user will entitle him to exclusive ownership of the mark.<sup>13-a</sup> On the other hand, if the mark is *prima facie* non-distinctive a claim to exclusive ownership will not generally be sustained, notwithstanding that the plaintiff was the first user, as such mark is not adapted to distinguish the plaintiff's goods from similar goods of other manufacture. In exceptional cases a plaintiff may, however, succeed in proving to the court that his mark, though *prima facie* non-distinctive, has in fact become distinctive of his goods. The ease with which this can be done will depend to a great extent upon the nature of the mark. It may, therefore, be useful to consider here what marks are *prima facie* non-distinctive and how such marks may, in spite of their primary non-distinctive character, acquire a secondary distinctive character in connexion with the goods of a particular manufacturer. This topic is discussed at some length in the following sections.

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(12) 20 B.P.C. 337.

(13) 21 B.P.C. 185, 569. See also *Gledhill & Sons, Ltd. v. British Perforated Toilet Paper Co.*, 28 B.P.C. 714.

(13-a) Subject to right of honest concurrent user by another.

**Mark descriptive of the goods.**—A trade mark which is *prima facie* descriptive of an article or its composition or its mode of manufacture must be open to the trade and cannot be claimed for exclusive use by any one trader. In *Singer Manufacturing Co. v. Loog*<sup>14</sup> Lord Selborne said: "The reputation acquired by machines of a particular form or construction is one thing; the reputation of the plaintiff as manufacturer is another. If the defendant has no right under colour of the former to invade the latter, neither have the plaintiffs any rights under colours of the latter to claim (in effect) a monopoly of the former." Thus, in *Liebig's Extract of Meat Co. (Limited) v. Hanbury*<sup>15</sup> where both the plaintiffs and the defendants were making the preparation according to Liebig's recipe and selling them as "Liebig's Extract of Meat" injunction was refused by Wood, V. C., on the ground that the process of manufacture had long been published and employed, and that the name had sometime past been in common use as descriptive of the article prepared according to this process. In *Browne v. Freeman*<sup>16</sup> injunction was likewise refused, the court observing, that though the plaintiff could have originally acquired exclusive right to the use of the word "Chlorodyne" when the product was first introduced by him in the market, the name had become the name of the article. Similarly, the words "linoleum" for floor cloth,<sup>17</sup> "malted food" for food,<sup>18</sup> "gripe water" for medicine,<sup>19</sup> "wet or dry" for abrasives,<sup>20</sup> and 'magazine of fiction',<sup>21</sup> were held to be merely descriptive of the goods.

On the other hand in *Singer Manufacturing Co. v. James Spence & Co.*,<sup>22</sup> and *Singer Manufacturing Co. v. British Empire Manufacturing Co., Ltd.*,<sup>23</sup> it was held that the term "Singer

(14) 18 Ch. D. 395; 8 App. Cas. 15.

(15) 17 L.T.N.S. 298 (1867); Seb. Dig. p. 171.

(16) (No. 1) Seb. Dig. p. 134; (No. 2) Seb. Dig. p. 253.

(17) *Linoleum Manufacturing Co. v. Nairn*, 7 Ch.D. 834; 47 L.J.Ch. 430.

(18) *Horlick's Malted Milk Co. v. Summerskill*, 34 R.P.C. 63.

(19) *Woodward Ltd. v. Boulton Maoro Ltd.*, 32 R.P.C. 173.

(20) *Minnesota Mining and Manufacturing Co.'s Application*, 41 R. P.C. 237.

(21) *Williams Stevens Ltd. v. Cassell & Co., Ltd.*, 30 R.P.C. 199. See also *Mathieson v. Sir Isaac Pitman & Sons, Ltd.*, 47 R.P.C. 541 where the words, "How to appeal against your rates," forming the title of the book were held to be descriptive of the contents of the book.

(22) 10 R.P.C. 297.

(23) 20 R.P.C. 313.

machines" had come to mean to the public, machines made by the Singer Manufacturing Co., and not machines made according to any particular type or pattern known as the Singer system. So also, in *Bechstein v. Barker and Barker*<sup>21</sup> the court held that the expression "Bechstein Model" indicated that the piano was made by the firm of Bechstein and not pianos made according to any particular model. In *Daimler Motor Co. (1904) Ltd. v. London Daimler Co., Ltd.*,<sup>25</sup> the Court of Appeal decided that the name, Daimler, had become distinctive, although originally it denoted merely a system on which motor cars worked. In *Roe (A.V.) & Co., Ltd. v. Aircraft Disposal Co., Ltd.*,<sup>1</sup> the plaintiffs had registered the word "Avro" for aeroplanes, but during the war aeroplanes according to the plaintiffs' design known as "Avro 504-K" had been made by other manufacturers and supplied to Government. It was contended that the name "Avro" was in the circumstances not distinctive, but indicated only a certain type of aeroplanes, irrespective of the manufacturer. Interlocutory injunction was, however, issued restraining the defendants from passing off machines not manufactured by the plaintiffs, under the name "Avro", but the defendants were not restrained from selling aeroplanes of other makers made according to the above design under the names "Avro type" or "Type Avro."

The expression "Lawson Tait Bedstead" was held to have acquired a secondary meaning in connection with bedsteads manufactured by the applicants though made according to a pattern originally approved by the physician Lawson Tait.<sup>2</sup>

The following words also were held to have no direct reference to the quality or nature of the goods: "Regimental" for cigarettes,<sup>3</sup> "National" for cash registers.<sup>4</sup>

**Laudatory words.**—Words which are merely laudatory cannot be appropriated as trade marks, e.g., "Superior", "superfine",<sup>5</sup>

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(24) 27 R.P.C. 484.

(25) 24 R.P.C. 379.

(1) 87 R.P.C. 249.

(2) *Application of Whitfield's Bedsteads Ltd.*, 26 R.P.C. 657. See also *Vacuum Oil Co., Ltd. v. Gooch and Tarrant*, 27 R.P.C. 76.

(3) *Imperial Tobacco Co. (of Great Britain and Ireland) Ltd. v. De Pasquali & Co.*; 35 R.P.C. 185.

(4) *National Cash Register Co.'s Application for a trade mark*, 34 R.P.C. 354.

(5) *Braham v. Bustard*, 1 H. & M. 447.

“Nourishing”,<sup>6</sup> “Best”, “Perfection”,<sup>7</sup> “classic”,<sup>8</sup> “Victor”,<sup>9</sup> “Charm”.<sup>10</sup>

**Marks descriptive of design.**—A name which denotes only a particular type or pattern of a machine or article and not the machine or article sold by the plaintiff cannot be protected. In *Harrison, McGregor & Co.’s Trade Mark case*,<sup>11</sup> Mr. Justice Kekewich held that the plaintiffs had used the word “Albion” only to denote a design and not a trade mark and that the mark should, therefore, be expunged from the Register, but, by agreement an order was only made for the limitation of the registration to the specified goods. In *Winser & Co., Ltd. v. Armstrong & Co.*,<sup>12</sup> the plaintiff company had registered a design for intercepting sewer traps or interceptors, and were selling the same as “Winser interceptors.” After the registration had expired the defendants began selling other interceptors of a similar design, under the name “Winser interceptors.” The plaintiffs’ action to restrain the defendants from using this name was dismissed. Byrne, J., said: “If a man registers a new design, and gives the article made in accordance with that design a name, that name describes the article. In this particular trade there are intercepting traps already known and identified by the name of the inventor, or of the persons who first introduced them, such as Buchan’s, Beale’s and Weaver’s traps. A man having invented a new design or trap, and given it a name, may present the name to the public as part of what he does. So long as he is protected by registration he, and he alone, can make in accordance with the design so registered, and the public are warned by the impression of the word “Registered” and the number that they must not make that article, which is an article belonging to the person who has so registered it. When the registration has expired, the article, whatever it is, becomes common property and anybody can make it. They must not, of course,

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(6) *Raggett v. Findlater*, L.R. 17 Eq. 29.

(7) *Joseph Crosfield & Sons, Ltd.’s Application*, 26 R.P.C. 837.

(8) *Sharpe (W.N.) Ltd. v. Solomon Bros. Ltd.*, 32 R.P.C. 15.

(9) *Massachusetts Saw Works’ Application*, 35 R.P.C. 137.

(10) *Keystone Knitting Mills Ltd.’s Trade mark*, 45 R.P.C. 193, 421.

(11) 7 R.P.C. 25.

(12) 16 R.P.C. 167. The word “Prophylactic” was held to be descriptive of a particular shape and make of tooth brush and not distinctive, *Cordes v. Addis & Son*, 40 R.P.C. 133. The word “console” was held to be in common use in the gramophone trade as indicating a design with particular characteristics, *The S. M. T. Gramophone Co., Ltd. v. Itonts Gramophone Ltd.*, 48 R.P.C. 309.

make the article and represent it to be an article of the plaintiffs' make, or as being an article sold by the plaintiffs; in other words, they must not, although they are entitled to make the articles, represent to the public that the goods they so make are goods made and sold by the other person, formerly the registered owners."

**Descriptive of quality.**—"A symbol which by trade usage has come to denote quality and nothing else (such as, for instance, the hammer mark in the cutlery trade and the "XX" and "XXX" marks in the brewing trade) cannot be appropriated by a particular manufacturer as a trade mark any more than a common adjective denoting quality can be so appropriated."<sup>13</sup> Where a mark merely signifies the quality of an article and not the article sold by the plaintiff the mark cannot be considered as the trade mark of the plaintiff, even though he may be the first to use it in the market.<sup>14</sup> Thus, in *Barlow v. Gobindram*<sup>15</sup> the plaintiffs' claim for the use of the number 9000 as a trade mark for distinguishing their cloth was rejected on the ground that it was only a quality mark. In *Vadilal Sakalchand v. Burditt & Co.*,<sup>16</sup> Mr. Justice Batty observed that the mere fact that a mark was designed by a person does not entitle him to the exclusive use of that mark. Such a mark may be a mere quality mark, indicating the reputation of the goods irrespective of the reputation of the seller. Every trader being entitled, if not bound, to state truthfully the quality of the goods he sells, no one trader can restrain any other from exercising that right by a mark truthfully indicating quality. "To give an exclusive right", said his Lordship, "there must be something further. The mark must amount to a representation that the quality is wholly or in part due to, and guaranteed by, some persons concerned in, or connected with, the origin or history of the goods. In such cases the public are invited to rely on the reputation of the persons denoted, and no other person can, without their authority, make such representation."

**Meaning may be different to the public and the trade.**—Sometimes a word may convey a different meaning to the public from what it has to the trade. In such cases, the Courts will consider only the meaning of the word as generally understood by

(13) *Lawrence, L. J.*, in *Nicholson & Sons Ltd.'s Application*, 48 R. P.C. at p. 246.

(14) *Ralli v. Fleming*, 3 Cal. 417, Markby, J.

(15) 24 Cal. 364.

(16) 7 Bom. L.R. 272; 30 Bom. 61.

ordinary purchasers. So, in *Singer Manufacturing Co. v. British Empire Manufacturing Co., Ltd.*,<sup>17</sup> Kekewich, J., observed: "It is said that this is not advertised as a "Singer" machine, but only as a machine according to the latest improved "Singer system". It is said that that is known in the trade, which seems to have been admitted in another case, but it is perfectly clear that among the ordinary purchasers of sewing machines, that is to say, among the thousands who buy and sell them, that there is no such thing known as the "Singer system"; what persons know is the "Singer" machine; and what persons want to buy is the "Singer" machine; and to tell them it is on the "Singer system" tells them nothing." So, in *Ford v. Foster*<sup>18</sup> it was held that to the public the word "Eureka", as applied to shirts, had become distinctive of the plaintiff's goods, though to the trade it was merely descriptive of a particular pattern. On the other hand, it is possible that a word may convey a distinctive meaning to the trade but only a descriptive meaning to the public. The case of the *Gramophone Company's application*<sup>19</sup> is illustrative of this point. The word gramophone at one time designated a patented instrument with disc, as distinguished from cylindrical records. The patent expired in 1900, and, thereafter, a number of manufacturers made similar machines and sold them, not as gramophones, but under various trade names. The applicant company alone sold those disc machines under the name gramophones. The company, accordingly, claimed exclusive right to use this word for disc machines of their manufacture. The finding of the Court was that the word "gramophone," so far from losing its original signification, had become popularised, largely owing to the advertisements of the plaintiffs themselves, as the name of the particular sort of article, though among traders, the word while still denoting the article, also generally connoted the source of manufacture. Registration was refused of the word "gramophone" as a trade mark. Lord Parker said: "On the one hand, distinguishing the public from the trade, it is, in my opinion, clear that to the general public the word "gramophone" now denotes a talking machine with disc as opposed to cylindrical records, that is, a particular type of talking machine, and denotes this without any connotation of the source of manufacture. . . . On the other hand, I think it is equally clear that, to the trade generally, the word, while it still denotes a talking machine of a particular type, connotes also

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(17) 20 R.P.C. at p. 319.

(18) (1872) L.R. 7 Ch. 616.

(19) 27 R.P.C. 689.

the source of manufacture of such machines. . . . Taking the word 'gramophone' on its own merits, and as it is used by the Applicant company in their application for registration, and finding that it is the name of a particular sort of article, I cannot see that it is in itself more adapted to distinguish that article when made by one person from the same article when made by another man than, for example, the word 'match' would be adapted to distinguish the matches of one manufacturer from the matches of another. In itself, therefore, the word 'gramophone' would be no more registrable for gramophones than the word 'match' for 'matches'.

**Descriptive words may acquire a secondary signification.—**

A word or name which is primarily descriptive of the goods may, in course of time, lose this ordinary meaning and, by long user, acquire a secondary meaning indicating that the goods sold under that word or name are not merely goods of that description but goods made by a particular manufacturer. In the circumstances, any other manufacturer will not be entitled to use the word or name to sell his own goods without clearly distinguishing such goods from those of the first user. When once it is established that the secondary meaning of the word or words had become the dominant meaning, that is to say, when the mark is understood by the public to indicate goods made by the plaintiff and not merely to describe the goods, the court will prohibit any other person selling his goods under that particular mark and, thereby, passing-off his goods, as and for, those of the plaintiff.

**Reddaway v. Banham.**—The leading authority for this principle is the famous Camel hair belting case.<sup>20</sup> It may be

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(20) *Reddaway v. Banham*, 13 R.P.C. 218. For other Reddaway cases see *Reddaway v. Ahlers*, 19 R.P.C. 12; *Reddaway & Co., Ltd. v. Frictionless Engine Packing Co., Ltd.*, 19 R.P.C. 505; *Reddaway & Co., Ltd. v. Robert Stevenson & Brother, Ltd.*, 20 R.P.C. 276; *Reddaway v. Smidt & Co.*, 32 Cal. 401. The history of the Reddaway cases is discussed in *Reddaway v. Hartley*, 48 R.P.C., at pp. 289 to 297 by Lord Hanworth, *M. R. Reddaway v. Banham*, has been applied or considered in the following cases: *Powell v. Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54; *Saxlehner v. Apollinaris Co.*, 14 R.P.C. 645; *Parsons Bros. & Co. v. John Gillespie & Co.*, 15 R.P.C. 57; *Cellular Clothing Co. v. Maxton and Murray*, (1899) App. Cas. 326; *Chivers & Sons v. Chivers & Co., Ltd.*, 17 R.P.C. 420; *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R.P.C. 1, 673; *Cash, Ltd. v. Cash*, 18 R.P.C. 213; 19 R.P.C. 181; *Aerators, Ltd. v. Tollit*, 19 R.P.C. 418; *Faulder & Co., Ltd. v. O. & G. Rushton, Ltd.*, 20 R.P.C. 477; *Plotzker v. Lucas*, 24 R.P.C. 551; *Kinnel (Charles P.) & Co., Ltd. v. Ballantine & Sons*, 27 R.P.C. 185; *May v. May*, 31 R.P.C. 324; *Goddard v. The Watford Co-operative Society, Ltd.*, 41 R.P.C. 218;



observed, however, that this principle of law had been stated before in several earlier cases. As Kekewich, J., observed: "Even the language finds a counterpart in many other cases, as *Seixo v. Provezende*.<sup>21</sup> But yet the law is so clearly put on a simple and intelligent basis, that one necessarily makes it the starting point in the consideration of questions of this class."<sup>22</sup> The plaintiff Reddaway, a manufacturer of belting had, since 1879, been selling in England, India and other countries, belting manufactured by him as "Camel Hair Belting" or "Camel Belting", for the purpose of distinguishing it from belting of other manufacturers. The defendant Banham, formerly in the employ of Reddaway, commenced to manufacture belting from yarn of the same description as that used by the plaintiffs and sell them as "Camel hair belting". An action for passing-off was originally launched on the ground that the expression "Camel hair belting" was a fancy term. In the course of the trial it was proved by the defendants that the material of the plaintiffs' belting consisted largely of genuine camel hair, and that, consequently, the trade designation "Camel hair belting" was not a fanciful term, as was generally supposed by the public. During the trial the correspondence between the defendant firm and his Indian agent was filed as evidence which showed fraudulent intention of the defendants to steal the reputation of the plaintiffs' belting. The findings of the jury were: (a) that "Camel hair" belting meant belting made by the plaintiffs as distinct from belting made by other manufacturers, (b) that the defendants' description of their belting as "camel hair" belting was likely to mislead purchasers and (c) that the defendants had fraudulently endeavoured to pass-off their goods for those of the plaintiffs. On these findings, Collins, J., gave a judgment for the plaintiffs and granted an injunction. The Court of Appeal reversed this decision on the ground that an action for passing-off could only lie where the trade name claimed by the plaintiff was a fancy name and not where the name was merely a truthful description of the nature of the goods, notwithstanding that the use of the name by others might lead to deception of the public. On appeal, the House of Lords reversed the decision of the Court of Appeal and affirmed the original decision of Collins, J. In his very learned judgment Lord Herschell laid the law in the following passage: "The

*Havana Cigar and Tobacco Factories, Ltd. v. Oddenino*, 40 R.P.C. 229; 41 R.P.C. 47.

(21) (1866) L.R. 1 Ch. App. 192.

(22) *Saxlehner v. Apollinaris & Co.*, 14 R.P.C., at p. 652.

name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular manufacturer that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of *A* when he was really getting the goods of *B*. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put-off his goods as the goods of the plaintiff. If he could succeed in proving this, I think, he would, on well-established principles, be entitled to an injunction." Referring to the judgment of the Court of Appeal his Lordship observed: "In my opinion the doctrine on which the judgment of the Court of Appeal was based, that where a manufacturer has used as his trade mark a descriptive word, he is never entitled to relief against a person who so uses it as to induce in purchasers the belief that they are getting the goods of the manufacturer who has theretofore employed it as his trade mark, is not supported by authority and cannot be defended on principle. I am unable to see why a man should be allowed in this way more than in any other to deceive purchasers into the belief that they are getting what they are not, and thus to filch the business of a rival."

**Smidt v. Reddaway & Co.**—Issues substantially identical with those in the above case were raised in the Indian case, *Smidt v. Reddaway & Co.*<sup>23</sup> The plaintiffs, F. Reddaway & Co., had been selling belting in India for several years under the name "Camel hair belting", and the name had acquired a valuable trade reputation in India. The defendants had recently imported machine belting of German manufacture which they had placed on the market under the name of "Camel hair belting" or "*Schroder Smidt & Co.*'s Camel hair belting". The correspondence between the defendants and the manufacturers of this belting showed that they were aware of the reputation of the plaintiffs' "Camel hair belting" in the Indian market and that they refused to have their belting stamped in a manner which would distinguish their belting from Reddaway's belting, as it would be then "very difficult if not impossible" to sell their belting. It was held that the name "Camel hair belting" had come to mean on

the Indian market exclusively the plaintiffs' belting. An injunction was accordingly granted by Ameer Ali, J., in the same terms as in *Reddaway v. Banham*,<sup>24</sup> and the decision was upheld on appeal.

**"Silverpan" Jam case.**—*Faulder & Co., Ltd. v. O. and G. Rushton, Ltd.*,<sup>25</sup> is another important case. The plaintiffs were the first to manufacture jams in pans made of silver or silver plated instead of in copper vessels then usual in the trade, and the jams so manufactured were sold as "silverpan" jams. The defendants who were retail grocers began to issue circulars advertising "Silver well silver pan Strawberry 10 1/2 d." An action for passing-off was successful, although the plaintiffs' mark was ordered to be expunged from the Register. Vice-Chancellor Hall held that the name "Silver pan" was distinctive of the plaintiffs' jams and that the defendants in their circulars had not sufficiently distinguished their jams from those of the plaintiffs. The decision was upheld on appeal. Lord Justice Romer said that there was no doubt that the term "Silver pan" was originally suggested by reason of the plaintiffs' jam having been boiled or made in silver or silvered vessels, but having regard to the fact that the user of this term by the plaintiffs in respect to their goods had been for so long a period, and had been so extensive and exclusive, it had become known as distinctive of their goods, and not as being something merely descriptive of the goods.

**Boake, Roberts & Co., Ltd. v. Wayland & Co.**—In *Boake, A. Roberts & Co., Ltd. v. Wayland & Co.*,<sup>1</sup> the question arose whether letters which by themselves were distinctive, but which alongside of the full name had a descriptive meaning could be protected in an action for passing-off. The plaintiffs were selling potassium metasulphite as "K.M.S." with the full name kalium metasulphite added in brackets. The defendants began selling the same salt as "K.M.S.", whereupon the plaintiffs filed an action for infringement and passing-off. It was argued on behalf of the plaintiffs that the letters "K.M.S." were used to distinguish their product from potassium metasulphite manufactured by other firms and that the letters by themselves were meaningless, either to the brewing trade where the chemical was largely used or from the chemical point of view to the chemist. The defendants contended,

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(24) 13 B.P.O. 218; 1896 A.O. 199.

(25) 20 B.P.O. 477.

(1) 26 B.P.O. 251.

on the other hand, that the letters "K.M.S." were an abbreviation of *Kalium metasulphite* and were thus descriptive of the article, *kalium* being the German word for potassium. Injunction was granted by Neville, J., on the ground that the evidence showed conclusively that the letters "K.M.S." were known in the brewing trade to indicate the manufacture of the plaintiffs.

A few more cases may be mentioned in this connection. In *Eno v. Dunn & Co.*,<sup>2</sup> the plaintiff had been selling for several years a medicinal preparation in the form of a powder under the name "Fruit Salt". The defendants commenced selling a medicinal preparation in the form of tablets under the name "Dunn's fruit salt and potash lozenges". Injunction was granted restraining the defendants from selling any medicinal preparation not of the plaintiff's make, under any title of which "Fruit Salt" formed a part, so as to induce the belief that such compound was the plaintiff's fruit salt. In *Sir Henry Cochrane v. MacNish and Son*<sup>3</sup> the Privy Council affirmed the finding of the Supreme Court of Jamaica that the words "club soda" had at the time of the commencement of the action acquired in the trade the meaning of soda water made by the plaintiff. In *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*,<sup>4</sup> the name "Valentine" was held to have become identified with meat juice or meat extract sold by the plaintiffs. In *Kodak, Ltd. v. London Stereoscopic and Photographic Co., Ltd.*,<sup>5</sup> the defendants' contention that the words "Kodak film," "Brownie film," etc., were descriptive of films of any make which would fit the camera was rejected, and the words were held to refer exclusively to the goods of the plaintiffs. In *Burroughs, Wellcome & Co. v. Thompson and Capper*<sup>6</sup> the word "Tabloid" was held to have acquired a secondary meaning in connection with drugs manufactured by the plaintiffs. In *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*,<sup>7</sup> it was held by the Lord Ordinary that the name "Dunlop" having acquired a secondary meaning in connection with the plaintiffs' goods, and the defendants' business being of a similar nature, the resemblance of the trade names was too close not to lead to confusion and an

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(2) 10 R.P.C. 261.

(3) 13 R.P.C. 100.

(4) 17 R.P.C. 673.

(5) 20 R.P.C. 337. See also *Eastman Photographic Materials Co., Ltd. v. Griffiths Cycle Corporation, Ltd.* (15 R.P.C. 105), where the defendants were restrained from selling "Kodak cycles".

(6) 21 R.P.C. 69.

(7) 22 R.P.C. 533.

interdict was accordingly granted. In *Havana Cigar and Tobacco Factories, Ltd. v. Tiffin* (1905), *Ld.*,<sup>8</sup> the Court of Appeal held that the term 'Corona' had become identified with cigars of the plaintiffs' manufacture, although the word had been used by a number of cigar manufacturers to indicate a particular shape. In *Kinnell & Co., Ltd. v. Ballantine and Sons*,<sup>9</sup> it was held that the name "Horse Shoe" had acquired a secondary meaning in connection with boilers made by the plaintiffs. In *Massam v. Thorley's Cattle Food Co.*,<sup>10</sup> Lord Justice James said that "Thorley's Food for cattle" had never become an article of commerce as distinguished from the particular manufactory from which it had proceeded. So also, in *The Application of Whitfield's Bedsteads, Ltd.*,<sup>11</sup> the Court said that the name "Lawson Tait" had become distinctive of bedsteads of a particular manufacture. And, in *The Oriental Government Security Life Assurance Co., Ltd. v. Oriental Assurance Co., Ltd.*,<sup>12</sup> it was held that the word "Oriental" when applied to a Life Assurance Company had become identified with the plaintiff company.

**Facts of each case to be considered.**—It is seen from the above cases that where the facts clearly establish that a particular descriptive name or word had lost its ordinary meaning and has acquired a secondary signification in connection with the goods of a manufacturer the principle of law to be followed is quite clear. But it must be emphasized that in dealing with a question of fact each case must depend upon the facts of that particular case alone. "It would be impossible, for instance, to say," observed Lord Halsbury in *Reddaway v. Banham*,<sup>13</sup> "that a trader could not describe his goods truly by enumerating the particulars of what they consisted, unless such description was calculated to deceive, and make his goods pass as the goods of another. What in each case or in each trade, will produce the effect intended to be prohibited is a matter,

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(8) 26 R.P.C. 473.

(9) 26 R.P.C. 12; 27 R.P.C. 185.

(10) 6 Ch.D. 574.

(11) 26 R.P.C. 657.

(12) 40 Cal. 570, Secondary signification was established in the following cases: "Brinsmead Pianos", *Brinsmead & Sons, Ltd. v. Brinsmead*, 30 R.P.C. 493; "London Olympia Circus", *Mills v. Chapman*, 47 R.P.C. 115; "The Brine Baths", *Hasketh Estates, Southports, Ltd. v. Droitwich Brine Baths, Ltd.*, 52 R.P.C. 39; "Goddard's Plate Powder", *Goddard v. The Watford Co-operative Society, Ltd.*, 41 R.P.C. 218; "Dorman's Motor Engines", *Dorman & Co., Ltd. v. Meadows, Ltd.*, (1922) 2 Ch. 332.

(13) 13 R.P.C. 218.

which must depend upon the circumstances of each case, and the peculiarities of each trade. It would be very rash *a priori* to say how far a thing might or might not be described without being familiar with the technology of the trade." And Lord Macnaghten said: "Cases of this sort must depend upon the particular circumstances. The facts of one case are little or no guide to the determination of another." The nature of a mark, the kind of goods, the class of purchaser and the extent of the sale of the goods are some of the important factors in deciding whether the mark has acquired secondary signification.

**Difficulty in establishing secondary signification in the case of descriptive words.**—Although the Camel Hair Belting case shows the possibility of an ordinary descriptive term acquiring secondary signification different from its original meaning, such instances are of a very exceptional nature. Ordinarily, it would be very difficult to establish the fact that a descriptive name or word has acquired a new meaning in connection with the goods of a particular manufacturer. The difficulty in establishing the acquired secondary meaning of an expression which in its primary sense is descriptive would depend to a large extent upon the amount of descriptiveness of the expression. "The more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof."<sup>14</sup> Or, as Vice-Chancellor Wood said in *Young v. Macrae*<sup>15</sup> "the more ridiculous a trade mark is, the better it is." This difficulty in establishing the alleged secondary signification has been well emphasized in a number of trade mark cases. It will be seen from these decisions that the courts are generally very reluctant to come to the conclusion that an ordinary descriptive word had lost its original meaning and had become distinctive of the goods of a particular manufacturer. The burden of proving that particular words have acquired secondary signification lies on the person alleging it.<sup>16</sup> But "if the proof establishes the fact the legal

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(14) per Lord Halsbury in *Reddaway v. Banham*, 13 R.P.C. 218, (1896) A.C. 199, 210. "A distinctive invented or fancy word has a much wider scope for colourable imitation than a word primarily descriptive, especially if the latter be one in common English use" per Astbury, J., in *Imperial Tobacco Co. (of Great Britain & Ireland) Ltd. v. De Pasquali*, 35 R.P.C. at p. 195.

(15) Seb. Dig., p. 114.

(16) *The Cellular Clothing Co. v. Maxton & Murray*, 16 R.P.C. 397; *Smidt v. Reddaway & Co.*, 9 O.W.N. 281; 32 Cal. 401.

consequence appears to follow." Where the word is descriptive the fact that the plaintiff happens to be the only person who had been using the word for any length of time is not enough to make the mark distinctive. The plaintiff will have to show that there had been an intimate association of the word or mark with his goods so that in the trade the word or mark had come to denote exclusively his goods as distinguished from similar goods sold by other manufacturers. A few leading illustrative cases where the alleged secondary signification was not established are mentioned below.

**The Cellular clothing case.**—The question was fully discussed by the House of Lords in *The Cellular Clothing Co. v. Maxton and Murray*.<sup>17</sup> The plaintiffs were the manufacturers of a special kind of fabric so woven as to permit, while retaining its warmth, free perspiration of the skin. Such fabric was sold under the name "Cellular" which name had never been before applied to clothing or any textile fabric. The defendants, a firm of shirt makers issued pattern books to their customers upon one of which they had stamped the words "Cellular" in block letters with their initials "M. & M." stamped on the outside of the book. It was shown that certain persons to whom the book was supplied ordered "Cellular" goods but did not expect to get the goods of any particular maker. The plaintiffs averred that the name "cellular" in the market meant exclusively their goods and claimed an injunction to restrain the defendants from using this word on cloth or or clothing not manufactured by the plaintiffs. It was contended on behalf of the defendants that the goods described by them as "Cellular", were in point of fact "cellular", and that, as it was an appropriate word describing the quality of the cloth, it had not been and could not be monopolised by any manufacturer. Injunction was refused.

Lord Chancellor Halsbury pointed out that in "dealing with a name which is properly descriptive of the article the burden is very great to show that by reason of your using that name, descriptive of the article you are selling, you are affecting to sell the goods of somebody else." "Certainly the Camel Hair Belting Case may be an example of what, under ordinary circumstances, it would be very difficult to establish; but it was established there. But here the word 'cellular' as a description is applicable; some of the documents and all the advertisements point out how appropriate

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(17) 16 R.P.C. 397 (H.L.); 1899 A.C. 326.

and accurate that mode of description is to the article sold. It cannot be denied, therefore, under those circumstances, that it was for the appellants to establish, if they could, that an ordinary word in the English language, properly applicable to the subject-matter of the sale, was one which had so acquired a technical and secondary meaning, differing from its natural meaning, that it could be excluded from the use of every one else. That is the proposition the Pursuers had to make out.....It seems to me that the Pursuers have failed in establishing this initial fact, and if they have failed in that they have failed altogether, because that cuts out the root of a claim to a remedy." Lord Shand said that the "utmost difficulty should be put in the way of any one who seeks to adopt and use exclusively as his own a merely descriptive term." Referring to *Reddaway v. Banham*<sup>18</sup> his Lordship observed: "Of that case I shall only say that it no doubt shows it is possible where a descriptive name had been used to prove that so general, I should rather say so universal—has been the use of it as to give it a secondary meaning, and so to confer on the person who has so used it a right to its exclusive use, or, at all events, to such a use that others employing it must qualify their use by some distinguishing characteristic. But I confess I have always thought—and I still think—that it should be made almost impossible for any one to obtain the exclusive right to the use of a word or term which is in ordinary use in our language, and which is descriptive only; and, indeed, were it not for the decision in *Reddaway's case*, I should say this should be made altogether impossible." Lord Davey also used substantially similar language: "As has been more than once said, particularly by Lord Justice Fry in the case *Siebert v. Findlater*<sup>19</sup> a man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden, and indeed a burden which it is not impossible, but at the same time extremely difficult to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word not significant and not descriptive, but what has been compendiously called a fancy word."

**Chivers & Sons v. Chivers & Co., Ltd.**—In *Chivers & Sons v. Chivers & Co., Ltd.*,<sup>20</sup> the plaintiffs who were manufacturers of jam

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(18) 13 R.P.C. 218.

(19) L.R. 7 Ch.D. 801.

(20) 17 R.P.C. 420.



and jelly sought an injunction to restrain the defendants who were also manufacturers of jam and jelly from using the word "Chivers" as descriptive of the table jelly manufactured or sold by the defendants. The action was dismissed with costs. Referring to the Camel Hair Belting case, Farwell, J., said: "the gist of it, as decided in *Reddaway v. Banham* is that you take out of the dictionary of the English language, for the purpose of a particular trade, a word which bears a primary signification, and you attach to that word in the dictionary a secondary signification. To say that can be done at all is, I agree with Lord Shand, a very great step. But when you have once the finding of a jury, as you have in *Reddaway's* case, that it had in fact been done with those words, it seems to me that the law follows as a matter of course. The real difficulty is the finding of fact." The test as to whether a descriptive word had acquired a secondary signification or not was stated in the following passage: "It seems to me that, in order that the plaintiffs may succeed, they must have called a body of witnesses, who would have said: 'when I saw that packet the word 'Chivers' on it told me at once, whatever the rest of it may be, whatever the colours may be, whatever the other statements may be, that that was the jelly manufactured by the plaintiff 'Chivers' and nobody else.'" That is the meaning of saying that the word "Chivers" has obtained, as applied to jelly, a secondary meaning in the English language, so that the primary meaning is excluded." His Lordship observed that he thought that the case was an "audacious attempt (if it is not an advertisement) to obtain a monopoly in the name of 'Chivers'."

**Slip-on Case.**—The law was discussed at length by Lord Parker in *Burberrys v. J. C. Cording & Co., Ltd.*<sup>21</sup> This was an action to restrain the defendants from using the word "Slip-on" for coats and overcoats, the plaintiffs alleging that the word had acquired secondary signification. There was no case of actual deception or intent to defraud and the plaintiffs based their case at the trial entirely on probability of deception. It was contended on behalf of the defendants that the plaintiffs had always used the term in connection with the name 'Burberry' and that the term was descriptive of a kind of loose overcoat. The action was dismissed with costs. Lord Parker said that the degree of readiness with which the court would infer the probability of deception would depend upon whether the word or name is *prima facie* in the nature

of a fancy word or name, or whether it is descriptive of the article in respect of which it is used. "It is also important for the same purpose to consider its history, the nature of its use by the person who seeks the injunction, and the extent to which it is or has been used by others. If the word or name is *prima facie* descriptive or be in general use, the difficulty of establishing the probability of deception is greatly increased." "It is of course a truism to state that unfair dealing of any sort ought to be restrained by Courts of justice, but there is another principle, and one equally important, namely, that everybody dealing in an article of commerce, is entitled to use any words which are or have become current in the English language as denoting or describing that article, provided he can do so without deceiving the public to another's injury." Referring to the facts of the case the learned judge said: "The word 'Slip-on' was a known word in the English language long before the plaintiffs used it at all. Though not in very general use, it was used by a considerable number of tailors and their customers as denoting or describing a coat of a particular cut. The word possibly now denotes generally not only the cut but also the material of the article to which it is applied. This is probably in the main due to what the plaintiffs have done, but it still denotes primarily a particular kind of coat which it is open for any one to make. It is generally associated with the plaintiff firm because the plaintiff firm is by far the most celebrated manufacturer of coats of the sort. If other traders wish to meet the popular demand for the kind of article primarily denoted by the word "Slip-on" they are at liberty to do so, and to grant an injunction restraining them from using the term by which the article is known, would, unless there is strong evidence that such use would be calculated to deceive by reason of some secondary meaning of the word, be in my opinion an undue interference with the trade and tend towards establishing a monopoly."

**Other cases.**—A few other cases may be mentioned where the alleged secondary meaning of the word was held to be not established. In *Symington & Co. v. Footman Pretty & Co.*,<sup>22</sup> where the plaintiffs were selling corsets under the name 'guaranteed corsets' with a guarantee for twelve months, the term was held to be descriptive of the terms of sale. In *Gamage Ltd. v. Randall Ltd.*,<sup>23</sup> the plaintiffs who were the first to stamp their shoes "Shorland"

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(22) 56 L.T. 696 (1885).

(23) 16 B.P.C. 185.

(the name of a famous cyclist) failed to obtain an injunction as secondary signification had not been established. In *Hommel v. Bauer & Co.*,<sup>24</sup> the word "Haemotogen" was ordered to be expunged from the register and an action for passing off was dismissed. In *Randall Ltd. v. Bradley & Son*<sup>25</sup> the term "American shoes" was held to be descriptive of shoes made after American models. In *Ripley v. Griffiths*<sup>1</sup> the plaintiff who was selling laundry blue in oval blocks or cakes and had extensively advertised the articles as "Ripley's oval blue" and as 'Oval blue' sought to restrain the defendant from selling laundry blue in similar blocks and under similar name but failed. In *Fels v. Christopher Thomas and Bros., Ltd.*,<sup>2</sup> the name "Fels-Naptha" for soap in which naptha was an important ingredient of the soap was held to be descriptive, although the plaintiffs' soap was the only soap of the kind for two years and was frequently designated by that name. Injunction was also refused on the same ground in *Fels v. Stephenson Bros., Ltd.*,<sup>3</sup> against the use of the words "Rock Oil Naptha soap", and in *Fels v. Hedley & Co., Ltd.*,<sup>4</sup> against the use of the words "Lady bird Naptha soap". So also, in *Aerators Ltd. v. Tollit*<sup>5</sup> injunction to restrain the defendant from registering a company, under the name of "Automatic Aerators Patents, Ltd.," was refused. This decision was followed in *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*,<sup>6</sup> where the words "Vacuum cleaner" were held to be descriptive of the class of machine used by both the plaintiffs and the defendants. Secondary signification was not established in respect of the words, "Post Office Directory" in *Kelly v. Byles*,<sup>7</sup> "White Viennese Band" in *Wurm v. Webster & Girling*,<sup>8</sup> "Flaked oatmeal" in *Parsons Bros. & Co. v. Gillespie & Co.*,<sup>9</sup> "Gripe water" in *Woodward Ltd. v. Boulton Macro Ltd.*,<sup>10</sup> "Malting Milk" in *Horlick's Malting Milk Co. v. Summerskill*,<sup>11</sup>

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(24) 22 R.P.C. 43.

(25) 24 R.P.C. 657, 773.

(1) 19 R.P.C. 590.

(2) 21 R.P.C. 85.

(3) 20 R.P.C. 443; 21 R.P.C. 89.

(4) 20 R.P.C. 437; 21 R.P.C. 91.

(5) 19 R.P.C. 418.

(6) 24 R.P.C. 641.

(7) (1880) 13 Ch.D. 682.

(8) 21 R.P.C. 373.

(9) 15 R.P.C. 57.

(10) 32 R.P.C. 173.

(11) 34 R.P.C. 63.

“White jelly crystals” in *White Tomkins & Courage Ltd. v. United Confectionery Co., Ltd.*;<sup>12</sup> “Castle albums” in *Schove v. Schmincke*;<sup>13</sup> “Wine cart” in *Edward Young & Co., Ltd. v. Grierson, Oldham & Co., Ltd.*;<sup>14</sup> “Chequerboard” for fencing in *T. & C. Associated Industries Ltd. v. Victoria Wagon Works Ltd.*<sup>15</sup> In *William Stevens Ltd. v. Cassell & Co., Ltd.*<sup>16</sup> the plaintiffs, who were publishers of “The magazine of Fiction”, sought to restrain the defendants from adopting to their publication the title “Cassell’s magazine of fiction and Popular Literature.” Injunction was refused by Neville, J., who said: “It is undoubtedly a matter of importance to protect a trader from any unfair attempt to take advantage of his reputation, but it is, I think equally important to protect all his Majesty’s subjects in their right to use the King’s English and the law will not recognize a monopoly of English words of common import.” This case was followed in *Ridgway Co. v. Hutchinson*<sup>17</sup> where the court held that the word ‘Adventure’ was descriptive of the contents of the plaintiffs’ magazine.

**Distinctiveness may depend upon kind of article on which the mark is applied.**—Whether a mark is descriptive of the quality of the goods may, sometimes, depend upon the nature of the goods on which the mark is affixed. A mark may thus be regarded as distinctive for one class of goods but as descriptive when applied to a different class of goods. This was pointed out clearly by Neville, J., in *Henry Thorne & Co., Ltd. v. Eugen Sandow*,<sup>18</sup> *Ld.* The plaintiffs, who had for many years sold a

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(12) 31 R.P.C. 430.

(13) 33 Ch.D. 546 (1886).

(14) 41 R.P.C. 548.

(15) 48 R.P.C. 148.

(16) 30 R.P.C. 199.

(17) 40 R.P.C. 335.

(18) 29 R.P.C. 440. In *Goodall & Sons, Ltd. v. Waddington, Ltd.*, 41 R.P.C. 465, 658, Sarjant, L.J., said: “If the plaintiffs had an ace of spades registered with regard to cotton goods, or with regard to cube sugar or something of that sort, then, no doubt, the taking by the defendants of an ace of spades and making use of that in connection with their goods would be almost certainly an infringement of the plaintiffs’ trade mark, and it would almost certainly also give rise to an action for passing-off. But we have to deal with playing cards, where by the custom of the trade, the ace of spades is a card in which a specially elaborate pictorial character is used by the makers of the cards and, therefore, we have to consider whether there is sufficient distinction between the defendants’ design and the plaintiffs’ design, as designs of the same article”. The term “Hot point” was held to be descriptive for irons but distinctive for other electrical appliances, *Hot point Electric Heating Co.’s application*, 38 R.P.C. 63.

particular brand of cocoa under the name "Health", brought an action for infringement and passing-off against the defendants who commenced selling a kind of cocoa under the name "Health and Strength." The action was dismissed. The learned Judge said: "I can conceive a case in which 'Health' might be upheld as a trade mark. Supposing a person had introduced a fishing rod on the market and called it "Health fishing rod", one might say that there was some remote bearing on the quality of the article, the suggestion being that those who used the fishing rod would find themselves in better health than if they did not do so; but the connection between the word used to denote the fishing rod and its ordinary meaning is so slight, that I could imagine a case in which the court may come to the conclusion that the word "Health" had become distinctive of a make of fishing rods, and that other persons ought not to be entitled to use a word, which they were exceedingly unlikely to introduce for themselves unless they wanted to interfere with the trade of the owner of the trade mark, and would allow the trade mark in such a case to stand. I do not say that would be the result, but I can imagine it. But when it comes to the same word used in connection with an article of diet, I think we are confronted by a totally different set of circumstances, and I must say, not to put it too high, that it seems to me that a person who sought to prove that . . . the word "Health" in connection with an article of diet, was only descriptive of his particular manufacture, would have an exceedingly difficult task before him." The learned Judge also pointed out that the nature of the commendatory word should also be considered in deciding such cases. Thus, although the word "Health" is commendatory in connection with certain articles, its commendatory character is not applicable to such a wide class of articles as other commendatory epithets might be. "For instance, 'good' or 'perfect' or words of that kind, would be applicable, as far as one can see, to any article that might be manufactured; whereas 'health' or 'health-giving' would not be applicable to a very large number of manufactured articles."

**Distinctiveness not necessarily incompatible with descriptiveness.**—Where the plaintiff establishes that his mark had acquired a secondary meaning among a substantial portion of the public, the fact that it is still understood in its primary descriptive sense by a few people will not deprive him of his exclusive right to use the mark. In the *Perfection case*,<sup>19</sup> Lord Justice Fletcher

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(19) *Crosfield, (Joseph) & Sons Ltd.'s Application*, 26 R.P.C. 837.

Moulton said: "Much of the argument before us on the part of the opponents and the Board of Trade was based on an assumption that there is a natural and innate antagonism between distinctive and descriptive as applied to words, and that if you can show that a word is descriptive you have proved that it cannot be distinctive. To my mind this is a fallacy. Descriptive names may be distinctive, and *vice versa*. . . . There is therefore no natural or necessary incompatibility between distinctiveness and descriptiveness in the case of words used as trade marks. The question whether a word is, or is capable of becoming distinctive of the goods of a particular maker, is a question of fact and is not determined by its being or not being descriptive." So also, in the "Slip-on" case,<sup>20</sup> Parker J., said that he did not agree with the argument that a word cannot be at the same time both descriptive and distinctive. But, as his Lordship pointed out, the fact that a word has retained its *prima facie* descriptive signification increases the difficulty of proving that it is distinctive of the goods of any particular manufacturer.

Again, a trade mark may indicate not only the origin of the goods, but their quality as well. The mere fact that on account of the enormous sales of a manufacturer's goods his mark has also become indicative of quality, is not of itself sufficient to debar him from protection and make his mark the common property of the trade. In *Andrew & Co., Ltd., v. Kuehnrich*,<sup>21</sup> Lord Justice Buckley, said: "I have no doubt that the marks in question were used as quality marks, but that does not necessarily exclude user as a Trade Mark. A man may indicate his best quality by one Trade Mark; his second quality by another Trade Mark, and so on. A mark does not necessarily cease to be a trade mark, because it conveys also something further, namely, that the goods indicated as being goods of a particular maker are goods of that maker of a particular kind." Thus in *Nicholson & Sons Ltd.'s Application*,<sup>22</sup> it was held that the firm had been using the triangle mark for the purpose of indicating to customers that the beer in the casks upon which that mark appeared was beer of a certain quality which had been brewed by them, and that the mark was their trade mark and not merely a cellar or handling mark.

(20) *Burberrys v. J. C. Cording & Co., Ltd.*, 26 R.P.C. 693.

(21) 30 R.P.C. at p. 695.

(22) 48 R.P.C. 227; 49 R.P.C. 88; 1932 A.C. 130 (*Bass, Ratcliff & Gretton, Ltd. v. Nicholson & Sons, Ltd.*).

In the converse case a word which was originally distinctive may, in course of time, acquire in addition a descriptive meaning. Such a word will also be entitled to protection provided the word has not become *publici juris* and is still understood in its original distinctive sense by a majority of people. So, in *Ford v. Foster*,<sup>23</sup> where the word "Eureka" as applied to shirts originally designated exclusively the goods of the plaintiff but later ceased to have such exclusive denotation, it was held that the plaintiff was still entitled to relief. Lord Justice Mellish said that "the test must be whether the use of it by other person is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods." This rule of law is well illustrated by a recent passing-off case. In *Havana Cigar and Tobacco Factories, Ltd. v. Oddenino*,<sup>24</sup> the plaintiffs, a well-known firm of tobacco manufacturers, had for several years been manufacturing cigars under a brand "La corona" commonly known as "Corona". Some thirty years before the commencement of the action the plaintiffs had introduced a new size name, "Coronas" and cigar of the Corona brand size and shape became known as "La Coronas" or "Corona Coronas". The size name "Corona" was subsequently adopted by other tobacco manufacturers to designate cigars of a particular size and shape, but cigars of similar size and shape were also sold under size names other than "Corona". It was shown that a request for 'Corona' cigar was, in the circumstances, ambiguous. In granting an injunction Mr. Justice Russell said: "This descriptive meaning has not destroyed or supplanted the original meaning. To the majority of the people, the words "a corona cigar" mean a cigar of the "La Corona" brand; but there is no doubt that, to a large number of persons the words do not indicate brand, but size and shape. . . . It would be unlawful in reponse to a request for a cigar of the Corona brand, to supply without clear explanation, a cigar of the Partagas brand. The defendant here claims the right to do this in response to every request for "a corona" cigar provided that the cigar supplied be of the Corona size and shape. Upon the evidence before me, this would result, in the majority of cases, in a cigar not of the Corona brand being supplied without clear explanation in response to a request for cigar of the Corona brand. In the majority of cases the defendant, would, if he exercised the right which he claims, be

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(23) L.R. 7 Ch. App. 616.

(24) 40 R.P.C. 229; 41 R.P.C. 47.

passing off goods not manufactured by the plaintiffs as goods of their manufacture." An appeal by the defendant was dismissed, Lord Justice Sarjant remarking that, where the originally exclusive denotation of an ordinary non-descriptive word mark had been extended so as to include some goods which were not of the plaintiffs' make, the onus was on the defendant to show that it had entirely lost its original meaning and that no purchaser could be deceived by the defendant using the mark.

**Distinctive marks may become *publici juris*.**—A mark which was originally distinctive may, in course of time, lose this distinctive meaning and become descriptive by common use.<sup>25</sup> This may be due to the negligence of the proprietor in asserting his rights, thereby, resulting in successful piracies, or may be due to his abandonment of the mark. Such a mark becomes the common property of the public. In deciding whether a mark has become *publici juris* the first question is, what does the mark denote. If it denotes an article made by the plaintiffs only the defendant cannot use it without taking sufficient precaution to prevent purchasers from being misled. But, if the mark denotes a particular kind of article which any one can make, the mark, though originally distinctive of the goods of a particular manufacturer, will have become *publici juris*, and any one who makes that kind of article may sell it by the name by which it is known in the trade. The test, whether a mark had become *publici juris*, which was laid down by Lord Justice Mellish in *Ford v. Foster*,<sup>1</sup> has been quoted with approval in several later cases. The question there related to a shirt called the "Eureka" shirt. The Lord Justice said: "The question is, has it become *publici juris*. And there is no doubt, I think, that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of Harvey's sauce. It was admitted that, although that originally had been the name of a sauce made by a particular individual, it had become *publici juris*, and that all the world were entitled to call the sauce they made, "Harvey's sauce", if they pleased. Then what is the test by which a decision is to be arrived at whether a word which was originally a trade mark has become *publici juris*? I think the

(25) *Wolff & Son v. Nopitsch*, 17 R.P.C. 321; 18 R.P.C. 27 "Spanish graphite" for pencils; *Woodward Ltd. v. Boulton Macro, Ltd.*, 32 R.P.C. 173 (grape water).

(1) L.R. 7 Ch. App. 616.



test must be whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade mark, the right to the trade mark must be gone."

A mark may have become *publici juris* in one country, although still retaining its distinctiveness in other countries. So in the *National Starch Manufacturing Co. v. Munn's Patent Maizena and Starch Co.*,<sup>2</sup> the Privy Council held that the invented word "Maizena" for flour had become *publici juris* in New South Wales, although the mark had been protected in other countries by legal action. Again, it is possible that a word that has become *publici juris* for one class of goods may still remain distinctive for a different class of goods. Descriptive names of new articles or patented articles after the expiration of the patent become generally *publici juris* and cannot be claimed as the exclusive property of any one trader to designate similar goods.

**Secondary meaning not acquired while there is no competition.**—In order that a word may become exclusively associated with the goods of a particular manufacturer, there must be similar goods of other manufacturers in the market. Otherwise it cannot be said that the word has acquired a secondary meaning and has become distinctive of the plaintiff's goods. "No distinction can arise from using the name of the class so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."<sup>3</sup> In the *Cellular clothing case*,<sup>4</sup> Lord Davey said: "Where a man produces or invents, if you please,

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(2). 11 R.P.C. 281. See also *Hudson's Trade Mark* (2), 24 R.P.C. 582; *Gramophone Co.'s Application*, 27 R.P.C. 689; *Device of a cat publici juris* in the gin trade, *Bagots, Hutton & Co., Ltd.'s Application*, 32 R.P.C. 333.

(3) Fry, L. J., in *Siegert v. Findlater*, 7 Ch.D. 801; See also *Marshall v. Sidebotham*, 18 R.P.C. at p. 48, *Kekewich, J.*

(4) *The Cellular Clothing Co. v. Maxton & Murray*, 16 R.P.C. at p. 409.

a new article and attaches a descriptive name to it—a name which, as the article has not been produced before has, of course not, been used in connection with the article—and secures for himself either the legal monopoly, or a monopoly in fact of the sale of that article for a certain time, the evidence of persons who come forward and say that the name in question suggests to their minds and is associated by them with the plaintiff's goods alone is of a very slender character for the simple reason that the plaintiff was the only maker of the goods during the time that his monopoly lasted, and therefore, there was nothing to compare with it, and anybody who wanted the goods had no shop to go to, and no merchant or manufacturer to resort to except the plaintiff." So in *Parsons Bros. & Co. v. Gillespie & Co.*,<sup>5</sup> the evidence was held to be not sufficient to show that the word "Flaked Oatmeal" had acquired a secondary meaning as the evidence related to a period when "nobody except the plaintiffs purported to sell goods under that name." In the "Slip-on" case<sup>6</sup> Lord Parker said "when a witness says that he knows that the word "Slip-on" as meaning, not only a particular kind of coat, but the coat of a particular manufacturer, it is material to know whether he is acquainted with the article as made by any one else. If he is not, the word, however it may be associated in his mind with the particular manufacturer, is not really to him a distinctive word."

**Difficulty in establishing secondary meaning where the manufacturer's name is used along with the trade name.**—Where the plaintiff's name is habitually used along with the trade name of his goods it is difficult to establish that the trade name has, by itself, become distinctive of his goods. In *Horlick's Malted Milk Co. v. Summerskill* Lord Shaw said: "When a name truly descriptive of an article, has always been associated with the particular name of the manufacturer, then a monopoly of the name of the article, apart from the name of the manufacturer is almost impossible to acquire; and, accordingly, it is almost impossible to succeed in a passing off action, the substantial ground of which would be the assumed possession of such a monopoly." In *Hommel v. Bauer & Co.*,<sup>7</sup> the plaintiff was selling a proprietary medicine which he called "Hommel's Haematogen", and sought to restrain

(5) 15 R.P.C. 57 (Privy Council).

(6) *Burberrys v. Cording & Co.*, 26 R.P.C. 693. See also *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, 24 R.P.C. 641.

(7) 34 R.P.C. 63.

(8) 22 R.P.C. 43.

the defendants from selling a similar product under the name "Haematogen." The action was dismissed. Vaughan Williams, L. J., said that the fact that the bottle containing the medicine was marked "Dr. Hommel's Hæmatogen" seemed to him a "most remarkable piece of evidence by the plaintiff himself going to show that 'haematogen' had not acquired this secondary meaning exclusively attaching it to Dr. Hommel's preparation. If it had acquired that secondary meaning there would be no need for this note at the side describing it as 'Dr. Hommel's Haematogen' especially on a bottle which itself calls the preparation 'Haematogen'." So also, in the Indian case *Palli Ram v. Emperor*<sup>9</sup> the Court observed that the general trend of the evidence was that the manufacturer's name was usually mentioned to designate the particular brand "Chand" or "Chand Tara" *biris* and that the complainant had therefore no exclusive right in the main features of the label.

It is, however, possible that notwithstanding the use of the plaintiff's name along with the trade name of his goods the latter may acquire a secondary meaning. In the *Imperial Tobacco Co., Ltd. v. de Pasquali*<sup>10</sup> Lord Justice Warrington observed: "The fact that a manufacturer places his name or uses his name upon or in connection with the goods as well as his trade mark does not prevent the trade mark from being used for the purpose of indicating that they are the goods of the manufacturer and in so saying I am only repeating what has already been said by Lord Justice Buckley and Lord Justice Farwell in *Andrew & Co., Ltd. v. Kuehnrich*."<sup>11</sup> And, in *Faulder & Co., Ltd. v. Rushton, Ltd.*<sup>12</sup> Vaughan Williams, L. J., said:—"A good deal was said about the name 'Faulder' always being used in connection with "Silverpan". As far as that is concerned I do not see myself that it in any way militates against the conclusion that I have come to as to the identification of the word 'Silverpan' with Faulder's."

The following are a few other illustrative cases where it was held that the trade names in question had acquired secondary

(9) A.I.R. 1931 Oudh 277.

(10) 35 R.P.C. at p. 208. "The fact that the user of a word or mark always uses it in conjunction with his own name is not conclusive to show that the word or mark cannot be claimed as a trade mark or that the user has waived his rights in it as a trade mark." Sir Basil Scott, C. J., in *The West End Watch Co. v. The Berna Watch Co.*, 35 Bom. 425.

(11) 30 R.P.C. 677 at pp. 695, 697.

(12) 20 R.P.C. at p. 493.

meaning although the names of the plaintiffs had also always been used along with them:—*Perry v. Truefitt*;<sup>13</sup> *Braham v. Bustard*;<sup>14</sup> *Ford v. Foster*;<sup>15</sup> *Wotherspoon v. Currie*;<sup>16</sup> *Powell v. The Birmingham Vinegar Brewery, Co., Ltd.*;<sup>17</sup> *Johnston v. Orr Ewing*;<sup>18</sup> *Eno v. Dunn & Co.*;<sup>19</sup> *Boord and Son v. Thom and Cameron, Ltd.*;<sup>20</sup> *Cochrane (Sir Henry) v. MacNish and Son*;<sup>21</sup> *Lavergne v. Hooper*;<sup>22</sup> *West End Watch Co. v. Berna Watch Co.*;<sup>23</sup> *Reddaway & Co., Ltd.'s cases*.<sup>24</sup>

**Geographical Names.**—The considerations which forbid the appropriation of descriptive terms as trade marks apply with equal force in the case of geographical names. As a general rule the right to use as trade description the name of a locality where the goods are manufactured or grown is a general right to which every manufacturer is entitled. A person cannot, therefore, ordinarily claim exclusive monopoly in the use of the name of a place and thereby restrain other manufacturers dealing in similar goods produced in the same area from truthfully applying the same geographical designation to their goods. For instance, the name 'Ferozabad' cannot ordinarily be appropriated by one manufacturer in respect of bangles, nor the word 'Benares' in respect of silk goods. The interests of the public also demand that such restraint in trade should not be permitted. Healthy competition will, otherwise, be stifled and a manufacturer, merely on the strength of being the first in the field, would be enabled to prevent any subsequent manufacturer doing business in the same place from lawfully using the name of the place to describe his goods.

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(13) 6 Beav. 66.

(14) 1 H. & M. 447.

(15) L.R. 7 Ch. 616.

(16) L.R. 5 H.L. 508 (1878).

(17) (1897) App. Cas. 710.

(18) (1882) L.R. 7 App. Cas. 219.

(19) 10 R.P.C. 261.

(20) 24 R.P.C. 697.

(21) 13 R.P.C. 100.

(22) 8 Mad. 149.

(23) 35 Bom. 425.

(24) *Reddaway & Co., Ltd. v. Bentham Hemp Spinning Co.*, 9 R.P.C. 503. *Reddaway v. Banham*, 13 R.P.C. 218. *Reddaway & Co., Ltd. v. Ahlers*, 19 R.P.C. 12. *Reddaway & Co., Ltd. v. Robert Stevenson & Brothers, Ltd.*, 20 R.P.C. 276. *Smidt v. Reddaway & Co.*, 32 Cal. 401. *Reddaway v. Hartley*, 48 R.P.C. 283.

**Secondary signification of geographical names.**—Notwithstanding the above general rule, cases may arise, where a geographical name becomes capable of exclusive appropriation by a particular manufacturer. A name which is primarily indicative of a place may by extensive user lose this ordinary meaning, and acquire a secondary meaning in connection with the goods of a particular manufacturer. No other person can then use this name on goods other than those made by the first manufacturer in a manner calculated to deceive the public. In such cases the geographical name has come to identify the goods of one particular person and the use of the same name by another manufacturer or seller on other goods without properly distinguishing the same from those of the former would constitute a fraud on the public. The plaintiff can therefore, legitimately insist that the manufacturers who followed him should take such reasonable precautions in using the geographical name as will prevent them from fraudulently diverting the plaintiff's custom and stealing the benefit of his reputation. Whether a certain geographical name has acquired a secondary meaning in connection with the goods of a person will depend upon the facts of the particular case. But where the fact is established the plaintiff will be entitled to prevent passing-off by others. It may be pointed out that, even where a geographical name has become distinctive of the plaintiff's goods, others will not generally be restrained from using the name of the place *per se*. All that the plaintiff is entitled to is that other competitors shall not use the same name in a manner which is calculated to mislead the purchaser. Whether a defendant has used the geographical name with such *differentiae* as will distinguish his goods from those of the plaintiff will again depend upon the facts of each case. *The Glenfield Starch case*<sup>25</sup> may be taken as an illustration where the Court was of opinion that the use of the word 'Glenfield' for starch by the defendant, was likely to create confusion in the market with the plaintiff's goods, notwithstanding that the defendant's own name had also been placed on his packets. Injunction was granted restraining the use of the word "Glenfield" upon labels on starch not manufactured by the plaintiff. But the more common form of injunction is the one ordered by the Court in *Seixo v. Provezende*.<sup>1</sup> The defendant is not absolutely prohibited from using the geographical name, but

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(25) *Wotherspoon v. Currie*, L.R. 5 H.L. 508; 42 L.J.Ch. 130.

(1) (1866) L.R. 1 Ch App. 192; 14 W.R. 357. See App. XIX for form of injunction.

may use it on his goods provided he takes reasonable precautions to prevent probability of deception. A few leading cases on this point are discussed below.

In *McAndrew v. Bassett*,<sup>2</sup> the plaintiffs who were large manufacturers of liquorice sold the same stamped with the word "Anatolia" which was the name of the tract of the country wherein liquorice root was largely grown. Injunction was granted restraining the defendant from using the name "Anatolia" on liquorice not of the plaintiffs' manufacture. It was held that the word "Anatolia" was not indicative of the origin of the liquorice and that the plaintiffs had acquired an exclusive right to the use of this word for liquorice.

In *Seixo v. Provezende*,<sup>3</sup> the plaintiff, a Portuguese wine merchant, had a vine yard known as the Quina de Seixo in a district in Oporto, called Seixo. The wine was sold in casks stamped with a crown and eagle and the word "seixo", from which his wine came to be known in the London market as "Crown Seixo" wines. The defendant had also a vine yard in the Seixo district and he put his wines on the London Market in casks which were stamped with a crown and the words "Seixo de Cima". It was contended that the plaintiff had no right to the monopoly of the term "Seixo", and that the defendant had as much right to use it as the plaintiff. Injunction was, nevertheless, granted by Wood, V.C., restraining the defendant from using the crown and the word "Seixo", or any other marks, in a manner likely to cause his wines to be mistaken for the "Crown Seixo" wine. But the injunction was not to extend to the absolute prohibition of the term "Seixo", but only to its use in a manner without clearly distinguishing the defendant's wine from the "Crown Seixo" wine sold by the plaintiff. This form of the injunction was confirmed on appeal by Lord Chancellor Cranworth and has been adopted in several later cases.

In *Lee v. Haley*<sup>4</sup> the plaintiffs were coal merchants trading as "The Guinéa Coal Co.," while the defendant, a former manager of the plaintiffs' business, set up independent business as the "Pall Mall Guinea Coal Co.," at Beaufort Buildings, Strand, and afterwards removed to 46, Pall Mall. There was evidence of deception of some of the customers of the plaintiffs. Injunction was granted

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(2) 4 De G.J. & S. 380; 33 L.J.Ch. 561; (1864).

(3) (1866) L.R. 1 Ch. 192; 14 W.R. 357.

(4) L.R. 5 Ch. 155; 18 W.R. 242.

and confirmed on appeal. Giffard, L.J., said: "It has been strongly urged here that if this injunction is sustained the defendant's trade will be stopped, but that is not so; his trade will not be stopped in the least, he will only be restrained from selling under this particular name. He may sell in Pall Mall coals at a guinea per ton to his heart's content; the only thing he may not do is to use a name which is calculated to induce customers to come to him under the supposition that they are going to the plaintiffs."

In *Siebert v. Findlater*<sup>5</sup> the plaintiff commenced manufacturing in 1830, at Angostura, in Venezuela, a fluid which he termed "Aromatic Bitters". The fluid came to be generally known as "Angostura Bitters". In 1870, one Dr. Meinhard commenced manufacturing at this place a similar medical preparation and sold them as "Angostura Bitters". The labels were marked "Angostura Bitters" prepared by Teodoro Meinhard, Ciudad Bolivar, formerly Angostura". The successors in business of Dr. Siebert who had, in 1875, removed their business to Port of Spain in Trinidad adopted the term "Angostura Bitters" for the first time and brought an action to restrain the infringement by the English agents of Dr. Meinhard. It was held by Fry, J., that Meinhard's conduct was calculated to deceive, and that, although the plaintiff was not entitled to the exclusive use of the term "Angostura", an injunction should be granted restraining the defendant from using the word "Angostura", or the words "Angostura Bitters" in a manner calculated to deceive.

**Glenfield Starch case.**—The question of secondary signification of geographical names was discussed at length in the well-known *Glenfield Starch case*.<sup>6</sup> The plaintiffs were making starch originally at Glenfield. They later moved to another place, and had been selling for more than twenty years starch made there as "Glenfield; Patent double refined powder starch". The article became well-known as "Glenfield Starch". The defendant with fraudulent motive obtained possession of a small plot of ground at Glenfield, and began to make starch there. This was sold in packets which were marked, "The Royal Palace double refined patent powder starch, Currie & Co., starch and flour manufacturers, Glenfield", the name "Glenfield" appearing in large and prominent letters. It was contended that no person can acquire

(5) (1878) 7 Ch.D. 801; Seb. Dig., p. 359.

(6) *Wotherspoon v. Currie*, L.R. 5 H.L. 508; 42 L.J.Ch. 130.

exclusive monopoly in the name of a place so as to prevent other manufacturers carrying on business in the same place from putting the name of the place on the articles produced there. Injunction was, however, granted by Malins, V. C., restraining the defendant from using the word 'Glenfield' in connection with his starch. On appeal the injunction was dissolved, but, on further appeal, the House of Lords restored the judgment of Malins, V. C. In his learned judgment Lord Chancellor Hatherley observed: "There was nothing whatever to give particular celebrity to the name of Glenfield so connected with a starch manufactory, beyond the fact that the appellants had manufactured an article known by that name and having a very large sale under that name. . . . That being so, it appears to me that the respondent, if he was an honest manufacturer setting up in business, would take great care, and all the more because he was setting up business in a place where "Glenfield Starch" had been manufactured and sold, to disconnect his name with any name which had become exclusively a designation of an article manufactured by the appellants." Lord Chelmsford said: "I am satisfied by the evidence that the respondent's object in getting possession of a small piece of standing ground, I may call it, at Glenfield, was for the purpose of commencing operation by acquiring a right to mention Glenfield in his advertisements, and that he followed this up by trying how near he could come to a deceiving resemblance of the appellants' labels, and be safe from a charge of piracy. By prominent mention of Glenfield in his labels, and by the representation of his agent, he succeeded in passing off the starch as "Glenfield starch" and it appears by the evidence that he has succeeded in drawing off from the appellants a great number of their customers." And Lord Westbury observed: "I take it to be clear from the evidence that long antecedently to the operations of the Respondent, the word "Glenfield" had acquired a secondary signification or meaning in connection with a particular manufacture; in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word "Glenfield," therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch. Now the question is, has that property been invaded by the respondent. I take the whole proceedings of the respondent from the beginning to the end to be



nothing in the world more than a contrivance for the purpose of getting the word "Glenfield" associated with his manufacture. I have no doubt, therefore, that this case comes within the principle on which the jurisdiction is founded, the principle being to prevent a party from fraudulently availing himself of the trade mark of another which has already obtained currency and value in the market, by whatever means he may devise for the purpose, provided the means are devised in order to give him a colourable title to the use of the word, and provided it be shown from the manner in which he has employed those means that his object was from the beginning to invade the property of the appellants."

**The Stone Ale case.**—*Montgomery v. Thompson* is a similar case. The plaintiffs (Respondents in the House of Lords) and their predecessors had been manufacturing ale at Stone for over 100 years and their ales had long been known in the trade as "Stone ales" and their brewery which was the only one for many years was known as "Stone brewery." The defendant, Thomas Montgomery, a publican at Liverpool who had been selling the plaintiffs' "Stone ale" at his place of business, subsequently built a brewery at Stone and proposed to call it "Stone Brewery" or "Montgomery's Stone Brewery" and to sell ale made there as "Stone ales." It was pleaded in defence that the reason for building the brewery at Stone was due to the excellent quality of the water there. Injunction was granted by Chitty, J., and it was held by both the Court of Appeal and the House of Lords that the injunction was rightly granted. Lord Herschell said: "I do not think the principle on which the Court ought to act in such a case as the present is open to doubt. The respondents are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so, because the practical effect of such restraint may be much the same as if the persons seeking the injunction had a right of property in a particular name. It appears to me to be idle to argue in opposition to the injunction that it is against the public interest to permit a monopoly of the use of the name of a town for trade purposes, when the only effect of allowing its use by the person and for the purpose sought to be restrained, would be to deceive the public." Lord Macnaghten

said: "It is not the first time in these cases that water has got an honest man into trouble and then failed him at the pinch. Neither Mr. Justice Chitty, nor the learned Lord Justices could be persuaded that the appellant was attracted to Stone by the peculiar virtue and chemical properties of water. They thought he went there simply with the object of stealing the plaintiff's trade, and in the hope of reaping where he had not sown. They were satisfied that he meant to make a fraudulent use of the term "stone ales" and that he could not possibly use that term honestly." And, Lord Hannen said: "The appeal to this House is based on the contention that the word "Stone" in connection with ale or beer, is merely used by the appellant in a geographical sense, as indicating that the ale or beer is manufactured at that place, and that any one is entitled to use it in that sense provided he does not use it so as to induce the belief that his goods are the goods of manufacturers previously established at Stone. The principle contended for by the appellant may be admitted as correct but in considering what may induce purchasers to believe that the appellant's goods are the goods of the respondents, all the circumstances of the case must be taken into account. Here the evidence has satisfied Justice Chitty and the Court of Appeal, and, I think, ought to satisfy your Lordships, that the respondents' goods had acquired by long usage the name of "Stone ale" and "Stone ales", that that name does not merely convey the idea that the beer was manufactured at Stone, but that it was ale of the respondents' manufacture. The appellant is undoubtedly entitled to brew ale at Stone, and to indicate that it was manufactured there, but there are various means of stating that fact without using the name which has now become the designation of the respondents' ale."

**Worcester Royal Porcelain Co., Ltd. v. Locke & Co.**—The "Stone ale" case was followed in *Worcester Royal Porcelain Co., Ltd. v. Locke & Co.*<sup>8</sup> The original factory of China and porcelain known as "Worcester" or "Worcester China" was founded at Worcester in 1751. Thereafter, one or two other firms manufacturing "Worcester" were started in the same place. Since 1889, the plaintiffs who claimed to be the successors of all these firms had been the only manufacturers of "Worcester." In 1897, the defendants started a new factory at this place and commenced selling "Worcester China". It was shown that there were no special natural advantages at Worcester for the manufacture of China

and that productions of the makes were not limited to any particular design. It was held that the word "Worcester" as applied to China and porcelain had acquired a secondary meaning as denoting the goods made by the plaintiffs at one or other of their factories to the exclusion of all other manufacturers of China and that the plaintiffs were not disentitled to relief by reason of the fact that some of their goods were described as "Royal Worcester" or "Graingers' Worcester China". Although no actual case of fraud was proved injunction was granted on the ground that the defendants' action was calculated to deceive the public.

**Saxlehner v. Apollinaris Co.**—In *Saxlehner v. Apollinaris Co.*,<sup>9</sup> the defendants were the sole importers, under a contract with the plaintiff, of Hungarian bitter water obtained from the plaintiff's spring known as "Hunyadi Janos". This water came to be popularly known in England under the name "Hunyadi" or "Hunyadi Janos". After the termination of the contract the defendant company began selling under the name "Apenta" another Hungarian bitter water said to be obtained from a spring in the neighbourhood of the plaintiff's. The label used with this water was different in colour from that adopted for the old "Hunyadi", but the name "Hunyadi" appeared conspicuously in several places. The plaintiff, thereupon, brought an action for passing-off and consequential relief. It was held that the word "Hunyadi" had acquired a secondary signification in England for Hungarian bitter water, notwithstanding that the name might have a geographical meaning in Hungary, as alleged by the defendants, and that the plaintiff was, therefore, entitled to an injunction,

The following geographical names have been held to be distinctive in respect of the goods with which they were used:—

"Bodega" for wines;<sup>10</sup> "Eldestino" for cigar;<sup>11</sup> "Reading" for biscuits;<sup>12</sup> "Yorkshire" for sauce;<sup>13</sup> "Magnolia" for metal bearings;<sup>14</sup> "Apollinaris" for mineral water;<sup>15</sup> "Oswego"

(9) 14 B.P.C. 645.

(10) *Bodega Co. (Limited) and Riviere v. Owens*, 7 R.P.C. 31.

(11) *Pinto v. Trott*, 8 R.P.C. 173; *Pinto v. Badman*, 8 R.P.C. 181.

(12) *Huntley and Palmer v. Reading Biscuit Co., Ltd.*, 10 R.P.C. 277.

(13) *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, 12 R.P.C. 496; 13 R.P.C. 235; 14 R.P.C. 720.

(14) *Magnolia Metal Co.'s Trade Marks*, 14 R.P.C. 265, 621.

(15) *Application of the Actien Gesellschaft Apollinaris Brunnen Formals Georg Kreuzberg*, 24 R.P.C. 436.

for corn flour, (Oswego being the name of a place in the United States where the applicants' factories were situated);<sup>16</sup> "Chartreuse" for liqueur;<sup>17</sup> "London" for candles in the Morocco market;<sup>18</sup> "California" syrup of figs for medicinal preparation;<sup>19</sup> "Itala" for motor cars;<sup>20</sup> "Crystal Palace" for fire works;<sup>21</sup> "Karlsbader Wasser" for Karlsbad waters;<sup>22</sup> "Berna" for motor cars;<sup>23</sup> and "Tyne brand" for canned fish, fish and meat pastes.<sup>24</sup>

On the other hand, injunction was refused in the following cases as secondary signification was not established in respect of the geographical names:—*Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*;<sup>25</sup> *Grand Hotel Co., of Caledonia Springs, Ltd. v. Wilson*;<sup>1</sup> *Hopton Wood Stone Firms, Ltd. v. Gething*;<sup>2</sup> *Whitstable Oyster Fishery Co. v. Hayling Fisheries, Ltd.*<sup>3</sup>

**Classification of geographical names.**—Geographical names which are used as trade descriptions may be classified under the following headings:—

(1) Names which have been accepted by common usage as devoid of any geographical meaning and are merely descriptive of the goods. These are common to the trade and cannot acquire secondary meaning, e.g., German silver, Eau de Cologne, Indian ink, Portland cement, Prussian blue.

(2) Names which have lost their geographical meaning and have acquired a secondary signification in connection with the business of a particular manufacturer. The defendant cannot in these cases plead in defence that his manufactory is situated in the place, the name of which he is using. This exclusive

(16) *Application of National Starch Co.*, 25 R.P.C. 802.

(17) *Rey v. Lecouturier*, 25 R.P.C. 265.

(18) *Price's Patent Candle Co., Ltd. v. Ogston and Tennant, Ltd.*, 26 R.P.C. 797.

(19) *Application of California Fig Syrup Co.*, 26 R.P.C. 436, 846.

(20) *Itala Fabbrica Automobili's Application*, 27 R.P.C. 493.

(21) *Brock & Co.'s, Crystal Palace Fireworks, Ltd. v. Pain & Sons*, 28 R.P.C. 461, 697.

(22) *Application of the Community of the City of Karlsbad*, 29 R.P.C. 162.

(23) *Berna Commercial Motors, Ltd.'s Application*, 32 R.P.C. 113.

(24) *Shield Ice and Cold Storage Co.'s Application*, 40 R.P.C. 197.

(25) 8 R.P.C. 241; 9 R.P.C. 46.

(1) 21 R.P.C. 117.

(2) 27 R.P.C. 605.

(3) 18 R.P.C. 434.

right of the plaintiff to use the name of the place is not lost even after he moves his business to a place outside that locality. Examples of some decided cases dealing with this class of geographical names have already been discussed.

(3) Names which still retain their primary geographical signification. Such names when used as trade descriptions serve to indicate to the public the locality from which the goods come and shall not, therefore, be used on goods which are not actually made in the locality.<sup>4</sup> Geographical names belonging to this class cannot be claimed by any single trader exclusively to describe his goods on the plea that he was the first so to use the name. So, in the *Anatolia liquorice case*,<sup>5</sup> Wood, V.C., observed. "It is not like the case, which I put myself, of there being some district which is the only district from which a well-known wine such as "Burgundy" is imported, and the first importer calls it "Burgundy." Although, he may have stamped "Burgundy" on his corks for twenty years, he could not prevent anybody else from calling a wine produced in Burgundy by the name of the place from which it was imported." False indications of origin are offences under the Merchandise Marks Act and are dealt with in Chapter XI.

**Geographical names of natural products.**—A person who owns and controls exclusively the source of a natural product, such as a spring of mineral water, is entitled to the sole use of the name of the source to describe the product obtained from it. In the example given, no other person will be allowed to use the name of the spring on mineral water not obtained from this place. Indeed, this limitation applies against the owner himself of the spring in question. The mark in this case distinguishes the water from the spring, in whosoever hands the spring may be. If, therefore, the spring gets dry or is sold to another or when the production of water is no longer remunerative, the original owner of the spring will not be allowed to continue the use of the name of the spring on other mineral waters.<sup>6</sup> So, in a case where the proprietors of the well-known Apollinaris spring in Germany applied to register the word "Apollinaris" in respect of mineral water, the applicants were required to give an undertaking not to use the mark except in respect of water from the applicants' property at Neunhar-

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(4) See Chap. XI.

(5) *McAndrew v. Bassett*, 33 L.J.Ch. 561.

(6) Such false trade description would constitute an offence under the Merchandise Marks Act.

where the Apollinaris springs were situate, or in the neighbourhood thereof.<sup>7</sup> Again, mining companies operating in the same area generally adopt names having reference to the geographical name of that area coupled with some distinguishing words.<sup>8</sup> The mere use of the geographical name as part of their trade names may not, in these cases, be calculated to cause confusion in the minds of the public. A few illustrative cases are given below:—

In *Whitstable Oyster Fishery Co. v. Hayling Fisheries, Ltd.*,<sup>9</sup> it was held that the term “Whitstable oysters” indicated a certain class of oysters recognisable by the trade, and that oysters answering to that description and cultivated by the defendant at Whitstable could be properly described as Whitstable oysters. The decision was affirmed on appeal. Lord Justice Collins pointed out that in the case of a “natural product coming from and described by reference to a particular district” the difficulty in proving secondary signification is even greater than in the case of other descriptive marks,<sup>10</sup> “particularly where the whole district from which the product comes is not in the exclusive ownership of the person who seeks to attach to it the secondary signification.” In *Grand Hotel Co. of Caledonia Springs Ltd. v. Wilson*<sup>11</sup> the springs owned by the plaintiffs were called “Caledonia springs” and the locality was also known by that name. The defendant tapped two springs on adjoining land which yielded water of the same quality as that from the plaintiffs’ springs. It was held by the Privy Council that the plaintiffs did not have an exclusive right to the use of the word “Caledonia” in connection with these waters and that the defendants were entitled to indicate the local source of the waters sold by them. In the *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*,<sup>12</sup> it was held that the expression “Rugby Portland cement” was well known in the trade to describe the cement made from the stratum of blue lias limestone existing in the neighbourhood of Rugby and that there was consequently no misrepresentation by the defendants. It was similarly held in

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(7) *Actien Gesellschaft Apollinaris Brunnen's Application*, 24 R.P.C. 436.

(8) *Tigon Mining and Finance Corporation Ltd. v. South Tigon Mining Co., Ltd.*, 48 R.P.C. 526.

(9) 18 R.P.C. 434.

(10) *Cellular Clothing Co. v. Maxton & Murray*, 16 R.P.C. 397.

(11) 21 R.P.C. 117.

(12) 8 R.P.C. 241; 9 R.P.C. 46 (C.A.).

*Hopton Wood Stone Firms Ltd. v. Gething*<sup>13</sup> that the name "Hopton wood" and "Hopton stone" denoted the character and the quality of the stone only.

In *Braham v. Beachim*<sup>14</sup> the plaintiff, who was the owner or lessee of practically all the collieries within the parish of Radstock, was carrying on business as "The Radstock Coal Company." The defendants also commenced to do similar business under the same name though they were not entitled to raise coal within the parish of Radstock, nor in any part of the district in which the seams of the Radstock coal existed. The plaintiff then changed the name to "The Countess Waldegrave's Radstock Collieries," whereupon the defendants adopted the name "The Radstock Colliery Proprietors." It was held that the defendants were not entitled to call themselves "The Radstock Colliery Proprietors" since the designation indicated to the public that they were selling coal obtained in Radstock which was not true. Mr. Justice Fry said: "The fact that a vein of Radstock coal runs out of parish of Radstock does not entitle all workers of it to describe themselves as Radstock Colliery Proprietors. The genus includes the species and by using name of Radstock Coal Proprietors defendants represented themselves as selling coals of plaintiff and others which come under description Radstock Coal." An injunction was granted, but it was not to apply if the defendants became owners or lessees of any colliery in the Radstock parish. After the decision in the above case the defendants acquired a colliery, though not in Radstock, and carried on business under the style "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset." Motion by plaintiffs to commit the defendants for breach of the injunction was refused,<sup>15</sup> as the court was of opinion that the name complained of, indicated no more than that the defendants' place of business was located at Radstock, which they were entitled to state.

An injunction of a restricted nature was granted also in *Bewlay & Co. v. Hughes*.<sup>16</sup> Although the word "Dindigul" was held to have acquired a secondary signification in respect of the plaintiff's cigars, the order was not to prevent the defendant from describing any cigars sold by him, which were made from "Dindigul" tobacco, as being so made.

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(13) (1910) 27 R.P.C. 605.

(14) (1878) 7 Ch.D. 848; Seb. Dig., p. 365 (S.C.).

(15) *Braham v. Beachim* (2), (1878) 7 Ch.D. 848; Seb. Dig., p. 388

(Fry, J.).

(16) (1898) 15 R.P.C. 290.

**One class of plaintiff's goods passed off for another.**—Where a plaintiff uses different trade marks to distinguish articles of different grades manufactured by him a person shall not sell an inferior article of the plaintiff's manufacture as one of superior quality. In such cases a fraud is committed on the public who may be induced to buy the inferior for the superior article. At the same time an injury to the plaintiff's trade is caused as such acts are likely to lead to unjust destruction of confidence that the public have in the quality of the plaintiff's goods. The law was stated in *Spalding and Bros. v. Gamage Ltd.*,<sup>17</sup> by Lord Parker thus: "The proposition that no one has a right to represent his goods as the goods of somebody else, must I think, as has been assumed in this case, involve as a corollary the further proposition, that no one, who has in his hands the goods of another of a particular class or quality, has a right to represent these goods to be the goods of that other of a different quality or belong to a different class.... A cannot, without infringing the rights of B, represent goods which are not B's goods or B's goods of particular class or quality to be B's goods or B's goods of that particular class or quality." So, in *Teacher v. Levy*<sup>18</sup> an inquiry as to damages was ordered and an injunction was granted restraining the defendants from selling inferior whisky of the plaintiffs' manufacture as the latter's whisky of special quality, known as "Teachers' Highland Cream Whisky." And, in *Jameson & Son, Ltd. v. Clarke*<sup>19</sup> the defendant was restrained from selling the plaintiffs' three years old whisky as their seven years old one. In *Palestine Wine and Trading Co., Ltd. v. Cohen & Co.*,<sup>20</sup> the defendants bought the genuine brandy of the plaintiffs' manufacture and sold them after dilution, as the plaintiffs' brandy. Injunction was granted with costs. In *Westinghouse Brake and Saxby Signal Co., Ltd. v. The Varsity Eliminator Co., Ltd.*,<sup>21</sup> the defendants' rectifier was built up of genuine Westinghouse parts, but the number of such parts was less than that built into a genuine rectifier of the plaintiffs. It was alleged that the altered rectifier was of inferior construction and its sale would injure the plaintiffs' reputation. An injunction was granted.

(17) (1915) 32 R.P.C. at p. 284; 84 L.J.Ch. 449; 31 T.L.R. 328 H.L.).

(18) (1905) 23 R.P.C. 117.

(19) (1902) 19 R.P.C. 255. See also *Champagne Heidsieck et cie v. Scotta and Bishop*, (1926) 43 R.P.C. 101, where injunction was granted restraining the sale of wine of the quality prepared for continental consumption (Dry monopoly) as wine prepared for consumption in England.

(20) 23 R.P.C. 568.

(21) 52 R.P.C. 295.



On the other hand, action was dismissed with costs in *Paquin Ltd. v. John Barker & Co., Ltd.*,<sup>22</sup> where the defendants advertised for sale "exclusive original Paquin models" of the plaintiffs' at a "mere fraction of the original cost." The coat complained of had been originally made and sold by the plaintiffs to an American firm who had it copied. The coat was sent back to England by the American firm and was subsequently purchased by the defendants.

Where the plaintiff alleges that his inferior goods have been passed off as of a superior class of his goods he must prove the existence of the two classes of goods and their reputation.<sup>23</sup> In the words of Warrington, J., he must "be able to define the goods for which the incriminated goods are passed off."<sup>24</sup>

**Sale of second-hand goods.**—The passing-off may consist in selling, or offering for sale, second-hand goods of the plaintiff's manufacture as and for his new goods. In such cases there would obviously be serious risk of loss of reputation to the plaintiff's goods and consequent diminution in their sales as the second-hand goods cannot be expected to give the same satisfaction as the new articles. Where second-hand goods are offered for sale the defendant must indicate sufficiently the nature of the goods, so that an ordinary purchaser may not be misled into buying them, believing them to be the new goods. Otherwise, an injunction will be granted. Thus, in *Gillette Safety Razor Co. v. Franks*<sup>25</sup> and in *Gillette Safety Razor Co. v. Diamond Edge, Ltd.*,<sup>1</sup> the defendants in the actions were restrained from selling re-sharpened used gillette blades as the genuine blades. In *Richards v. Williamson*<sup>2</sup> the defendant purchased as old iron, the lock plates of the condemned or worn out guns of the plaintiff, and made them up into fire arms allowing the plaintiff's trade mark to remain on the lock

(22) (1934) 51 R.P.C. 431.

(23) *Hunt, Roope, Teage & Co. v. Ehrmann Bros.*, (1910) 2 Ch. 198; 103 L.T. 91; 27 R.P.C. 512; *Dunbar v. Holland Bombay Trading Co.*, 12 S.L.R. 129; *Harris v. Warren & Phillips*, (1918) 35 R.P.C. 217; 87 L.J.Ch. 491; 119 L.T. 217.

(24) *Hunt, Roope, Teage & Co. v. Ehrmann Bros.*, (1910) 2 Ch. 198; 103 L.T. 91; 27 R.P.C. 512.

(25) (1924) 40 T.L.R. 606; 41 R.P.C. 499.

(1) (1926) 43 R.P.C. 310. See also *Spalding (A.G.) & Bros. v. A.W. Gamage Ltd.*, (1913) 31 T.L.R. 328; 30 R.P.C. 388 where the defendants bought the plaintiffs' 'orb balls' which had been sold to a waste rubber dealer and advertised them for re-sale.

(2) (1874) 22 W.R. 765; Seb. Dig., p. 264.

plates and levers, so as to induce the public to believe that the fire arms were manufactured by the plaintiff. Injunction was granted.

Where it is alleged that the defendant had been passing off second-hand articles of the plaintiff it will be material to consider the nature of the locality, of the shop, and of the goods sold. As Mr. Justice Maugham pointed out in a recent case<sup>3</sup> there are shops which deal only in second-hand jewellery where the purchaser would be a fool if he thought that when he asked for a gold necklace or chain he was going to get a new one. The same thing applies with regard to many other articles such as motor cars, books, etc. Where the goods are jumbled up with other goods in the shop window and are offered for sale at considerably reduced prices, an ordinary purchaser, without specifying new articles, cannot expect that he would get a new article. An action for passing off was, thus, dismissed with costs in *The General Electric Co., Ltd. v. Pryce's Stores*<sup>4</sup> where the court held that the nature of the defendants' business was such that the inference might be drawn that the defendants' purchasers expected to receive only second-hand lamps.

**Quality of the defendant's goods immaterial.**—It is immaterial that the goods passed off are equal to, identical or superior to the plaintiff's goods. For, it is the mark that sells the goods and any inference of the purchaser as to their quality is from the association of the mark with the goods. Besides, in most cases the ordinary purchaser does not compare the two goods or test their quality. The buyer of an article is the best judge of his interests and it must be presumed that, when he asks for an article of a particular make or manufacture, it is, because, that make has given him satisfaction or he expects it to do so. Thus, it is possible that the customer would have bought the plaintiff's article, notwithstanding, that it is no better than the defendant's. And, with the idea of purchasing an article of the plaintiff's make he should not be misled into buying the article of a different make by reason of the similarity of the marks on the two articles. The question is not whether the other article would serve his purpose equally well. As was said by an American judge, "If a man wants an article of oak, and gets an article of deal, and pays an oak price, it is no answer to say that deal would do as well." Thus, in the early case *Blofeld v. Payne*,<sup>5</sup> although the finding of the jury was that the hones sold by the

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(3) *The General Electric Co., Ltd. v. Pryce's Stores*, 50 R.P.C. 232.

(4) 50 R.P.C. 232.

(5) (1833) 4 B. & Ad. 410; 110 E.R. 509; Seb. Dig., p. 24.

defendants were not inferior to the plaintiff's, it was held that the plaintiff was entitled to damages. In *The Glenfield Starch case*<sup>6</sup> it was contended by the defendant that there was no reason in the world why he should take the name of the plaintiff, as the starch manufactured by him was superior to that of the plaintiff's manufacture. The Lord Chancellor, however, dismissed the plea with the significant observation, "Well, then, one naturally asks, why should he do anything to lead people to suppose that his name is to be in any way associated with Glenfield or this inferior article with his." In *The Chartreuse case*<sup>7</sup> Lord Shaw similarly remarked, "whether the business and efforts of Lecouturier's assignees working in the old locality, have succeeded in producing a liqueur as good or better, appears to me to be irrelevant." In *Vokes Ltd. v. Evans and Marble Arch Motor Supplies, Ltd.*,<sup>8</sup> the plaintiffs had been selling motor car windscreen wipers with the words "Vokes Folberth." These were manufactured for them by an English company under an agreement which prohibited the company from making such wipers to persons other than the plaintiffs; but the manufacturers wrongfully sold a number of such wipers to the defendants. The articles were in every respect identical with the plaintiffs' article and contained the same inscriptions on them. It was held that the wipers complained of were spurious, as they were not selected or marketed by the plaintiffs, and that the sale thereof by the defendants constituted actionable passing off.

Where the defendant's goods are not inferior, there can obviously be no injury to the plaintiff's reputation and he cannot claim any special damage on that account.

**Substitution of goods.**—Substitution is one of the common methods by which goods of one person are passed off as and for the goods of another. Thus, in *Kodak, Ltd. v. London Stereoscopic and Photographic Co., Ltd.*,<sup>9</sup> the defendants had supplied to customers rolls of films not of the plaintiffs' manufacture in response to written and verbal orders for "Kodak films" and Brownie films";

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(6) *Wotherspoon v. Currie*, (1872) L.R. 5 H.L. 508; 27 L.T. 393. See also *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1897) A.C. 710; 14 R.P.C. 720; *Sazlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; 14 R.P.C. 645.

(7) *Rey v. Lecouturier*, (1910) A.C. 262; 27 R.P.C. 268.

(8) (1931) 49 R.P.C. 140. See also *Catterson & Sons, Ltd. v. Anglo Foreign Manufacturing Co., Ltd.*, (1910) 28 R.P.C. 74.

(9) (1903) 19 T.L.R. 297; 20 R.P.C. 337. See also *Pearson Bros. v. Valentine & Co.*, (1917) 34 R.P.C. 267.

in *Burroughs, Wellcome & Co. v. Thompson and Capper*<sup>10</sup> the defendants had been supplying drugs not of the plaintiffs' manufacture in response to orders and prescriptions for the plaintiffs' "tabloids" drugs; and, in *Minimax Ltd. v. Moffat*<sup>11</sup> the defendant sold "minimax" refills of his make for the plaintiff's minimax fire extinguishers. Cases of this kind are, generally, cases of fraud and, therefore, injunction will be ordinarily granted. Where passing off by substitution is alleged by the plaintiff, he must show, that the defendant was clearly informed of what the customer wanted,<sup>12</sup> that the trade description or name of the goods ordered represented exclusively the plaintiff's goods, and that the goods which were not of the plaintiff's manufacture were substituted fraudulently.<sup>13</sup>

The defendant is liable, ordinarily, for passing off in cases of fraudulent substitution by his servants in the ordinary course of their employment, although such substitution may be committed without his knowledge and in some cases even against his orders.<sup>14</sup> It is immaterial that there was no intention to deceive<sup>15</sup> the public or that the sales were small.<sup>16</sup> Injunction may not, however, be issued where the court is satisfied that the defendant had taken all reasonable precautions to prevent the occurrence of the act

(10) (1904) 1 Ch. 736; 21 R.P.C. 69. See also *Parozone Co., Ltd. v. Gibson*, (1904) 21 R.P.C. 317; *Kerfoot v. Cooper Ltd.*, (1908) 25 R.P.C. 508; *Havana Cigar and Tobacco Factories Ltd. v. Tiffin Ltd.*, (1909) 26 R.P.C. 473; *Cusenier Fils, & Co. v. Gaiety Bars and Restaurant Co., Ltd.*, (1902) 19 R.P.C. 337; *Goddard v. Watford Co-operative Society, Ltd.*, (1924) 41 R.P.C. 218.

(11) (1935) 52 R.P.C. 340.

(12) *Peters Ltd. v. Domestic Inventions Co.*, (1908) 25 R.P.C. 387. It is not the duty of the purchaser to examine and satisfy that the goods supplied were the goods which he asked for. "If a man makes a representation it is no answer at all for him to say: 'If reliance had not been placed upon the representation, but if due examination had been made by the person to whom the representation was made, he would not have been deceived.'" *Peterson, J., in Pearson Bros. v. Valentine & Co.*, (1917) 34 R.P.C. 267.

(13) *Godfrey Phillips Ltd. v. Russell*, (1909) 26 R.P.C. 834, where the action was dismissed as the defendant had never sold any tobacco other than the plaintiffs', when asked for 'Grand cut.'

(14) *Grierson, Oldham & Co., Ltd. v. Birmingham Hotel and Restaurant Co., Ltd.*, (1901) 18 R.P.C. 158; *Monro v. Hunter*, (1901) 21 R.P.C. 296; *Bovril Ltd. v. Bodega Co., Ltd.*, (1916) 33 R.P.C. 153; *Havana Cigar and Tobacco Factories, Ltd. v. Tiffin*, (1909) 26 R.P.C. 473. See Master and Servant, Chapt. XI.

(15) *O.T., Ltd. v. Cumming & Co.*, (1914) 32 R.P.C. 69.

(16) *Parozone Co., Ltd. v. Gibson*, 21 R.P.C. 317.

complained of,<sup>17</sup> or where only a few isolated sales had occurred due to the ignorance or inadvertence of the defendants' servants and there was no reasonable apprehension of any future injury to the plaintiffs' business.<sup>18</sup>

Substitution may not in certain cases amount to passing off. For instance, when a customer asks for a particular article and that article is not in stock a trader may explain that the goods asked for are not in stock and may offer other goods in substitution. In these circumstances the trader cannot be accused of any unfair act. "If *A* orders from *B* specified goods and then *B* sends different goods a cause of action arises in *A*. With that we are not here concerned. If *A* keeps the goods and does not return them, it may be either that he keeps them believing that they are what they are not, or because he is satisfied with them. In a passing off action, if the plaintiff relies upon evidence that goods, other than the plaintiff's goods, were sent and were not returned, he must go on to prove that the purchaser retained them believing them to be what they are not."<sup>19</sup> *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*,<sup>20</sup> is an illustrative case. In that case a co-operative society in supplying a list of orders from a regular customer supplied their own soap instead of the plaintiffs' soap which was not stocked by the Society. They did so in the belief that if the customer could not get the soap he asked for he would prefer to get the substituted soap rather than to get no soap at all. An action for passing off was dismissed. The rule was explained by Lord Justice Moulton in the following passage: "The person whose goods you order has nothing to do with the fulfilment of that order. If with the consent of the purchaser other goods are supplied instead, he has got no right to complain. His rights arise from the deception of the customer, that passing off on the

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(17) *Montgomery & Co., Ltd. v. Young Bros.*, (1904) 21 B.P.O. 285; *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, (1912) 106 L.T. 472; 29 R.P.C. 225 (C.A.).

(18) *Leahy, Kelly and Leahy v. Glover*, (1893) 10 R.P.C. 141; *Rutter & Co. v. Smith*, (1901) 18 R.P.C. 49; *Carr & Sons v. Crisp & Co., Ltd.*, (1902) 19 R.P.C. 497; *Montgomery & Co., Ltd. v. Young Bros.*, (1904) 21 R.P.C. 285; *Moseley & Sons, Ltd. v. Nathan & Co.*, 23 R.P.C. 345; *Kodak Ltd. v. Grenville*, (1908) 124 L.T.J. 458; 25 R.P.C. 416; *Burberrys v. Watkinson*, (1906) 23 R.P.C. 141; *Armstrong Oiler Co., Ltd. v. Patent Axle-box & Foundry Co., Ltd.*, (1910) 27 R.P.C. 362; *O. T. Ltd. v. Cumming & Co.*, (1914) 32 R.P.C. 69.

(19) Per Buckley, L. J., in *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, and *Benjamin Brookes & Co., Ltd. v. Masbro' Equitable Pioneers Society Ltd.*, (1912) 106 L.T. 472; 29 R.P.C. 225.

(20) loc. cit.

customer goods which he thinks are goods of the plaintiff, when, in fact, they are not. Substitution may, therefore, be perfectly innocent, or it may be perfectly guilty; but the test whether it is innocent or guilty is not the mere fact of substitution, but whether or not it comes within the definition of what is passing off, which has been laid down so often in the courts."

The circumstances under which substitution will or will not amount to passing-off were summed up by Eve, J., as follows:—"When the customer asks for a particular article and that article is not in stock, the honest tradesman, of course, explains to him that it is not in stock and offers his own goods in substitution. If he does that honestly in a way which conveys the whole matter to the mind of the customer, he need be under no fear of a motion to commit or attach being successful against him. If, on the other hand, he does it in this way, that he wraps up the article and mumbles something to himself and hands it to the purchaser, then . . . of course, the court has no hesitation in saying that there was not a fair opportunity given to the purchaser to choose between the two rival articles, and that the purchaser was more or less rushed into buying, instead of what he asked for, something he did not intend to buy."<sup>21</sup>

**Area of reputation of trade marks and trade names.**—In deciding whether a trade mark has acquired secondary signification the extent to which the said mark or name has already been used forms an important factor for consideration. It is obvious that where the user has been short, spasmodic or limited to small local areas the mark cannot have acquired any reputation. But what the test should be in such cases it is impossible to define *a priori*. This will depend on the facts of each case. The nature of the mark and the goods on which it is applied will have to be taken into consideration. In such cases the plaintiff will be required to show that the area over which his mark has acquired a secondary signification is as large as possible. So, in the *Perfection case*,<sup>22</sup> Lord Fletcher Moulton, L.J., said that the fact that the words "Perfection Soap" had acquired a secondary meaning over half of England would have influenced him greatly if

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(21) *Kerfoot v. Cooper, Ltd.*, (1908) 25 R.P.C. at p. 510.

(22) *Crosfield (Joseph) and Sons Ltd.'s Application*, (1910) 1 Ch. 130: (1909) 26 R.P.C. 837 (C.A.).

the words had been less objectionable. The reported cases do not appear to show any uniformity of rule on this question. Thus from the judgment of Lord Shand in *The Cellular Clothing case*<sup>23</sup> it would appear that where secondary signification is claimed for a descriptive word the extent of the user must be 'universal.' His Lordship said that if a plaintiff could prove that his mark which is primarily descriptive had acquired a distinctive meaning in connection with his goods in a number of southern counties of England where his goods had been sold under that name the fact "would surely never entitle the plaintiff to have an injunction in every part of England." The same rule was applied by Farwell, J., in *Chivers & Sons v. Chivers & Co., Ltd.*,<sup>24</sup> where His Lordship said: "It appears to me that the issue thrown upon the plaintiff in a case of this sort is to prove that the world has come to know that particular article associated with his name as meaning his manufacture, and that only. When I say 'the world' I am using another phrase similar to that used by Lord Shand. I do not, of course, mean every human being in the Kingdom, but I mean all persons whom it in any way concerns. . . . In order to give 'Chivers' jelly' that secondary signification which the plaintiffs desire to attach to it and not to make it mean simply a jelly made by a person of the name of Chivers, they must, in my judgment, show first of all that that user has been locally universal at any rate in the sense that it extends in any locality over the area in which the defendant traded. . . . Speaking for myself, I should never find the fact to be that the word had obtained that secondary signification unless it was proved to my satisfaction that the use had been locally universal in the sense I have attached to it—universal in point of space." According to His Lordship "the universality really must be co-extensive at any rate with England and Wales."<sup>25</sup> It is obvious that this ruling goes too far. For, it will be impossible to establish such 'universal user' in most cases. As Kekewich, J., said "in no trade, or none but the very largest

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(23) *Cellular Clothing Co. v. Maxton & Murray*, (1899) A.C. 326; 16 R.P.C. at p. 408.

(24) (1900) 17 R.P.C. at p. 429.

(25) See *Thorne (Henry) & Co., Ltd. v. Eugen Sandow and Sandow, Ltd.*, (1912) 106 L.T. 926; 29 R.P.C. at p. 453; *Star Cycle Co., Ltd. v. Frankenburgs*, (1907) 24 R.P.C. 405; *Crosfield and Sons Ltd.'s Application*, (1909) 1 Ch. 130; 26 R.P.C. 837; *Lea Ltd.'s Application*, (1912) 2 Ch. 32; 29 R.P.C. 165; (1915) 1 Ch. 446; 30 R.P.C. 216; *Cassella & Co.'s Application (Diamine)*, (1910) 2 Ch. 240; 27 R.P.C. 453; *W. & G. Du Cros Ltd.'s Application*, (1912) A.C. 624; 29 R.P.C. 65; 30 R.P.C. 660.

trades, is any one man's goods known throughout the kingdom." According to him it would therefore be sufficient if the plaintiff establishes that his mark had become distinctive even within a limited area.<sup>1</sup> Vaughan Williams, L. J., was also of this view. In the *Silverpan Jam case*<sup>2</sup> His Lordship observed:—"I quite agree... that it is necessary that the plaintiffs should identify this word 'Silverpan' with their firm 'Faulders'. It is quite plain that it is necessary.....to show that identification is recognised within the district in which the defendants, whose user of the word is complained of, carry on business. But this does not mean that there must be proof that the word 'silverpan' is recognised by every one in the district. In my judgment it is sufficient if there is, as there seems to be in this case, a user in the district of the name of 'Silverpan' exclusively in connection with the plaintiffs' firm coupled with a large user of the word 'Silverpan' exclusively by Faulders throughout a large portion of Lancashire."

In the case of names of business premises or hotels the plaintiff will be entitled to relief though the reputation of the business may be merely of local character. The defendant cannot start similar business in that area and adopt a name which may cause confusion to the public and consequent damage to the plaintiff. The injunction will, however, in such cases be limited to the particular areas.<sup>3</sup>

The question of area of reputation is of special importance in a large country like India. The point was raised in *Smidt v. Reddaway & Co.*<sup>4</sup> It was urged that the evidence showed that the secondary signification acquired by the words "Camel hair belting" was confined to Calcutta and Cawnpore, and that it was necessary to show that the term had acquired secondary meaning over the whole of India. But Mclean, C. J., said that the secondary meaning need not be universal all over India and that it was sufficient to show that the term signified the plaintiffs' belting in the Indian market. In *Unani Dawakhana v. Hamdard Dawakhana*,<sup>5</sup> Tekchand and Currie, JJ., observed that it would be difficult to define exactly over what area repute of an article should extend before it can be held that the said repute is locally universal.

(1) *Paine & Co. v. Daniell and Sons' Breweries, Ltd.*, (1893) 2 Ch. 567; 10 R.P.C. at p. 78.

(2) *Faulder & Co., Ltd. v. O. & G. Rushton, Ltd.*, (1903) 19 T.L.R. 452; 20 R.P.C. 477 (C.A.).

(3) *The Clock, Ltd. v. The Clock House Hotel, Ltd.*, (1935) 52 R.P.C. 386.

(4) (1905) 32 Cal. 401; 9 C.W.N. 281.

(5) (1930) 12 Lah. 224; A.I.R. 1930 Lah. 999.



Their Lordships pointed out that in this country industry is not well-developed and the art of advertisement is still in its infancy so that the repute of any article will not easily spread over a wide area. In their Lordships' opinion injunction should therefore be granted where it is found that many customers local and mofussil are likely to be misled.

**Name of patented articles.**—It has long been recognised under the common law that on the expiration of a patent the patentee has thrown open to the public the right to use the name by which the patented article was known.<sup>6</sup> The fact that the patent was invalid or was actually revoked makes no difference. This rule of law has been explained by Lord Herschell as follows:—"Where a patentee attaches a particular name to the production he patents that name becomes common property as description of the patented article. It possesses, indeed, no other name. That name would necessarily be applied to it by all persons desiring to purchase that article. It is not descriptive of the production of a particular manufacturer, but of the article itself, by whomsoever it is manufactured. Indeed there is no presumption that the patentee will manufacture it, even during the term of the patent; more often than not, patented articles are manufactured by other persons by the licence of the patentee." The fact that the name had hitherto been used solely by the plaintiff does not entitle him to the exclusive monopoly of the name. The name in such cases becomes identified with the goods, not primarily because they are plaintiff's goods, but because, he alone as patentee can make and sell them; and, as already pointed out, so long as there is only one maker there can be no secondary meaning in the name. "Until some other person is making the same article and is at liberty to call it by the same name, there can be no right acquired by the exclusive use of the name, as showing that the manufacture of one person is indicated by it and not the manufacture of another."<sup>8</sup> Further, as was explained by the Herschell Committee, "a patentee obtains the patent upon the condition that at the expiration of the term of

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(6) Per Cozens-Hardy in *Edge & Sons, Ltd. v. Nicolls and Sons, Ltd.*, (1911) 1 Ch. 5; 28 R.P.C. at p. 61. That this rule appears to be based upon obsolete conditions and is a source of embarrassment to traders is the view taken by the Goschen Committee who accordingly recommend a revision of statutory law so as not to deprive the trader of the benefit of his research and advertising.

(7) *Beddaway v. Banham*, (1896) A.C. 199; 13 R.P.C. 218.

(8) Per Fry, J., in the *Linoleum Manufacturing Co. v. Nairn*, (1878) 7 Ch.D. 834.

his monopoly, the public shall have the right to manufacture and use it; and if the only name by which it is known is that which the proprietor has registered as a trade mark, it would certainly seem inconsistent with the right thus intended to be conferred on the public, if everyone, except the original patentee, were prevented from calling it or selling it by that name which alone it bears." Thus, in *Wheeler and Wilson Manufacturing Co. v. Shakespear*<sup>9</sup> the court refused to pass an order restraining the defendant from using the words "Wheeler and Wilson" on the ground that they described a machine manufactured according to the plaintiffs' patent which had expired. James, V. C., said:—"A man cannot prolong his monopoly by saying 'I have got a trade mark in the name of a thing which was the subject of the patent'." The *Linoleum Manufacturing Company v. Nairn*<sup>10</sup> is another illustrative case. The plaintiffs were the assignees of a patent for a species of floor cloth. The cloth manufactured according to the patent was termed "Linoleum floor cloth" or "Linoleum." After the patent had expired the same kind of cloth was manufactured by the defendant and was described by him as "Linoleum floor cloth." Thereupon, the plaintiffs moved for an injunction to restrain the defendant from using the word "Linoleum" on cloth not manufactured by the plaintiffs. Injunction was refused. Fry, J., said:—"This word 'Linoleum' directly and primarily means a solidified oil. It only secondarily means the manufacture of the plaintiffs and has that meaning only so long as the plaintiffs are the sole manufacturers. In my opinion, it would be extremely difficult for a person who had been by right of some monopoly the sole manufacturer of a new article and has given a new name to the new article meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article." This principle of law is now well settled and is embodied in section 6 (1) of the English Trade Marks Act, 1919.<sup>11</sup> Registration of

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(9) (1870) 39 L.J.Ch. 36. "I look with great jealousy at any attempt by a patentee to prolong the monopoly given to him by the patent after it has expired." per Fletcher Moulton, L.J., in *Dental Manufacturing Co., Ltd. v. de Trey & Co.*, (1912) 3 K.B. 76 at 84; 29 R.P.C. at p. 623. See also *Freeman Bros. v. Sharpe Bros., Ltd.*, (1899) 16 R.P.C. 205.

(10) (1878) 7 Ch.D. 834; 47 L.J.Ch. 430; 26 W.R. 463. See also *Palmer's Tm.*, (1883) 24 Ch.D. 504; *Native Guano Co. v. Sewage Manure Co.*, (1889) 4 T.L.R. 372; 8 R.P.C. 125; *Formalin Hygienic Co.'s Application*, (1900) 17 R.P.C. 486.

(11) The same principle applies to a word which is the only practicable

trade marks has been refused in several cases to names by which the new patented articles were known during the period of monopoly of the patentee.<sup>12</sup>

**Name of natural product obtained according to a patented process.**—Although the name used by the patentee to describe the new article becomes common to the trade after the expiration of the patent, the name cannot be used during the life of the patent by other manufacturers to describe similar articles not manufactured by the patentee or his licensee. For, as the public associate the name with a particular kind of goods which can be manufactured during this period only by the patentee the use of the name on other goods would be calculated to deceive the public. This restriction does not, however, apply where the name is used to describe a natural product. If a person discovers a natural product and takes a patent for preparing the same, the name fixed upon by the patentee to designate the natural product may be used by others to describe it, even during the life time of the said patent, provided the product is the same but obtained by a totally different process or from a totally different natural source so that there is no infringement of the patent. So, in the early case *Young v. Macrae*<sup>13</sup> where the plaintiffs were the owners of a patent for the distillation of paraffin oil and the defendant commenced to sell another oil under the name 'Paraffin oil' or 'American Paraffin oil' injunction to restrain the defendant from using those names was refused.

**Name may acquire secondary signification after the expiration of the patent.**—The former patentee can, however, show that the name by which his article was known during the existence of the patent ceased to be so used after the expiration of the patent and had, thereafter, become exclusively associated with goods of his manufacture. In such cases he will be entitled to restrain others from using the same to describe similar goods. *Boake, A.*

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name or description of a chemical substance. No one can acquire a monopoly in respect of it. See section 6 (2) of the English Trade Marks Act, 1919.

(12) See *Winser & Co., Ltd. v. Armstrong & Co.*, (1899) 16 R.P.C. 167; *Formalin Hygienic Co., Ltd.'s Application*, (1900) 17 R.P.C. 486; *Gestetner's Trade Mark*, (1907) 2 Ch. 478; 24 R.P.C. 545; (1908) 1 Ch. 513; 25 R.P.C. 156; (C.A.); *British Vacuum Cleaner Co., Ltd. v. The New Vacuum Cleaner Co., Ltd.*, (1927) 2 Ch. 312; 24 R.P.C. 641; *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd. (No. 2)*, (1913) 30 R.P.C. 609; *Moore's Modern Method Ltd.'s Application*, (1918) 36 R.P.C. 6.

(13) (1862) 9 Jur.N.S. 322; (1862) Seb. Dig., p. 114.

*Roberts & Co., Ltd. v. Wayland & Co.*,<sup>14</sup> is an instance of this type in which the plaintiffs succeeded in establishing that the letters "K.M.S." had acquired secondary meaning in connection with their potassium metasilphite after the patent for preparing this compound had expired. The labels and get-up which have become distinctive of the patentee's goods when the patent was in force will also be protected against fraudulent imitation. "The public may have acquired confidence in that particular label, and that confidence may have given a value to it which the patentees may be entitled to have protected after the expiration of their patent."<sup>15</sup>

**Name of new goods.**—The same considerations discussed above in the case of patented articles apply where a manufacturer uses a name to designate a new article he has introduced into the market. "If a person makes an article not patented, and gives it a certain name by which the article comes to be known in the market, any one in the market, any one who can make the same kind of article can call it by the name by which it is known if he can, in fact, do so without passing his goods off for those of the original maker."<sup>16</sup> "The same thing in principle must apply," said Lord Davey in the *Cellular Clothing case*,<sup>17</sup> "where a man has not taken out a patent as in the present case, but has a virtual monopoly because other manufacturers, although they are entitled to do so, have not in fact commenced to make the article. He brings the article before the world, he gives it a name descriptive of the article; all the world may make the article and all the world may tell the public what article it is they make, and for that purpose they may *prima facie* use the name by which the article is known in the market." Again, as Fry, J., said, "the person who produces a new article, and is the sole maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article,

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(14) (1909) 26 R.P.C. 251. See also *Norton Company's Application*, (1919) 36 R.P.C. 153; *Edison Storage Battery Co. v. Britannia Batteries, Ltd.*, (1931) 48 R.P.C. 350.

(15) Per Wood, V.C., in *Edelsten v. Vick*, 68 E.R. 1194; 1 Eq. Rep. 413; (1853) Seb. Dig., p. 64.

(16) Per Lindley, L. J., quoted by Lord Davey in *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1897) A.C. 710; 14 R.P.C. at p. 732.

(17) *The Cellular Clothing Co. v. Maxton & Murray*, (1899) A.C. 326; 16 R.P.C. at p. 409. "That which is the only name of a thing cannot, it seems to me, be a fancy word with regard to it. The word 'spade' describes the thing; you can never take the word 'spade' and call it a fancy word for the thing." Per Fry, L.J., in *Waterman v. Ayres*, (1888) 39 Ch.D. 29.

there is nothing to distinguish it from.”<sup>18</sup> So, where the defendants prepared an extract of meat in accordance with Liebig’s recipe and described it as “Liebig’s extract of meat” the plaintiffs who were selling “Liebig’s extract of meat” failed to get an injunction.<sup>19</sup> And, in *Davis & Co., Ltd. v. Stribolt & Co.*,<sup>20</sup> registration of the word “Bokol” was ordered to be expunged from the register, as the Norwegian word was the only appropriate designation of the kind of foreign beer imported into England, where it was previously unknown and without a name.

The original inventor of a new manufacture is alone entitled to designate such manufacture as ‘the original’ and if he has been so designating his manufacture an injunction will be granted to restrain a rival manufacturer from applying the designation to his goods.<sup>21</sup>

**Goods manufactured according to secret recipe.**—“If a name under which goods are sold indicates the process by which they are manufactured rather than the manufacturer who puts them on the market, that manufacturer cannot, if he has not the exclusive right to manufacture according to the process, prevent a rival in trade, who is entitled to manufacture according to the process, from applying to goods so manufactured the name by which they are known in the market.”<sup>22</sup> In order, however, to entitle the defendant to use the name of the new article introduced by the plaintiff it is essential that the article sold by the former should be identical with that hitherto sold by the plaintiff. It is not enough to show that it is very like it. So that if the plaintiff has been manufacturing the article according to a secret recipe, as long as he is the sole possessor of the secret, “he is *ex necessitate* the sole person, who, physically, can make the goods.”<sup>23</sup> And, so long as the defendant does not know the recipe of the plaintiff it would be impossible to say that the two goods are the same. In *Powell v.*

(18) *Siebert v. Findlater*, (1878) 7 Ch.D. 801.

(19) *The Liebig’s Extract of Meat Co., Ltd. v. Hanbury*, (1867) 17 L.T.N.S. 298; Seb. Dig., p. 171. See also *James v. James*, (1872) L.R. 13 Eq. 421; *Massam v. Thorley’s Cattle Food Co.*, (1880) 14 Ch.D. 748; *Parsons Bros. & Co. v. John Gillespie & Co.*, (1898) A.C. 239; 15 R.P.C. 57; *Fels v. Christopher Thomas & Bros., Ltd.*, (1903) 21 R.P.C. 85.

(20) (1888) 59 L.T. 854; 6 R.P.C. 207.

(21) *Cocks v. Chandler*, (1871), L.R. 11 Eq. 446.

(22) *Walker & Sons, Ltd. v. Kego* (No. 2), (1921) 38 R.P.C. p. 38 (Lord Hunter).

(23) Per Lord Davey in *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1897) A.C. 710; 14 R.P.C. at p. 725.

*The Birmingham Vinegar Brewery Company, Ltd.*,<sup>24</sup> the defendants could not show that they had obtained the secret recipe of the plaintiff's manufacture. Lord Davey, said: "The appellants do not pretend that they have discovered the respondent's secret, or that their goods are made according to the same recipe. . . . The appellants, therefore are misrepresenting the character of their goods when they call them 'Yorkshire Relish'. They are not, in fact, 'Yorkshire Relish', though I will assume they closely resemble that compound. . . . So long as the respondent can succeed in keeping his secret he is, in fact, the sole manufacturer of 'Yorkshire Relish' in the market, and the appellants' act of selling their goods as 'Yorkshire Relish', when they are not 'Yorkshire Relish' as a fact, is at once a fraud upon the public, and at the same time, amounts, in my opinion, to a misrepresentation that the goods are the goods of which the respondent is the sole manufacturer."

**Colourable imitation.**—The spurious mark complained of may be either an exact or substantial copy of the genuine trade mark,<sup>25</sup> or an imitation done in a manner which is likely to cause the spurious mark to be mistaken for the genuine one. Cases of the first type do not present any difficulty, as the onus of showing that the counterfeit mark is not calculated to deceive the public is cast on the defendant. Such instances of direct misrepresentation are, however, rare. The common type of misrepresentation consists in imitating the plaintiff's mark in such manner that the differences between the genuine and the spurious marks are merely colourable. Great difficulty is often experienced in deciding cases where a defendant devises his mark with the intention to imitate the plaintiff's mark as closely as possible and still keep within the law. In such cases the defendant deliberately introduces apparent differences with a view to be able to show to the court, if called upon to do so, that his mark is different from that of the plaintiff, while at the same time he retains such of the essential characteristics of the original mark as would enable him to pass off his goods for those of the plaintiff. In the language used by Lord Blackburn in *Johnston & Co. v. Orr Ewing & Co.*,<sup>1</sup> the differences are such

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(24) (1897) A.C. 710; 14 R.P.C. 720. See also *Rey v. Lecouturier*, (1910) A.C. 262; 27 R.P.C. 268; *Walker & Sons, Ltd. v. Kego*, (No. 2), (1921) 38 R.P.C. 31.

(25) See for instance *Ford v. Foster*, 7 Ch. 616 (1872); *E. v. Dundas*, 6 Cox. 380.

(1) (1882) L.R. 7 App. Cas. 219; quoted and followed by the Privy Council in *Somerville v. Schembri*, (1887) 12 A.C. 453; 4 R.P.C. 179.

“which might prevent persons from being deceived,” but not such “as to prevent its being likely that they might be deceived.” Diversity of opinion as to whether or not the imitation is a colourable one is, therefore, often likely to arise in cases of this sort.

**Standard of comparison.**—It is impossible to lay down any general rule as to the amount of resemblance which will make the defendant's mark a colourable imitation of that of the plaintiff. In order to entitle a party to relief it is by no means necessary that there should be absolute identity. “What degree of resemblance is necessary, is, from the nature of things, a matter incapable of definition *a priori*. All that courts of justice can do, is to say, that no trader can adopt a trade mark so resembling that of a rival as that ordinary purchasers purchasing with ordinary caution are likely to be misled.”<sup>2</sup> In *Swadeshi Mills Co. v. Juggi Lal Kamalapat Cotton Spinning and Weaving Mills Co., Ltd.*,<sup>3</sup> the court observed:—“No general rule can be laid down as to what is or is not a mere colourable variation. All that can be done is to ascertain in every case as it occurs whether there is such a resemblance as to deceive a purchaser using ordinary caution.” The principle of the law is perfectly clear, namely, that a person cannot pass off goods of one trader as and for the goods of another.<sup>4</sup> If any difficulty arises, it is as to the application of that law to the particular facts of the case before the court. The question whether the defendant's mark is a colourable imitation of the plaintiff's mark is a question of fact and the decision will depend on the surrounding circumstances of each case. “Cases of this sort” said Lord Macnaghten in the House of Lords in the *Camel Hair Belting* case<sup>5</sup> “must depend upon their own particular circumstances. The facts of one case are little or no guide to the determination of another.” And Lord Watson remarked in *Johnston v. Orr Ewing*<sup>6</sup>: “How can observations of Judges upon other and quite different facts bear

(2) Per Cranworth, L.C., in *Setzo v. Provesende*, L.R. (1866) 1 Ch. 192.

(3) A.I.R. 1927. All. 81.

(4) “The law has been settled from the year books downwards that a man has no right to trade under false colours and to sell his goods as another's,” Lord Langdale in *Knott v. Morgan*, (1836) 48 E.R. 610: 2 Keen 213.

(5) *Reddaway v. Banham*, (1896) A.C. 199; 13 R.P.C. 218. See also *Gamage, Ltd. v. Randall, Ltd.*, (1899) 16 R.P.C. 185, (Collins, L.J.); *Havana Cigar and Tobacco Factories, Ltd. v. Oddenino* (1924) 1 Ch. 179; 41 R.P.C. 47.

(6) (1882) L.R. 7 App. Cas. 219.

upon the present case, in which the only question is what is the result of the evidence." "Two cases are seldom exactly parallel, and therefore decided cases are of little value in determining the question whether the goods manufactured by the defendant are likely to be mistaken for those of the plaintiff." Every case is thus an authority for the proposition that it actually decides and it is impossible from the nature of the things to find a decided case the facts of which are exactly similar to those of the particular case before the court for decision. An examination of the decided cases, nevertheless, brings out prominently certain general principles enunciated by the courts from time to time, which may be applied to the facts of any particular case under consideration. It is now well settled, for instance, that in order to constitute a colourable imitation it is not necessary that the plaintiff's mark should be copied in every particular. It is enough for the plaintiff to show that the representations employed by the defendant bear such close resemblance to his mark as to be reasonably calculated to deceive the public. The infringement need not be an absolute and literal copy, but it must be such a similarity as the court would hold, in all the circumstances, to be calculated to deceive.<sup>8</sup> Such general considerations as are important in determining the question of colourable imitation are discussed in the following sections.

**Net impression to be considered.**—In finding out whether there is colourable imitation one must not look only at the differences or at the resemblances between the two marks but compare the two marks fairly and then come to a decision.<sup>9</sup> Each dissimilarity or resemblance must not be taken by itself and a conclusion based thereon.<sup>10</sup> "If the dissimilarity is so small, and the common

(7) Per Niamatullah, J., in *Thomas Bear and Sons (India) v. Prayag Narain*, A.I.R. 1935 All. 7.

(8) *Tatem & Co., (1915), Ltd. v. Gaumont Co., Ltd., (1917)* 34 R.P.C. at p. 188. [Cozens-Hardy]. See also *Eastern Asiatic Match Co., Ltd. v. Kemmeline Match Co., Ltd., A.I.R. 1931 Rang. 213; Nagendra Nath Saha v. Emperor, 57 Cal. 1153; A.I.R. 1930 Cal. 274; Sassoon v. Mills, 1 Bom.L.R. 291; Badische Aniline and Soda Fabrik v. Maneckji Shapurji Katrak, 17 Bom. 584; Emperor v. Tapidas Durlabdas, (1907) 9 Bom.L.R. 732.*

(9) Lord Lindley in *Schweppes, Ltd. v. Gibbens, (1905)* 22 R.P.C. at p. 607. See also, *Lever v. Goodwin, (1887)* 36 Ch.D. 1; 4 R.P.C. at 505.

(10) In *Coleman & Co., Ltd. v. Stephen Smith & Co., (1911)* 2 Ch. 572; 29 R.P.C. at p. 88, Cozens-Hardy, M.R., said: "Mr. Buckmaster tried to induce us to say that taking all the labels off and holding up these two bottles of 'Wincarnis' and 'Lemco', that there can be no doubt that the one is like the other and the one is an imitation of the other. That is entirely fallacious. You must look at the thing as a whole. You must look at the bottles with all



features are so numerous, that the two as a whole are similar, the dissimilarity goes for nothing."<sup>11</sup> Therefore in each case it is a question of degree and it is the totality of impression which is likely to be left in the mind of a probable purchaser that has to be considered. Minor details or non-essential points of difference between the marks are not important, provided the main idea is the same.<sup>12</sup> As Lord Halsbury said in *Schweppes, Ltd. v. Gibbens*,<sup>13</sup> "The whole question in these cases is whether the thing—taken in its entirety, looking at the whole thing—is such that in the ordinary course of things a person with reasonable apprehension and proper eyesight would be deceived." It is thus quite possible that the defendant's label is a colourable imitation of the plaintiff's label, although no part of one is a copy of the other.<sup>14</sup> In *Jones v. Hallworth*,<sup>15</sup> Kekewich, J., said: "If you take the points of similarity in detail, it is often not very difficult—sometimes it is extremely easy—to show that in all those points of similarity the defendant is perfectly right and has played the part of an innocent man. That applies directly to this case. No one contends that the defendants are not entitled to manufacture and sell polishing cloths; nobody contends that they are not entitled to manufacture and sell polishing cloths of certain sizes, or to impress thereon by printing or otherwise certain words. . . . All those things are perfectly common to the trade; every one of them may be done with perfect innocence. But, by an inductive process, one may come to this conclusion, that every one of those perfectly innocent things

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the labels on them, and not confine your attention to one of the labels only". See *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, A.I.R. 1925 Cal. 220; 40 C.L.J. 230; *Chetarpal Sharma v. Jagannath Das*, 44 All. 608; A.I.R. 1922 All. 178.

(11) Per Lindley, L.J., in *Christiansen's Tm.*, 3 R.P.C. 54. See *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, A.I.R. 1925 Cal. 220; 40 C.L.J. 230, *Richard Crispin & Co.'s Application*, (1917) 2 Ch. 267; 34 R.P.C. 349.

(12) See *Hookham v. Pottage* (1872) L.R. 8 Ch. 91; Seb. Dig. p. 236; *Glenny v. Smith*, 62 E.R. 701; 2 Drew & Sm. 476; Seb. Dig., p. 144; *Bayer v. Baird*, (1898) 15 R.P.C. 615.

(13) (1905) 22 R.P.C. at p. 607. See also *Williams Co. v. Bronnley & Co., Ltd.*, (1909) 26 R.P.C. 765; *Dixon & Son, Ltd. v. George Richardson & Co., Ltd.*, 50 R.P.C. 365; "one must have regard to the net impression, the main idea left on the mind by a casual look," *Bryant and May, Ltd. v. United Match Industries, Ltd.*, (1933) 50 R.P.C. at p. 18 (Clauson, J.).

(14) *Badische Aniline and Soda Fabrik v. Maneckji Shapurji Katrak*, 17 Bom. 584; *Barlow v. Gobindram*, 24 Cal. 364; 1 C.W.N. 281; *Swadeshi Mills Co. v. Juggilal Kamalapat Cotton Spinning and Weaving Mills, Co., Ltd.*, 49 All. 92; A.I.R. 1927 All. 81.

(15) (1897) 14 R.P.C. at p. 234.

when combined in a series may produce something which is the reverse of innocent." Comparison must be made as when both marks are fairly used in the ordinary course of trade, and the effects of wear and tear and other surrounding circumstances should be taken into consideration.<sup>16</sup>

**Identity of features in the two marks not essential.**—In *Seixo v. Provezende*,<sup>17</sup> Lord Chancellor Cranworth said: "In order to entitle a party to relief it is by no means necessary that there should be absolute identity. . . . If a purchaser, looking at the article offered to him, would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the court considers the use of such a mark to be fraudulent." And, in *Abbott v. The Bakers' and Confectioners' Tea Association, Ltd.*<sup>18</sup> Hatherley, L.C., said: "Though no one particular mark is exactly imitated, the combination is very similar and is likely to deceive." All the circumstances of the case will have to be taken into consideration before the court arrives at any decision on the question of colourable imitation. "The points of similarity between the two marks and the essential points of difference between them must be given due weight and the conclusion must be arrived at on a consideration of the colour, shape, form and design of the two marks."<sup>19</sup> The *ratio decidendi* is whether the defendant's mark is calculated to deceive the public. In the *Upper Assam Tea Co. v. Herbert & Co.*,<sup>20</sup> both the plaintiffs and the defendants had registered a trade mark consisting of an elephant, the former for tea and the latter for coffee. Injunction was granted by Cotton, L.J., who said: "I think there is here sufficient similarity. I do not say that the plaintiffs can claim all elephant marks, but one looks only at those particular elephant marks, and although there is the difference of the elephant in the defendants' mark turning his head in a most

(16) *Lyndon's Tm.*, (1896) 2 Ch. 137; 3 R.P.C. 102; *Haines Batchelor & Co.'s Tm.*, (1888) 5 R.P.C. 669; *Rosing's Application*, (1878) 54 L.J.Ch. 975 (C.A.).

(17) (1866) L.R. 1 Ch. 192; 14 W.R. 357.

(18) W.N. (1872) p. 31; Seb. Dig. p. 226.

(19) Per Iqbal Ahmad, J., in *Thomas Bear and Sons (India) v. Prayag Narain*, A.I.R. 1935 All. 7; 57 All. 510.

(20) (1889) 7 R.P.C. 183. See also for instance, *Herbert Whitworth, Ltd. v. Jamnadas Nemichand Mehta*, A.I.R. 1928 Bom. 227; 52 Bom. 228, and *Danish Dairies Milk Export v. Murlidhar & Co.*, 26 S.L.R. 51; A.I.R. 1932 Sind 84; Cf. *Anonyme Dubonnet's Application*, (1915) 32 R.P.C. 241, where it was held that the distinctions between the pictures of the cats were obvious, and registration was allowed; *Bagots Hutton & Co.'s Application*, (1916) 2 Ch. 103; 32 R.P.C. 333.

convenient way, yet I do not think that that, and the fact that the plaintiffs' elephant is in profile, are sufficient to prevent this mark used by the defendants from being passed off as the plaintiffs'. Of course, where one person imitates another's mark, he never takes it absolutely in all points—if so there is no question—but there is always a similarity and dissimilarity in order that he may say 'if you look at the marks carefully you will see such a difference that you cannot be deceived'." So also, in *Nemi Chand v. Wallace*.<sup>21</sup> Sir Francis Maclean, C.J., said: "No doubt if the two pieces of cloth are placed side by side and carefully examined, certain differences are obvious. But the general resemblance is very marked—the practical identity of heading, the green and the black and silver labels and the number of yards marked almost identically as on Dewhursts' goods, with the little dots within the figures."

**Comparison of marks side by side not the test of similarity.—**

It is not enough for the defendant to say that when the two marks are compared together a wide difference may be noticed. "As is well-known the rule in regard to infringements is not to take the two documents and put them side by side, because that is not what a man does who goes to buy. He sees one at one time and one at another, and carries more or less imperfectly in his mind the one that he has first seen, and he is, generally speaking, not in a position to make anything like an accurate comparison of the two."<sup>22</sup> "It would be a mistake to suppose," said Lord Cranworth, "that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical value."<sup>23</sup> Sargant, J., observed:—"The question is not whether, if a person is looking at the two trade marks side by side there would be a possibility of confusion. The question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection."<sup>24</sup> Similarly,

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(21) 11 C.W.N. 537. See also *Sassoon v. Mills*, 1 Bom.L.R. 291.

(22) Per Chitty, J., in *Melachrin v. Melachrin*, (1887) 4 B.P.C. at p. 223. See also *Nemi Chand v. Wallace*, 11 C.W.N. 537; *Barlow v. Gobindram*, 24 Cal. 364; 1 C.W.N. 281; *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, (1906) 24 B.P.C. 27. *Dixon & Son, Ltd. v. George Richardson & Co., Ltd.*, (1933) 50 B.P.C. 365.

(23) *Seixo v. Provesende*, (1866) L.R. 1 Ch. 192.

(24) *Sandow Ltd.'s Application*, (1914) 30 L.T. 394; 31 B.P.C. 196.

Coutts-Trotter, C.J., and Ramesam, J., observed: "One has got to see whether an ignorant purchaser is going to be in the position of the court having the two things side by side and examine them critically. The purchaser probably trusts to his recollection of one or a description of it that has been given him, or seeing it in the shop window, goes to the person selling the infringement, who *ex hypothesi* does not give him the two, the genuine one and the infringement to choose from."<sup>25</sup>

**Observation by the Herschell Committee.**—The matter was fully considered by Lord Herschell's Committee who proposed certain rules of comparison. The Committee observed: "Two marks, when placed side by side may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with a mark first registered, and not having the two side by side for comparison might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. . . . We would suggest that when the question arises whether a mark applied for bears such resemblance to one on the Register as to be calculated to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other and yet the leading, or it may be the only, impression left on the mind might be very different; whilst, on the other hand, a critical comparison of the two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same."

**Special attention to be paid to the leading features.**—Thus, the adoption of a single leading characteristic of the plaintiff's mark

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See also *De Long Hook and Eye Co. v. Newey Bros., Ltd.*, (1911) 29 R.P.C. p. 58.

(25) *Ebrahim Currim & Sons v. Abdulla Saheb*, 65 M.L.J. 617; A.I.R. 1934 Mad. 226.

may constitute an infringement.<sup>1</sup> But which feature is a leading characteristic of the plaintiff's mark is a question of fact which will depend on the circumstances of each case. In *Madhavji Dharamsey Manufacturing Co., Ltd. v. Central India Spinning, etc., Co., Ltd.*,<sup>2</sup> the court observed that when a combination of devices go to form a trade mark of a particular article, the question as to what the dominant feature of the trade mark is, is a question of evidence depending upon which device has caught the attention of the buyers and has come to be associated with the goods of the manufacturer. It was held in that case that as the plaintiff's goods were identified in the market by a number forming part of his mark, to copy that number was an infringement and that it made no difference that the infringer adopted a different drawing or picture along with the number.

**Rule by Byrne, J.**—The proper method of trying the issue in these cases was laid down by Byrne, J., in the following passage: 'In coming to a conclusion upon such an issue, which is one of fact, I think that where the case depends upon what is called 'get-up' or 'dressing' of the goods, there are certain leading points which ought to be borne in mind in all cases, whatever special circumstances may attach to and require consideration in any particular case; and, first, it must always be kept in mind that the actual issue is, not whether or not the Judge or the members of the Jury determining it would, or would not, have been personally deceived, but whether or not, after hearing the evidence, comparing the articles, and having had all the similarities and dissimilarities pointed out, the true conclusion is that the ordinary average customer of the retail dealers is likely to be deceived.'<sup>3</sup>

**Resemblance in non-essential matters.**—The similarity must be in the points which a customer would look out to see whose manufacture he was buying.<sup>4</sup> Where the resemblance between the marks of the plaintiff and the defendant is limited to a few

(1) See *Balfour & Co. v. Kilburn & Co.*, (1862) 1 Hyde, 270; *Guinness v. Ullmer*, (1847) 10 L.T.O.S. 127; Seb. Dig., p. 46. *Whitworth Ltd. v. Jamnadas*, 52 Bom. 228; *Bryant and May, Ltd. v. United Match Industries, Ltd.*, (1933) 50 R.P.C. 12.

(2) 41 Bom. 49.

(3) *Clark v. Sharp*, (1898) 15 R.P.C. 141.

(4) *Blackwell v. Crabb*, (1867) 36 L.J.Ch. 504; Seb. Dig., p. 163.

Injunction was refused notwithstanding general resemblance between the two labels on the ground that the name of the manufacturer to which a customer would look to discover the identity was conspicuously different.

non-essential or minor details, the courts may not consider that the defendants' mark is likely to cause deception of the public. Thus, in *Schwerdtfeger & Co. v. Hart Publishing Company Ltd.*,<sup>5</sup> the plaintiffs' mark for picture post cards consisted of a heart-shaped design with the initials "E.A.S." in the centre while the defendants' mark had in the corner a heart, in the centre of which were printed in very small type a letter and a number. The design of the heart used by the plaintiffs was somewhat different from the defendants' design, being considerably broader than it was long, while the defendants' design was the conventional shape of a heart. It was held that the characteristic feature of the plaintiffs' trade mark was the initials and not the design of the heart and that there was no likelihood of deception. So also, in *Marshall v. Sidebotham*<sup>6</sup> it was held that the distinguishing feature of the plaintiff's mark was the letters "I.X.L." and as this feature was absent in the defendant's mark the action was dismissed.

**Addition of maker's name may not distinguish the goods.—**

Where the name of the manufacturer is always used along with a trade name or mark on his goods it may be difficult to show that the trade name or mark by itself distinguishes his goods. The name of the maker may, in such cases, constitute the leading feature by which the purchasers distinguish his goods from other similar goods, and a rival trader may then be able to distinguish his goods by the mere addition of his name prominently along with the trade name or mark complained of.<sup>7</sup> On the other hand, it is possible that notwithstanding the addition of the maker's name the trade name of the goods may be regarded by the public as the prominent feature which distinguishes his goods from other similar goods. The mere addition of a rival manufacturer's name to the trade name or mark used by the plaintiff on his goods will not, in such cases, be sufficient to distinguish the goods of the former from the plaintiff's goods. The cases of "*Glenfield Starch*,"<sup>8</sup> "*Two*

(5) (1912) 29 R.P.C. 236. See *Clark v. Sharp* (1898) 15 R.P.C. 141; *Tatem & Co., (1915) Ltd. v. Gaumont Company, Ltd., (1917) 34 R.P.C. 181.*

(6) (1900) 18 R.P.C. 43. See also *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps, Ltd., (1928) 45 R.P.C. 132; Dixon & Son, Ltd. v. George Richardson & Co., Ltd., (1933) 50 R.P.C. 365.*

(7) See for instance *Beard v. Turner, (1865) 13 L.T. (N.S.) 746; Seb. Dig., p. 147; Blackwell v. Crabb, (1867) 36 L.J.Ch. 504, Seb. Dig., p. 163; Jewsbury and Brown v. Andrew & Atkinson & Ormerod Brothers, (1910) 28 R.P.C. 293; Hommel v. Bauer & Co., (1904) 21 T.L.R. 80; 22 R.P.C. 43.*

(8) *Wotherspoon v. Currie, (1878) L.R. 5 H.L. 508.*

Elephants,"<sup>9</sup> "Yorkshire Relish,"<sup>10</sup> "Cat and barrel"<sup>11</sup> and "Camel Hair Belting"<sup>12</sup> are well-known instances of this type, where, notwithstanding the fact that the defendant's name appeared prominently along with the trade name or mark on the goods an action for passing-off was successful. As Vice-Chancellor Hall said: "The whole point is, that if the primary word has acquired with certain persons a secondary meaning of a special manufacture, then it is not enough merely to put the name of somebody else in front of it. It must be distinguished in such a way that it will not be likely to deceive."<sup>13</sup> In considering a question of this sort the probability of the name of the manufacturer being dropped or not used by the trade in course of time will be a material factor. "It is true" said Lindley, L.J., in *Reddaway & Co., Ltd. v. Bentham Hemp Spinning Co.*,<sup>13-a</sup> "that the defendants call their belting 'Bentham's', and the Plaintiffs call theirs 'Reddaway's', but in commerce these words are soon dropped; ordinary purchasers do not know of them; and if it be true that 'Camel Hair Belting' denotes belting made by the Plaintiffs, then belting made by the Defendants will soon be known by the same short name, and may then be easily mistaken for the belting made by the Plaintiffs'".

**No colourable imitation where features copied are common to the trade.**—Where the resemblance between the marks is

(9) *Johnston v. Orr-Ewing*, (1882) L.R. 7 App. Cas. 219.

(10) *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1897) A.C. 710.

(11) *Boord & Son v. Thom and Cameron, Ltd.*, (1907) 24 R.P.C. 697.

(12) *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q.B. 639; 9 R.P.C. 503; *Reddaway v. Banham*, (1896) A.C. 199; 13 R.P.C. 218; *Reddaway & Co., Ltd. v. Frictionless Engine Packing Co., Ltd.*, (1902) 19 R.P.C. 505; *Smidt (John) v. Reddaway & Co.*, 32 Cal. 401; *Reddaway & Co., Ltd. v. Robert Stevenson & Brother, Ltd.*, (1903) 20 R.P.C. 276. "The evidence is abundant to show that Reddaway's camel hair belting would be indicated even under the term 'Lechat's camel hair belting'" Lord Hanworth, M.R., *Reddaway & Co., Ltd. v. Hartley*, (1931) 48 R.P.C. 283. See also *Singer Manufacturing Co. v. Wilson*, (1877) 3 App. Cas. 376; *Siebert v. Findlater*, (1878) 7 Ch. D. 801; *Perry v. Truefitt*, (1842) 49 E.R. 749; 6 Beav. 66; *Braham v. Bustard*, (1863) 71 E.R. 195. 1 H. & M. 447; *Ford v. Foster*, (1872) L.R. 7 Ch. 616; *Ross v. Loftus*, (1878) 47 L.J.Ch. 576; *Eno v. Dunn & Co.*, (1893) 9 T.L.R. 376; 10 R.P.C. 261; *Cochrane (Sir Henry) v. McNish & Son.*, (1896) A.C. 225; 13 R.P.C. 100; *Daniel and Arter v. Whitehouse and Everall*, (1898) 1 Ch. 685; 16 R.P.C. 71; *Burberrys v. Raper & Pulleyn*, (1909) 100 L.T. 895. 23 R.P.C. 170; *Universal Winding Co. v. Hattersley (George) & Sons, Ltd.*, (1915) 32 R.P.C. 479.

(13) *Faulder & Co., Ltd. v. O. and G. Rushton, Ltd.*, (1903) 19 T.L.R. 452; (C.A.) 20 R.P.C. at p. 489.

(13-a) 9 R.P.C. 503.

entirely or mainly in those particulars that are common to the trade in the sense that they are open to the trade, such resemblance will not constitute colourable imitation. "It is no doubt important," said Farwell, L.J., "to protect fair trading but it is at least as important to prevent the acquisition of a monopoly in matters that are common to every one."<sup>14</sup> "The right to a trade mark," said Lord Cranworth, "is the exclusive right to use it for the purpose of indicating where and by whom, at what manufactory the article to which it was affixed was manufactured."<sup>15</sup> If a person uses something that is common to the trade he is using that which is not distinctive of his goods and he cannot obviously claim exclusive monopoly of the same. So, Lord Selborne said:—"If the defendant has a right to make and sell, in competition with the plaintiffs, he must also have a right to say that he does so, and to employ for that purpose the terminology common to the trade, provided always that he does this in a fair, distinct, and unequivocal way."<sup>16</sup> Where, therefore, a plaintiff's trade mark includes features common to the trade, he will have to show that the alleged infringement is in respect of the distinctive features of his mark. In *Payton & Co., Ltd. v. Snelling Lampard & Co., Ltd.*,<sup>17</sup> Lindley, M.R. said that where the resemblance is confined to features which are common to the trade the plaintiff "must make out not that the defendant's (goods) are like his by reason of those features which are common to them and other people, but he must make out that the defendant's (goods) are like his by reason of something peculiar to him, and by reason of the defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the plaintiff's from other goods

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(14) *Williams Co. v. Bronnley & Co., Ltd.*, (1909) 26 R.P.C. 774.

(15) *Leather Cloth Co., (Limited) v. American Leather Cloth Co., (Limited)*, (1865) 11 H.L.C. at p. 533; 11 E.R. 1435.

(16) *Singer Manufacturing Co. v. Loog*, (1882) 8 App. Cas. 15.

(17) (1899) 16 T.L.R. 56; 17 R.P.C. 48, at p. 52. "If he (plaintiff) takes a colour and a shape which are common to the trade the only distinctive feature is that which he has added to the common colour and common shape, and unless he can establish that there is in the added matter such a similarity as is calculated to deceive, I think he must fail." Cozens-Hardy, M.R., in *Williams Co. v. Bronnley & Co., Ltd.*, (1909) 26 R.P.C. at p. 771; See also *Hennessy & Co. v. Dompe*, (1902) 19 R.P.C. 333; *Imperial Tobacco Co., Ltd. (of Great Britain and Ireland), Ltd. v. Purnell & Co.*, 21 R.P.C. 598; *Coleman & Co., Ltd. v. Stephen Smith & Co.*, (1911) 2 Ch. 572; 29 R.P.C. 81; *Bagots, Hutton & Co. Ltd.'s Application*, (1916) 2 Ch. 103; 32 R.P.C. 333; *Richard Crispin & Co.'s Application*, (1917) 2 Ch. 267; 34 R.P.C. 349. *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps, Ltd.*, (1928) 45 R.P.C. 132.



which have, like his, the features common to the trade. Unless he brings his case up to that he fails." In a later passage his Lordship observed: "The evidence is very strong that one tin may be mistaken for the other; very likely; but why? Because of the features common to them and common to all." In that case it was held that red, blue and green enamelled tins for coffee were common to the trade. Other examples of features held to be common to the trade are:—Yellow labels for mustard,<sup>18</sup> red bands for cigars,<sup>19</sup> dome-topped maroon coloured tins for shaving soap,<sup>20</sup> ox cart in connection with port wine,<sup>21</sup> the numeral '9' for cigarettes,<sup>22</sup> the word 'star' and the device of a star in the tobacco trade,<sup>23</sup> picture of the 'Duchess of Devonshire' by Gainsborough in the hat and millinery trade,<sup>24</sup> device of a milkmaid in the butter trade,<sup>25</sup> 'Tower' for tea,<sup>1</sup> pictorial representation of ace of spades for playing cards,<sup>2</sup> the crescent and star for *biris* in India,<sup>3</sup> device of a cat for gin,<sup>4</sup> "console" in the gramophone trade.<sup>5</sup>

**Test of infringement where some of the features copied are common to the trade.**—Where the plaintiff's mark consists of a

(18) *Farrows' Trade Marks*, (1890) 63 L.T. 233; 7 R.P.C. 260.

(19) *Imperial Tobacco Co. (of Great Britain and Ireland), Ltd. v. Purnell & Co.*, (1904) 21 R.P.C. 368, 598.

(20) *Williams & Co. v. Bronnley & Co., Ltd.*, (1909) 26 R.P.C. 481, 765. See also *Jamieson & Co. v. Jamieson*, (1898) 14 T.L.R. 160; 15 R.P.C. 169; *Paokham & Co., Ltd. v. Sturges & Co.*, (1898) 15 R.P.C. 669; *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, (1899) 17 R.P.C. 58; *King & Co., Ltd. v. Gillard & Co., Ltd.*, (1905) 2 Ch. 7; 21 R.P.C. 589; *Schweppes, Ltd. v. Gibbens*, (1905) 22 R.P.C. 113, 601; *Perry & Co., Ltd. v. Hessin & Co.*, (1912) 56 Sol. Jo. 572; 29 R.P.C. 509; *Hutchinson's Application*, (1924) 41 R.P.C. 538; *Clark v. Sharp*, (1898) 15 R.P.C. 141.

(21) *Edward Young & Co., Ltd. v. Grierson Oldham & Co., Ltd.*, (1924) 41 R.P.C. 548.

(22) *Ardatb Tobacco Co., Ltd. v. Sandorides, Ltd.*, 42 R.P.C. 50.

(23) *Gallaher Ltd.'s Application*, (1925) 42 R.P.C. 215.

(24) *Louise & Co., Ltd. v. Gainsborough*, (1902) 87 L.T. 591; 20 R.P.C. 61.

(25) *Anglo-Swiss Condensed Milk Co.'s Trade Mark*, (1903), 20 R.P.C. 509.

(1) *Great Tower Street Tea Co. v. Smith*, (1889) 5 T.L.R. 232; 6 R.P.C. 165.

(2) *Goodall & Son, Ltd. v. Waddington, Ltd.*, (1924) 41 R.P.C. 658.

(3) *Palli Ram v. Emperor*, 8 O.W.N. 827; A.I.R. 1931 Oudh 277.

(4) *Bagots, Hutton & Co. Ltd.'s Application*, (1916) 2 Ch. 103; 32 R.P.C. 333.

(5) *The S.M.T. Gramophone Co., Ltd. v. Itonia Gramophones, Ltd.*, (1931) 48 R.P.C. 309.

combination of a get-up common to the trade and a distinctive feature, then, what the court will consider is "not whether the defendants' get-up is like the plaintiffs' as regards the common features, but whether that which specially distinguishes the plaintiffs' has been taken by the defendants."<sup>6</sup> In such cases the features that are common to the trade must be eliminated and it must then be seen whether there is a sufficient distinction between the two marks in that which is left,<sup>7</sup> as the monopoly to which the plaintiff is entitled is limited to the distinguishing features of his mark. Indeed, as Kekewich, J., observed, a man "might properly and with perfect honesty copy that which was common to the trade" and that "as long as he does not copy that which is a peculiarity of the trade mark which is said to be infringed he is not only outside the law but he is perfectly honest."<sup>8</sup> In *Faqir Chand v. Emperor*<sup>9</sup> the plaintiffs' get-up for hair dye consisted in addition to features which were common to the trade the design of a horse which was held to be distinctive of their goods. The defendants adopted in their get-up along with features common to the trade a design of a horse with a rider. The two designs were in different colours. It was held that the defendants' get-up was calculated to deceive though the complainant firm could not claim a trade mark in the general get-up. Addison, J., added, however, that "it is open to the petitioners to change the designation from a horse to something else and that is all that the complainant firm desires." In these cases it is important to consider "whether there is or is not some essential point of difference or of resemblance, which overcomes or establishes the effect of other points of resemblance; how much of the matter complained of is

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(6) *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, (1899) 17 R.P.C. at p. 63 per Lindley, M.R. See also *Hennessey & Co. v. Dompe*, (1902) 19 R.P.C. 333; *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, A.I.R. 1925 Cal. 220; 40 C.L.J. 230.

(7) *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps, Ltd.*, (1928) 45 R.P.C. at p. 151, Lawrence, L.J., *Hampshire & Co.*, (1927) *Ld. v. General Kaputine Syndicate, Ltd.*, (1930) 47 R.P.C. 437; *Bryant and May, Ltd. v. United Match Industries, Ltd.*, (1933) 50 R.P.C. 12; *Murphy's Tm.*, (1890) 7 R.P.C. 163.

(8) *Alaska Packers' Association v. Crooks & Co.*, (1901) 18 R.P.C. 129. "If competitors in a particular market do no more than follow the fashion of the market, and do not in any way seek to induce customers to buy their goods as being those of their rivals, I cannot judicially find fault with them because they adopt styles, shapes, sizes and colours which are common to the trade." *Hubbuck & Son., Ltd. v. Brown Sons, & Co.*, (1900) 17 R.P.C. 154. (Kekewich, J.).

(9) A.I.R. 1934 Lah. 687; 16 Lah. 114.

common to the world, how much to the trade in similar articles, and how much to the trade in specific commodity, colour, shape, form, originality of arrangement, device and design.”<sup>10</sup>

**Imitation cumulative.**—A “trader may acquire by user an exclusive right of monopoly in respect of a combination of two or more matters which by themselves are absolutely common to the trade.”<sup>11</sup> As Eve, J., said: “A man may have used characteristics or factors, in no single one of which he could claim a monopoly, but which, in combination, create a result in which he can claim a monopoly when once it is proved that it is distinctive as identifying his goods.”<sup>12</sup> It will be, however, very difficult to establish such proof of distinctiveness in the case of a combination mark, every one feature of which is common to the trade.<sup>13</sup>

In judging whether a combination mark is distinctive or not, it is wrong “to dissect the mark, and to show that each of its component parts is not distinctive in itself, and then as a result of this process to conclude that the mark as a whole is not distinctive.”<sup>14</sup> Each imitation is cumulative and a number of such may amount to colourable imitation. “One must bear in mind the points of resemblance and the points of dissimilarity, attaching fair weight and importance to all, but remembering that the ultimate solution is to be arrived at, not by adding up or comparing the results of such matters, but by judging the general effect of the respective wholes. A man may be entitled to use every single dissected item of the whole, and any of such items, and yet be disentitled to use the whole; being the items arranged in a particular form or manner.”<sup>15</sup> So in an early case,<sup>16</sup> Vice-Chancellor Wood, referring to the decision in *Knott v. Morgan*,<sup>17</sup> said: “The words conveyance company, the green omnibus, etc., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone.”

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(10) *Clark v. Sharp*, (1898) 15 R.P.C. 141.

(11) *Williams Co. v. Bronnley & Co., Ltd.*, (1909) 26 R.P.C. 486, Neville, J.

(12) *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps, Ltd.*, 45 R.P.C. at p. 46.

(13) *Williams & Co. v. Bronnley & Co., Ltd.*, (1909) 26 R.P.C. 486.

(14) *Diamond, T. Motor Car Co.'s Application*, (1921) 2 Ch. 583: 38 R.P.C. at p. 380 (Lawson, J.).

(15) *Clark v. Sharp*, (1898) 15 R.P.C. 146 (Byrne, J.).

(16) *Woollam v. Batcliff*, (1863) 71 E.R. 113: 1 H. & M. 259.

(17) (1836) 48 E.R. 610: 2 Keen 213.

In *Lever v. Goodwin*,<sup>18</sup> Lord Justice Cotton observed:—"The defendants' contention was this: 'There is no trade mark in 'Self-washing' or 'Self-washer'; there is no monopoly in this parchment paper; there is no monopoly in the spaced printing; then why should I be restrained in carrying on business from using those things as to which the plaintiffs cannot claim any monopoly whatever?' That was an obvious fallacy. There may be no monopoly at all in the individual things separated, but if the whole are so joined together as to attempt to pass off, and to have the effect of passing-off the defendants' soap as the plaintiffs', then, although, the plaintiffs have no monopoly either in 'Self-washing' or 'Self-washer,' or in the parchment paper, or in the spaced painting, yet if those things, in which they have no sole right, are so combined by the defendants as to pass-off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction in order to restrain the defendant from passing-off his goods as those of the plaintiff.'" *Parker & Smith v. Satchwell & Co., Ltd.*,<sup>19</sup> is another illustrative case. The defendants had in that case deliberately copied the show card used by the plaintiffs for mounting their hair comb for purposes of sale. Lord Alverstone, M.R., said: "It is no question at all of adopting something common to the trade—either colours, or ladies heads, or anything of that kind—but it is taking the identical arrangement of hair, shape of heads, and position of hands, and copying them."

It is thus seen that, where a manufacturer has been using a trade mark in which the leading features are common to the trade, it behoves other manufacturers desiring to use the same features in their trade marks to be careful in selecting their marks so that there may be no likelihood of confusion of their goods with the goods of the first manufacturer.<sup>20</sup>

**Name given by the public to the plaintiff's goods.**—The actual physical resemblance between the two marks may not be the sole question for consideration in deciding whether the defendant's mark is calculated to deceive. It may sometimes happen that a

(18) (1887) 36 Ch.D. 1; 4 R.P.C. 505. See also *Jones v. Hallworth*, 14 R.P.C. at p. 234, (Kekewich, J.); *Munday v. Carey*, (1905) 22 R.P.C. 273; *Clark v. Sharp*, (1898) 15 R.P.C. 141.

(19) (1900) 17 R.P.C. 713, C.A.

(20) *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, (1899) A.C. 303; 17 R.P.C. 48; *Romer, L.J.*, see also *Cordes v. Addis & Son*, (1923) 40 R.P.C. 133, (Eve, J.).

trade name may get attached exclusively to the goods of a particular manufacturer by the general public on their own initiative. As Lord Moulton said: "Many a trade mark has been taken by accident; some peculiarity of the get-up of the goods has been fixed upon by public fancy. Goods have been known by some appellation borrowed from such get-up, and things which were never intended to be trade marks have become so in fact."<sup>21</sup> Where the plaintiff's trade mark had caused his goods to obtain celebrity under a name descriptive of the trade mark the defendant will not be permitted to adopt a trade mark which is likely to cause the public to attribute the same name as that under which the plaintiff's goods are known. In *Seixo v. Provezende*,<sup>22</sup> Lord Cranworth said: "If the goods of a manufacturer have from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market may be as much a violation of the rights of that rival as the actual copy of his device." In the above case the plaintiff's mark consisted of a crown and the word "Seixo" and his wine came to be known as "Crown Seixo" wine and the defendants were restrained from using a crown and "Seixo" or any other mark likely to cause their wine to be mistaken for "Crown Seixo" wine although the two marks showed considerable differences.

In *Johnston v. Orr-Ewing*<sup>23</sup> the plaintiffs' labels were of a triangular shape bearing in green and gold colours the device of two elephants with a drooping cloth or banner suspended between them. The plaintiff had been exporting Turkey red yarn to Bombay under these labels and their yarn came to be known as "Bhe Hathi" or "two elephants" yarn in the local market. The defendant also used for the same class of goods a label also containing two elephants holding a suspended banner, the figure being, however, differently arranged. Injunction was granted. Lord Selborne said:—"Although the mere appearance of these two marks could not lead any one to mistake one for the other, it might easily happen that they might both be taken by the natives of Aden or India, unable to read and understand the English language as equally symbolical of the plaintiff's goods. To such persons or at least to many of them, even if they took notice of the differences

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(21) Trans. Inst. Pat. Agents, XXIV, p. 47.

(22) (1866) I.Ch. 192.

(23) (1882) 7 App. Cas. 219.

between the two labels, it might probably appear that these were only differences of ornamentation, posture and other accessories, leaving the distinctive and characteristic symbol substantially unchanged. Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade mark themselves for reasons of their own."

In *Anglo Swiss Condensed Milk Co. v. Metcalf*<sup>24</sup> the plaintiffs had registered and used a trade mark consisting of the full length figure of a woman with a pail upon her head and another in her hand with the words "Milk Maid Brand" for milk, cocoa, coffee, condensed milk and other articles. The condensed milk was generally called and ordered as "Milkmaid" or "Milkmaid brand," but it was also frequently inquired for and ordered under the name of "Dairymaid" Swiss milk. The defendant subsequently registered a half-length figure of a dairymaid or milkmaid in conjunction with the word "Dairymaid" for the same class of goods. Injunction was granted-restraining the defendant from using his mark upon condensed milk, coffee, cocoa, etc., and the defendant's registration was ordered to be confined to goods other than the above. Mr. Justice Kay observed: "It is quite true neither the words 'Milkmaid' or 'Dairymaid' are any part of the plaintiffs' trade mark. Those words 'Milkmaid' and 'Dairymaid' were names which the public, looking at the trade mark, affixed to this particular kind of milk; and it grew into such a habit that numbers of persons. . . . commonly applied for and ordered this article under the name of 'Dairymaid' brand or 'Dairymaid' milk. . . . It is very likely that the tradesman who buys it to sell again knows perfectly the distinction between that and the plaintiffs' manufacture but is it or is it not calculated to deceive people who know the plaintiffs' manufacture by the term 'Dairymaid's brand,' and who go to a retail shop and inquire for it in that way? I have not the faintest doubt about it."

A similar thing occurred in *Barker's Trade Mark case*.<sup>25</sup> A firm of distillers (Grant and Sons) had registered as a trade mark for cherry brandy a picture representing two huntsmen on horseback. The words "Sportsman's special quality" were printed upon the design below their name. The cherry brandy became widely known as "Huntsman's" and as "Sportsman's" brandy. Barker and Son, another firm of distillers, registered as their trade

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(24) (1886) 31 Ch.D. 454; 3 R.P.C. 28.

(25) 53 L.T. (N.S.) 23.

mark the picture of a huntsman surrounded by hounds, the words "Huntsman's cherry brandy" being printed on the design. Motion to expunge the latter trade mark was granted by Kay, J. In *Wilkinson v. Griffith Bros. & Co.*,<sup>1</sup> the plaintiffs had been exporting French polish to Bombay under a label on which two medals were printed in red and their polish came to be known in that market under the brand name "Lal chap" meaning red stamp. The defendants were consequently restrained from using a label with two red medals. In *Taylor v. Virasami Chetty*<sup>2</sup> the court held that the plaintiff's shirting came to be known in the Madras market as "katti" or "talwar" goods from their trade mark which consisted of five 'talwars' or swords and restrained the defendants from using the device of five talwars as part of their trade mark. In *Boord & Son v. Thom & Cameron, Ltd.*,<sup>3</sup> it was held that the defendants' device consisting of a cat and barrel, though not resembling the device used by the plaintiffs, still constituted an infringement of the plaintiffs' mark, as their gin had become known in the market as cat and barrel brand. And, in *Pakir Mahomed v. Emperor*,<sup>4</sup> although the complainant's mark consisting of a crown differed considerably from the fez mark used by the accused, the court accepted the complainant's contention that as his mark had, by long user, come to be known in the market as 'topee' mark the defendants' mark which was also known as 'Topi' or 'Turkish Topi' mark was calculated to deceive.

In the following cases the plaintiffs could not establish that their goods were known under the names which were descriptive of their trade marks:—*Cowie Bros. & Co. v. Herbert*,<sup>5</sup> *Tatem & Co. (1915), Ltd. v. Gaumont Co., Ltd.*,<sup>6</sup> *Mahumiar & Co. v. Finlay*

(1) (1891) 8 R.P.C. 370. See also *Huxley's Application*, (1924) 41 R.P.C. 423, "Ship brand."

(2) 6 Mad. 108.

(3) (1907) 24 R.P.C. 697. See also *Boord & Son v. Huddart*, (1903) 89 L.T. 718; 21 R.P.C. 149. Registration of a device of a cat for gin was however allowed in *Bagots Hutton & Co., Ltd.'s Application*, (1916) 2 Ch. 103; 32 R.P.C. 333.

(4) A.I.R. 1929 Rang. 322.

(5) (1897) 14 R.P.C. 436. See also *Lever Bros., Ltd. v. Bedingsfield*, (1898) 80 L.T. 100; 16 R.P.C. 3.

(6) (1917) 34 R.P.C. 181. See also *Price's Patent Candle Co., Ltd. v. Jeyes' Sanitary Compounds Co., Ltd.*, (1901) 19 R.P.C. 17; In the matter of Trade Mark "Pup," (1933) 50 R.P.C. 198, registration was allowed as the opponents, the Gramophone Co., Ltd., failed to show that their mark consisting of a dog listening to sounds from a gramophone was referred to or recognised by the public as a "pup" or "puppy" mark.

*Fleming & Co.,<sup>7</sup> Mohamed Noordin v. Abdul Kareem & Co.,<sup>8</sup> Malayan Tobacco Distributors, Ltd. v. United Kingdom Tobacco Co., Ltd.<sup>9</sup>*

**Name suggested by the trade.**—In *Emperor v. Bakaulah Mallik*,<sup>10</sup> a case decided under the Indian Merchandise Marks Act, the question arose as to how far, in fact, the law allows a man to appropriate as his own, a name which is suggested by his trade. The complainants had been selling fish hooks stamped with a device consisting of a representation of two fishes crossed with their heads and tails bent up while the defendant also used a representation of a fish with a head and tail turned upwards as a trade mark on their fish hooks. Although the two marks were dissimilar it was contended that the complainants' fish hooks had come to be known under the name "Mash" or "fish brand" and that the defendant's trade mark was consequently calculated to deceive. It was held that, where the public had chosen a name for their own use such as "Mash Marka" or "Fish mark," the fact could not prevent other persons from using on fish hooks marks containing representations of fishes. Ghose and Stephen, JJ., said: "In the present case as put forward by the respondent, the public had chosen a name for their own use; and, if the difference between the two kinds of fish hooks is noticeable enough to make the public care to distinguish between them, the difference between one fish and two fish is marked enough to afford a very simple method of distinction.....A picture of a fish can hardly be held to be descriptive of a fish hook.....We do not think that the fact that the mark was known as 'mash marks' can be held to prevent others from applying a mark to fish hooks, which may be generally known by the same term.....The essential feature of the design is, in our opinion, too common and too apt for application to fish hooks, for a name used on it to be reasonably calculated to mislead."

**Confusion between word marks.**—A word mark may be used orally as well as in writing. In considering the probability of confusion between two such marks one must therefore "judge of them both by their look and their sound."<sup>11</sup> "Two marks may be

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(7) 7 B. 169; A.I.R. 1929 Rang. 345.

(8) A.I.R. 1931 P.C. 272.

(9) 66 M.L.J. 588; A.I.R. 1934 P.C. 167.

(10) 31 Cal. 411.

(11) Lord Parker in *Pianotist Co., Ltd.'s Application*, (1906) 23 B.P.C. 774.



calculated to deceive either by appealing to the eye or to the ear, or by one appealing to the eye, and one to the ear.”<sup>12</sup> Thus, in *The Red Star case*,<sup>13</sup> the trade mark consisting of the words “Red Star,” for glass, was removed from the Register on the ground of prior registration of the picture of a star for glass. Kay, L. J., said that “although one appeals to the eye and the other to the ear, they would so nearly resemble as to be calculated to deceive.” Two words may appear to be similar to the eye though when pronounced they may be quite dissimilar in sound. Registration was thus refused of the German word “Schicht” for soap, on the ground that to the eye the word showed such close similarity to the word “sunlight” as to be calculated to deceive.<sup>14</sup> In cases of this type the proper test is not to compare the two marks visually side by side but to consider whether in the case of an average purchaser confusion is likely to result from seeing the second mark sometime after having seen the first. The probability of confusion between the words in the case of hastily placed orders will also have to be considered.

In many cases the phonetic similarity of the two words may be more important than the aspect of the words to the eye. If the two word marks have substantially the same sound the Court will consider that confusion is likely to arise although the marks may be dissimilar in appearance. Thus, the word “Kokoko” was held to be not sufficiently dissimilar to “Coco” to be distinctive, Kay, J., observing that the two words were “almost of the same sound and might be very easily confused and mistaken when people are talking to one another.”<sup>15</sup> The test in these cases is whether the phonetic similarity is such that if an order be placed verbally or by telephone it will create a confusion in the mind of a person who receives the one commodity when he asks for the other.<sup>16</sup> It is

(12) *Societe Anonyme des Verreries de l' Etoile's Tm.*, (1894) 2 Ch. 26; 11 R.P.C. at p. 146 (Lindley, L. J.).

(13) *Societe Anonyme des Verreries de l' Etoile's Tm.*, (1893) 10 R.P.C. 436; (1894) 1 Ch. 61 O.A. (1894) 2 Ch. 26; 11 R.P.C. 142. The opponent's goods were known as ‘Star glass’ from the device of the star.

(14) *Georg Schicht Actiengesellschaft's Application*, (1912) 28 T.L.R. 375; 29 R.P.C. 483. See also *Oxo Ld. v. King*, (1917) 34 R.P.C. 165 (‘Oxot’ and ‘Oxo’).

(15) *Jackson Co.'s Tm.*, (1889) 6 R.P.C. 80; 60 L.T. 93.

(16) *Magdalena Securities, Ld.'s Application*, (1931) 48 R.P.C. at p. 487.

immaterial that there are dissimilarities in the get-up of the two goods.<sup>17</sup>

The probability of confusion is less where the two marks are ordinary words in common use, each conveying a definite idea, than in the case of an invented word. Thus, in *Thomas A. Smith Ltd.'s Application*<sup>18</sup> registration of the word "Limit" as a trade mark in respect of collars and shirts was opposed by the owners of the trade mark "Summit" in respect of similar goods. Registration was allowed by Neville, J., who said: "I do not think that so far as the meaning of the words is concerned, a reference to the one would in the least have such an impression in the mind of the reader as to make him mistake the other for it."

**Rule for comparing word marks.**—The rule for comparing two word marks has been expressed by Lord Johnston thus: "I think we are not bound to scan the words as we would in a question of *comparatio literarum*. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into the shop."<sup>19</sup> The totality of the impression produced by the two marks must be considered. As Farwell, J., said in a recent case,<sup>20</sup> "I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with another word as a whole. In my judgment it is quite wrong to take a portion of the word and say that, because that portion of the word differs from the corresponding portion of the word in the other case, there is no sufficient similarity to cause confusion. There may be two words which in their component parts are widely different but which, when read or spoken together, do represent something which is so similar as to lead inevitably to confusion. I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word." The natural or ordinary pronunciation should be con-

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(17) *Bale and Church Ltd. v. Sutton Parsons and Sutton*, (1934) 51 R.P.C. 129.

(18) (1913) 30 R.P.C. 363. In *Fitchetts Ltd. v. Loubet & Co., Ltd.*, (1919) 36 R.P.C. 296, Sarjant, J., said that "Rito" was a word with a definite and distinct slang meaning of right or satisfactory while "Lito" had no meaning. See also *Society of Motor Manufacturers and Traders Ltd. v. Motor Manufacturers' and Traders' Mutual Insurance Co., Ltd.*, (1925) Ch. 675; 42 R.P.C. 307.

(19) *Tokalon Ltd. v. Davidson & Co.*, (1914) 31 R.P.C. at p. 136.

(20) *William Bailey (Birmingham) Ltd.'s Application*, (1935) 52 R.P.C. at pp. 151, 152.

sidered, and any similarity which may be noticed by "torturing the English language and English pronunciation" should be discarded.<sup>21</sup>

Where the suffix of the two word marks is a common one, the earlier portion of the word is the natural and necessary mark of distinction<sup>21-a</sup> and the plaintiff cannot claim a monopoly of the common suffix. So, in *Fitchetts Ltd. v. Loubet & Co., Ltd.*,<sup>22</sup> Sarjant, L. J., said: "It seems to me quite inadmissible that the registration of "Lito" should prevent the registration amongst other things, another dissyllabic word ending in 'ito,' whether it is an invented word such as 'Brighto,' 'Nighto,' 'Slighto,' 'Tighto,' 'Mighto,' or any other combination with the termination 'ighto'—a common termination especially at the present day—and a preceding letter or letters."

**Word Marks held to be similar.**—It has been held that confusion is likely between the words "Onsoria" and "Anzora,"<sup>23</sup> "Apollinis" and "Apollinari,"<sup>24</sup> "Emollio" and "Emolline,"<sup>25</sup> "Kokoko" and "Coco,"<sup>21</sup> "Demotic" and "Demon,"<sup>22</sup> "El Devino" and "El Destino,"<sup>23</sup> "Stafford" and "Trafford,"<sup>24</sup> "Savoline" and "Savonol,"<sup>25</sup> "St. Ives" and "St. Ivel,"<sup>26</sup> "Securine" and "Seccotine,"<sup>27</sup> "Tablones" and "Tabloids,"<sup>28</sup> "Murrilo" and

(21) *Fitchetts Ltd. v. Loubet & Co., Ltd.*, (1919) 36 R.P.C. at p. 303 (Sarjant, J.). See also observations of Romer, L. J., in *Goodwin v. Ivory Soap Co.*, (1901) 18 R.P.C. at p. 392.

(21-a) *Facsimile Letter Printing Co., Ltd. v. Facsimile Typewriting Co.*, (1912) 29 R.P.C. 557.

(22) (1919) 36 R.P.C. at p. 303. See also *Fox & Co.'s Application*, (1920) 37 R.P.C. 37; *Bale and Church, Ltd. v. Sutton Parsons & Sutton and Astrah Products*, (1934) 51 R.P.C. at p. 144 (Maugham, J.). "The test of infringement where the trade mark has a descriptive element is the same as the test where it has no descriptive element, except so far as the descriptive element is itself common to the trade."

(23) *Lewis v. Vine and Vine's Perfumery Co.*, (1914) 31 R.P.C. 12.

(24) *Apollinaris Co. v. Herrfeldt*, (1887) 4 T.L.R. 9; 4 R.P.C. 478.

(25) *Grossmith's Tm.*, (1889) 60 L.T. 612; 6 R.P.C. 180.

(1) *Jackson Co.'s Trade Mark*, (1889) 60 L.T. 93; 6 R.P.C. 80.

(2) *Slasenger v. Feltham & Co.*, (1889) 5 T.L.R. 365; 6 R.P.C. 531.

(3) *Pinto v. Trott*, (1891) 8 R.P.C. 173.

(4) *Smith and Wellstood v. Carron Co.*, (1896) 13 R.P.C. 108.

(5) *Field Ltd. v. Wagel Syndicate Ltd.*, (1900) 1 Ch. 651; 17 R.P.C. 266.

(6) *Aplin and Barrett v. Richards*, (1903) 20 R.P.C. 799.

(7) *McCaw, Stevenson and Orr, Ltd. v. Nickols & Co.*, (1903) 21 R.P.C. 15.

(8) *Capsuloid Co. Ltd.'s Application*, (1906) 23 R.P.C. 782.

"Muralo,"<sup>9</sup> "Murad" and "Muratti,"<sup>10</sup> "Stateroom" and "State Express,"<sup>11</sup> "Oxot" and "Oxo,"<sup>12</sup> "Camay" and "Cameo,"<sup>13</sup> "Cocoatina" and "Cacaotina,"<sup>14</sup> "Steelpen's Blue black" and "Stephens' Blue Black,"<sup>15</sup> "Starch gloss" and "Starch glaze,"<sup>16</sup> "American syrup of figs" and "California Syrup of figs,"<sup>17</sup> "Freia" and "Fry,"<sup>18</sup> "Egall" and "Egrol,"<sup>19</sup> "Galaxy" and "Glaxo,"<sup>20</sup> "Zykol" and "Zeekol,"<sup>21</sup> "Malagole" and "Mallat,"<sup>22</sup> "Victor" and "Victory,"<sup>23</sup> "Germoce" and "Germolene" or "Homocea,"<sup>24</sup> "Nuvol" and "Nujol,"<sup>25</sup> "Hemvo" and "Harvo,"<sup>26</sup> "Vino" or "Vyno" and "Harvino,"<sup>27</sup> "Bolivar" and "Molivar,"<sup>28</sup> "Amata" and "Amami,"<sup>29</sup> "Red Knight" and "Silent Knight,"<sup>30</sup> "Brick" and "Brico,"<sup>31</sup> "Coalite" and "Ucolite,"<sup>32</sup> "Pine-ette"

(9) *Muralo Co. v. Taylor*, (1910) 27 R.P.C. 261.

(10) *Muratti Sons & Co. v. Murad, Ltd.*, (1911) 28 R.P.C. 497.

(11) *United Kingdom Tobacco Co.'s Application*, (1912) 29 R.P.C. 489.

(12) *Oxo Ltd. v. King*, (1917) 34 R.P.C. 165.

(13) *O. Proctor and Gamble Co. v. Pugsley Dingman & Co., Ltd.*, (1929) 46 R.P.C. 421.

(14) *Schweitzer v. Atkins*, (1868) 19 L.T. 6; 37 L.J.Ch. 847.

(15) *Stephens v. Peel*, (1867) 16 L.T. (N.S.) 145.

(16) *Ascough v. Johnson & Co.*, (1887) 3 T.L.R. 735.

(17) *California Fig Syrup Co. v. Taylor's Drug Co., Ltd.*, (1897) 14 R.P.C. 564; 13 T.L.R. 348.

(18) *Akt. Freia Chocolate Fabrik's Application*, (1924) 41 R.P.C. 653.

(19) *Egg Products Ltd.'s Application*, (1922) 39 R.P.C. 155.

(20) *Smith's Application*, (1923) 40 R.P.C. 77.

(21) *Brown & Co's Application*, (1921) 38 R.P.C. 15.

(22) *Hinks, Wells & Co.'s Application*, (1916) 33 R.P.C. 281.

(23) *Massachusetts Saw Works' Application*, (1918) 35 R.P.C. 137.

(24) *Taylor's Drug Co. Ltd.'s Application*, (1923) 2 Ch. 174; 40 R.P.C. 193.

(25) *McDowell's Application*, (1926) 43 R.P.C. 313 at p. 330; 44 R.P.C. 335; (1927) A.C. 632. See also *Savage's Application*, (1927) 44 R.P.C. 1, where "Nuvola" was held to be too close to "Nujol."

(1) *Hemming's Application*, (1924) 41 R.P.C. 672.

(2) *Wheatley, Akeroyd & Co. Ltd.'s Application*, (1920) 37 R.P.C. 137.

(3) *R. Middlemas and P. J. Wood (Trading as Walters & Co.) v. Moliver & Co., Ltd.*, (1921) 38 R.P.C. 97.

(4) *Prichard & Constance (Wholesale), Ltd. v. Amata, Ltd.*, (1924) 42 R.P.C. 63.

(5) *Forth and Clyde and Sunnyside Iron Companies, Ltd. v. William Sugg & Co., Ltd.*, (1928) 45 R.P.C. 382.

(6) *Hans Lauritsen's Application*, (1931) 48 R.P.C. 392.

(7) *Magdalena Securities Ltd.'s Application*, (1931) 48 R.P.C. 477.

and "Pine-exx,"<sup>8</sup> "Kleenoff" and "Kleenup,"<sup>9</sup> "Erector" and "Erectiko,"<sup>10</sup> "Otto Dil Bagh" and "Otto Dil Bagar,"<sup>11</sup> "Motricine" and "Motorine."<sup>12</sup>

**Marks held to be not similar.**—On the other hand it was held that confusion was not likely to arise between the words "Emolliolorum" and "Molliscorium,"<sup>13-14</sup> "Triticumina" and "Triticine,"<sup>15</sup> "Vincalis" and "Wincarnis,"<sup>16</sup> "Ivory" and "Ivy,"<sup>17</sup> "Neostyle" and "Cyclostyle,"<sup>18</sup> "Cocosoline" and "Cottolene,"<sup>19</sup> "Lanco" and Lancashire,<sup>20</sup> "Neola" and "Pianola,"<sup>21</sup> "Aquastite" and "Acquascutum,"<sup>22</sup> "Colonial" and "Colonol,"<sup>23</sup> "Carvino" and "Wincarnis,"<sup>24</sup> "Limit" and "Summit,"<sup>25</sup> "Herogen" and "Gerogen,"<sup>21</sup> "Mendit" and "Mendine,"<sup>22</sup> "Swankie" and "Swan,"<sup>23</sup> "Lavroma" and "Lavona" or "Lovona,"<sup>24</sup> "Anchola" and "Anchovette,"<sup>25</sup>

(8) *Dixon v. Taylor and Cowells (Trading as the Pine-exx Liquid and Disinfectant Soap Co.)* (1933) 50 R.P.C. 405.

(9) *Bale and Church, Ltd. v. Sutton Parsons & Sutton, and Astrah, Products*. (1934) 51 R.P.C. 129.

(10) *William Bailey (Birmingham) Ltd.'s Application*, (1935) 52 R.P.C. 136.

(11) *Anglo Indian Drug and Chemical Co. v. Sugandha Perfumery Co., Statesman*, 27th March, 1936.

(12) *Compagnie Industrielle Des Petroles' Application*, (1907) 2 Ch. 435; 24 R.P.C. 585.

(13-14) *Talbot's Tm.*, (1894) 63 L.J.Ch. 264; 70 L.T. 119; 11 R.P.C. 77.

(15) *Meaby & Co., Ltd. v. Triticine, Ltd.*, (1897) 14 T.L.R. 42; 15 R.P.C. 1.

(16) *Coleman & Co., Ltd. v. Brown & Co.*, (1899) 16 R.P.C. 619.

(17) *Goodwin v. Ivory Soap Co.*, (1901) 18 R.P.C. 389.

(18) *Neostyle Manufacturing Co., Ltd.'s Tm.*, (1903) 20 R.P.C. 329 at p. 803.

(19) *Fairbank Co. v. Cocos Butter Manufacturing Co.*, 20 T.L.R. 53; 21 R.P.C. 23.

(20) *Reddaway & Co., Ltd. v. Irwell and Eastern Rubber Co., Ltd.*, (1906) 23 R.P.C. 621; (1907) 24 R.P.C. 603.

(21) *Pianotist Co., Ltd.'s Application*, (1906) 23 R.P.C. 774.

(22) *Aquascutum v. Cohen & Wilks*, (1909) 26 R.P.C. 651.

(23) *St. Mungo Manufacturing Co. v. Viper and Recovering Co.*, (1910) 27 R.P.C. 420.

(24) *Coleman & Co., Ltd. v. Stephen Smith & Co., Ltd.*, (1911) 2 Ch. 572; 28 R.P.C. 645; (C.A.) 29 R.P.C. 81.

(25) *Smith (Thomas, A.) Ltd.'s Application*, (1913) 30 R.P.C. 363.

(1) *British Drug Houses, Ltd.'s Tm.*, (1912) 107 L.T. 756; 30 R.P.C. 73.

(2) *Coombe v. Mendit, Ltd.*, (1913) 136 L.T.Jo. 86; 30 R.P.C. 709.

(3) *Crook's Tm.*, (1914) 110 L.T. 474; 31 R.P.C. 79.

(4) *Tokalon, Ltd. v. Davidson & Co.*, (1915) 32 R.P.C. 133.

(5) *Waide & Co. Ltd.'s Application*, (1916) 33 R.P.C. 320.

“Regiment” and “Regimental,”<sup>6</sup> “Rito” and “Y-to” or “Lito,”<sup>7</sup> “Motrate” and “Filtrate,”<sup>8</sup> “Aquatite” and “Aquaturn,”<sup>9</sup> “Cream o’ the north” and “Northern cream,”<sup>10</sup> “Tripeastroid” and “Castrol,”<sup>11</sup> “Farris cycles” and “Fairyceyle,”<sup>12</sup> “Ernalde” and “Nilde.”<sup>13</sup>

**Class of purchasers—Not manufacturers or middlemen.—**

The class of purchasers who should be considered in deciding the question of probability of deception has been discussed in several cases. The fact that the manufacturers of similar goods or the middleman to whom the defendant sells his goods are not deceived by the mark is of no importance, if the mark is likely to deceive the ultimate purchasers. “The way in which the Court deals with these cases” said Romilly, M.R., in an early case, “is not to see whether the manufacturers themselves would distinguish them, but whether the public, who may be more easily misled would probably be deceived.”<sup>14</sup> In *Singer Manufacturing Co. v. Loog*<sup>15</sup> Lord

(6) *Imperial Tobacco Co., (of Great Britain and Ireland) Ltd. v. De Pasquali & Co.*, (1918) 2 Ch. 207; 35 R.P.C. 185.

(7) *Fitchetts Ltd. v. Loubet & Co., Ltd.*, (1919) 36 R.P.C. 296.

(8) *Fox & Co.’s Application*, (1920) 37 R.P.C. 37.

(9) *Cohen’s Tm.*, (1922) 39 R.P.C. 33.

(10) *Hutchinson’s Application*, (1924) 41 R.P.C. 538.

(11) *London Lubricants Ltd.’s Application*, (1925) 42 R.P.C. 264.

(12) *Lines Bros, Ltd. v. Farris & Co.*, (1926) 43 R.P.C. 64.

(13) *Societe La Parfumerie Nilde v. Ernalde Ltd.*, (1929) 46 R.P.C. 453.

(14) *Shrimpton v. Laight*, (1854) 52 E.R. 65; 18 Beav. 164. See also *Lever v. Goodwin*, (1887) 36 Ch. D. 1; 4 R.P.C. 492. “It is not sufficient to show that those who are in the trade knew the facts, but the question is what the public knew” (Lindley, L.J.), *Wood v. Butler (Wood’s Tm.)*, (1886) 3 R.P.C. 81; *Hubbuck & Son, Ltd. v. (William) Brown Sons & Co.*, (1900) 17 R.P.C. 645; *Sykes v. Sykes*, (1824) 107 E.R. 834; 3 B. & Cr. 541; *Edge v. Johnson*, (1892) 9 R.P.C. 134; *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1897) A.C. 710; 12 R.P.C. 496; *Singer Manufacturing Co. v. Loog*, (1879) 8 App. Cas. 15; *Reddaway & Co., Ltd. v. Frictionless Engine Packing Co., Ltd.*, (1902) 19 R.P.C. at p. 512; *Edge & Sons, Ltd. v. Niccolls & Sons, Ltd.*, (1911) A.C. 693; 28 R.P.C. 582; *Abdul Salam v. Hamidullah*, 166 P.W.R. 1912; *Macdonald & Co. v. Holland & Moss*, 10 S.L.R. 175; 41 I.C. 539.

(15) (1879) 8 App. Cas. 15. In *Edelsten v. Edelsten*, (1863) 1 De G. J. & Sm. 185; 46 E.R. 72 Lord Westbury said that the plaintiff will not be deprived of his remedy in equity “even if it be shown by the defendant that all the persons who brought from him goods bearing the plaintiff’s trade mark were well aware that they were not of the plaintiff’s manufacture. If the goods are so supplied by the defendant for the purpose of being sold again in the market, the injury to the plaintiff is sufficient.”

Blackburn observed: "It is well settled that when any one adopted a mark so closely resembling the trade mark of the plaintiff's that it would likely be mistaken for it, and put it on his goods and sold them, knowing that, though the persons to whom he sold them were well aware that they are not of the plaintiff's make, yet when they are meant to be sold to others who would see only the trade mark, and were likely to be deceived by its resemblance to that of the plaintiff, he might be properly found to have fraudulently and knowingly sold the goods as and for the plaintiff's." The reason is clear. "The law is intended to reach," said Kekewich, J., "and many authorities show that it does reach, not only those who themselves deceive, but also those who enable others to deceive the purchasing public."<sup>16</sup> The whole gist of the complaint is thus whether the defendant had sold "a weapon calculated to be used fraudulently by the middlemen."<sup>17</sup> Bowen, L.J., said: "It is an injury to take a name understood in the trade as connoting a particular maker, and to sell goods under it which are not of that maker's make; and it is an injury none the less because the immediate vendee is not deceived. If the probable and natural result is that the immediate vendee, though not deceived himself, will use the name so as to deceive others—his ulterior vendees—it is an injury to take the name and use it in that way, and it is a fraud in equity if it is known by the person who takes it that that will be the ultimate and probable result."<sup>18</sup>

**Effect on ultimate purchaser to be considered.**—The *ratio decidendi* in every case of alleged colourable imitation is thus whether the goods are likely to deceive the ultimate purchaser.<sup>19</sup> So, in *Orr-Ewing & Co. v. Johnston & Co.*,<sup>20</sup> it was held that, notwithstanding that the English purchasers and Indian dealers

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(16) *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; 14 R.P.C. at p. 654. "It has been long ago pointed out in decided cases that it is not upon a *mala mens* towards the first purchaser that the decision of these cases rests." (Lord Heatherley) *Wotherspoon v. Currie*, (1872) L.R. 5 H.L. at p. 517.

(17) *Per Cotton, L.J.*, in *Lever v. Goodwin*, (1887) 36 Ch. D. 1; 4 R.P.C. 492.

(18) *Barlow & Jones v. Johnson Jabez & Co.*, (1890) 7 R.P.C. 395.

(19) *Wylam v. Clarke*, (1876) W.N. 68; *Edge v. Johnson*, (1892) 9 R.P.C. 134; *Johnston v. Orr Ewing*, (1882) 7 App. Cas. 219; *Packham & Co., Ltd. v. Sturgess & Co.*, (1898) 15 R.P.C. 669; *Edge & Sons, Ltd. v. Niccolls & Sons, Ltd.*, 27 R.P.C. 671; (1911) A.C. 693; 28 R.P.C. 53, 582; *Jones Bros., Ltd. v. Anglo American Optical Co.*, (1912) 29 R.P.C. 361.

(20) (1882) 13 Ch.D. 434, 7 App. Cas. 219.

were not likely to be deceived the plaintiff was entitled to relief as the defendant's mark was calculated to deceive the ultimate purchasers in India. The reason is obvious. Persons in the trade may not generally be deceived by the imitation. As Farran, J., observed: "The actual manufacturer, who pirates the trade mark, rarely, if ever deceives any one. The persons who, in the first instance, purchase from him know that they are purchasing an article with a questionable trade mark. It may pass through many hands before the ultimate unwary purchaser is made a victim."<sup>21</sup> The immediate purchaser or middleman may thus often be a consenting party to the passing-off.

The proposition is, however, not confined to cases of fraud, but is of a more general nature. "No man is permitted to use any mark, sign or symbol, device or other means whereby, without making a false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer."<sup>22</sup> Or, as Buckley, L.J., expressed it: "This again is the law—that if *A* does not deceive *B* but puts into *B*'s possession an article which will assist *B* to deceive *C*, then there will be an injunction granted to restrain *A* from so dealing."<sup>23</sup> So, a defendant cannot escape liability by showing that he had instructed his shopmen to inform the retail dealers of the spurious nature of the mark, since there is no certainty that such information would be passed on to purchasers buying subsequently from those retail dealers.<sup>24</sup>

**Not experts in the trade.**—It is also now well settled that in passing-off cases "the probability of misleading, not experts or persons who know the real facts, but ordinary or unwary customers, is the mischief to be guarded against."<sup>25</sup> It is not sufficient to show that persons knowing the secrets of the trade may not be

(21) *Manockji Petit Manufacturing Co., Ltd. v. The Mahalaxmi Spinning and Weaving Co., Ltd.*, 10 Bom. 617. See also *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461.

(22) *Per Lord Macnaghten, in Reddaway v. Banham*; (1898) A.C. 199; 13 R.P.C. 218.

(23) *Brinsmead and Sons, Ltd. v. Brinsmead*, (1913) 29 T.L.R. 706; 30 R.P.C. 493 at p. 511.

(24) See *Chappell v. Davidson*, (1855) 69 E.R. 719; (1856) 2 K. & J. 123.

(25) *Lindley, L.J., in Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54 at p. 68; 13 R.P.C. at p. 250; *Nemi Chand v. Wallace*, 11 C.W.N. 537; *Abdulla Ally Mohammed v. Mohamad Ebrahim & Co.*, 157 I.C. 902.



deceived. In the “Singer” case<sup>1</sup> Lord O’Hagen said: “I think we should be cautious in holding that, although a person of intelligence and observant habits might, in a case like this, by exercising reasonable vigilance, escape misleading, there should be no restricting interference to prevent others from being misled. It is a question of degree—of more or less; there can be no rigid rule, and the special facts must be considered in every instance.” This point was decided as early as 1824 in *Sykes v. Sykes*,<sup>2</sup> and has been recognised ever since. For instance, in *Spicer Bros, Ltd. v. Spalding and Hodge, Ltd.*,<sup>3</sup> Joyce, J., said: “To experts the paper sold under the name of ‘British Dominion Bond’ is no doubt different from that sold by the plaintiffs under the name of ‘British Bond.’ I do not think I could tell the difference, and I certainly do not hesitate to say that they are similar, although at the same time to an expert who is familiar with paper they are on examination different.”

**Unwary purchaser.**—While it may readily be granted that an expert in the trade should not be taken as the type of the customer to be considered, it must be remarked that the pendulum of judicial decisions has often swung to the other extreme. In their anxiety to protect the public the Courts have in many cases emphasised that the probable purchaser should be taken to be an unwary purchaser. Thus, for instance, in *Upper Assam Tea Co. v. Herbert & Co.*,<sup>4</sup> Stirling, L.J., observed: “It is always to be borne in mind that it is the unwary purchaser who has to be protected in these

(1) *Singer Machine Manufacturing Co. v. Wilson*, (1877) 3 App. Cas. at p. 394. See also *Huzley’s Application*, (1924) 41 R.P.C. at p. 431. In *Wood v. Butler*, (1886) 32 Ch.D. 247 at p. 260, 3 R.P.C. at p. 90, Lindley, L.J., remarked that the “trade itself knew that what was done was a juggle, but the public knew nothing about it.”

(2) (1824) 107 E.R. 834; 3 B. & Cr. 541.

(3) (1915) 32 R.P.C. at p. 59. In *Eno v. Dunn*, (1893) 9 T.L.R. 376; 10 R.P.C. at p. 263, Kekewich, J., said: “As to the evidence of the chemists, which shows that they have not been deceived it is not likely that they would be, being intelligent persons, but I repeat that my notion of the folly of mankind leads me to suppose that there is a very large element of deception in these tablets.” See also *Sassoon v. Mills*, 1 Bom.L.R. 291.

(4) (1889) 7 R.P.C. at p. 185. See also *Wotherspoon v. Currie*, (1872) L.R. 5 H.L. 508 (Lord Chelmsford); *Singer Manufacturing Co. v. Loog*, (1882) 8 App. Cas. 15 (Lord Selborne); *Alaska Packers’ Association v. Crooks & Co.*, (1899) 16 R.P.C. at p. 507; (Kekewich, J.). “The public are careless, and it is no use supposing that if they paid a very moderate attention to names they would see they were not the same, but only similar.” per Jessel, M.R. in *The Guardian Fire and Life Assurance Co. v. Guardian and General Assurance Co.*, (1880) 50 L.J.Ch. 253.

matters. . . . The question I have got to put to myself, is, is there such a distinction between the two that it is impossible that an unwary purchaser would not be likely to mistake the one for the other."

The view that the courts should only think of the unwary purchaser has been subjected to some criticism. For instance, in *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co.*,<sup>5</sup> Lord James said: "It appears to be admitted that an ordinary business person would not be misled, but it is alleged that the unwary would. Well, of course, there are unwary people in this world, but I think that a man who employs his own name in carrying on his business has the right to regard the people whom he may attract as being capable of exercising and being in the habit of exercising thought, and I cannot differ from the judgment of Lord Low in which he says: 'I do not think that the respondents are liable to have their business practically stopped unless they change their name simply because a thoughtless person might unwarrantably jump to the conclusion that they were connected with the complainers.' Under the circumstances. . . . I do not think that the average citizen . . . . would be deceived, and I cannot speculate upon the degree of unwariness that would induce the confusion necessary to support the appellants' claim."<sup>6</sup>

**Rule laid down by Romer, L.J.**—The rule was laid down by Lord Justice Romer in the following passage in his very instructive judgment in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*,<sup>7</sup> which received the approbation of Lord Macnaghten in the House of Lords. "It seems to be a sort of popular notion of some witnesses" said Romer, L.J., "that in considering whether the customers are likely to be deceived, you are to consider the case of an ignorant customer who knows nothing about, or very little about the subject of the action. That is a great mistake. The kind of

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(5) (1907) A.C. 430 at 438; 24 R.P.C. at p. 581. See also *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, (1899) 17 R.P.C. 58; *Alaska Packers' Association v. Crooks & Co.*, (1901) 18 R.P.C. 129.

(6) The term "unwary purchasers" has been explained by Pollock, M.R., thus: "Unwary" does not, to my mind, mean rash. An unwary purchaser does not mean a purchaser who will purchase any card needlessly, wholly without reason, and think that any card must be that of the manufacturer whose goods he assumes them to be, but one who may easily overlook or disregard features that with more careful examination might be noted; one whose observation might be inexact or cursory." *Goodall and Son, Ltd. v. Waddington, Ltd.*, (1924) 41 R.P.C. at p. 664.

(7) (1900) 17 R.P.C. 48.

customer that the courts ought to think of in these cases is the customer who knows the distinguishing characteristics of the plaintiff's goods, those characteristics which distinguish his goods from other goods on the market so far as relates to general characteristics. The customer must be one who, knowing what is fairly common to the trade, knows of the plaintiff's goods by reason of these distinguishing characteristics. If he does not know that he is not a customer whose views can properly or will be, regarded by this court."<sup>8</sup> His Lordship proceeded to say that a customer who had very little knowledge of the article except what he was accustomed to buy might easily mistake one article for another, and yet it might turn out that if he knew the market he might easily distinguish the defendants' article from the plaintiffs'. "A customer like that must not be regarded or considered in dealing with cases of this class, and I think that plaintiffs in cases of this kind are too fond of laying hold of customers of the class I have been referring to, persons of an ideal character, who either are particularly innocent or too easily deceived."

**Only persons who are likely to buy the goods to be considered.**

—The effect of the above rule, as was pointed out by Kekewich, J., is that in considering probability of deception evidence of persons who are either too easily deceived or who do not know the difference between the plaintiff's goods and other goods in the market should be regarded as of no value.<sup>9</sup> The class of customers should

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(8) "One must always bear in mind that these courts exist for the protection of those members of the public purchasing these goods who articulate with reasonable audibility, and who examine what is given them or exercise reasonable care in satisfying themselves, when they have received a packet of goods, that it is the packet of goods for which they have asked. That applies also to persons who walk up Regent street looking for a particular shop and end up by going into a different shop. If they have seen an advertisement of one shop dealing in commodities of this sort, and enter another shop which deals in them, it by no means follows that they have been deceived. What has happened is that they have forgotten what they read, they have not taken the trouble to remember it, or make a note of it, and they make a shot at the first shop which they think may have been that of which they have read. That is a class of members of the public for the protection of whom the courts do not exist." Eve, J., *Societe La Parfumerie Nide v. Ernalde, Ltd.*, (1929) 46 R.P.C. 453.

(9) *Alaska Packers' Association v. Crooks & Co.*, (1901) 18 R.P.C. at p. 137. See also *Goodall (Charles) & Son, Ltd. v. John Waddington, Ltd.*, (1924) 41 R.P.C. 465. In the case of word marks, the rule was stated thus by Eve, J: "The class of person who has to be protected is the person who does not know the appearance and may be quite unacquainted with the price charged for the 'Bolivar' cigars, but who has got into his mind that there is a brand of cigar with a name 'Bolivar', which has a reputation and which

be taken to be those who are likely to purchase the goods in question. This would depend to some extent upon the article in question and the price<sup>10</sup> at which it is sold. For instance, in the *Pianotist Co., Ltd.'s case*,<sup>11</sup> Parker, J., said that the test of the customer in the case of a costly musical instrument is not the same as in the case of washing soap in a grocer's shop. And in *Edge & Sons, Ltd. v. Niccolls & Sons, Ltd.*,<sup>12</sup> Lord Herschell said: "The class of goods which are sold and the circumstances in which they are sold have to be taken into consideration. The goods in question are made up in many packets and are chiefly purchased over the counter by washerwomen, cottagers and other persons in a humble station of life. . . . The poor classes who buy this class of goods do not seem to distinguish the goods by the label but by the general appearance which the articles present."

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he desires to purchase." *R. Middlemas and P. J. Wood* (trading as *Walters & Co.*) v. *Moliver & Co., Ltd.*, (1921) 38 R.P.C. at p. 102. "In all these cases which come before the courts the court is proceeding upon the assumption that customers do retain a normally imperfect recollection of the plaintiff's trade name and will make mistakes if the defendant's trade name is similar to that of the plaintiff's", Romer, J., in *Prichard & Constance (Wholesale), Ltd. v. Amata, Ltd.*, (1925) 42 R.P.C. at p. 71. See also His Lordship's observations in *Bale and Church, Ltd. v. Sutton, Parsons & Sutton*, (1934) 51 R.P.C. 129 at pp. 141, 142; at p. 143 Maugham, L.J., said that "Orders may be given by people who have only heard of the reputation gained by the plaintiff's goods, without any accurate knowledge as to the trade mark or the get-up of the goods in question." In the case of limited companies it is trite to say that persons do not always recite the names of the companies at full length, Clauson, J., *Crystalite Gramophone Record Manufacturing Co., Ltd., v. British Crystalite Co., Ltd.*, (1934) 51 R.P.C. at p. 320.

(10) The substantial difference in price between the plaintiffs' and the defendants' cigarettes and the different character of the tobacco in the two cigarettes were some of the grounds on which the court came to the conclusion that there was no risk of deception or confusion, in *Ardath Tobacco Co., Ltd. v. Sandorides, Ltd.*, (1925) 42 R.P.C. 50.

(11) (1906) 23 R.P.C. 774. See also *Cordes v. Addis & Son*, (1923) 40 R.P.C. 133; *Aquascutum v. Cohen and Wilks*, (1909) 26 R.P.C. 651; Buyers of motor cars or motor trucks which are expensive articles are likely to buy them only after careful inspection, *Diamond T. Motor Car Co.'s Application*, (1921) 2 Ch. 583; 38 R.P.C. 373.

(12) (1911) A.C. 693; 28 R.P.C. 582. "One must remember that a person who wants a pen may fairly be presumed to be able to read, and he is not a person merely governed by the colour and shape of the box without reference to what is on the boxes themselves." Cozens-Hardy, M. R., in *Perry & Co., Ltd. v. T. Hessin & Co.*, (1912) 56 Sol.Jo. 572; 29 R.P.C. at p. 530. In *Malayan Tobacco Distributors, Ltd. v. United Kingdom Tobacco Co., Ltd.*, 66 M.L.J. 588; A.I.R. 1934 P.C. 167, the Privy Council observed: "The present case is concerned only with sales in the Straits Settlements of cheap grades of cigarettes purchased exclusively by Asiatics

Should be persons of average intelligence using ordinary caution.—The probable purchasers should thus be taken to be customers of average intelligence, “persons with reasonable apprehension and with proper eyesight,”<sup>13</sup> and buying with ordinary caution.<sup>14</sup> They must be typical of those members of the public who are likely to buy the goods. The probable purchasers must not be persons of “phenomenal ignorance or extraordinarily defective intelligence,”<sup>15</sup> or as Lord Justice Romer put it, not “persons of an ideal character who either are particularly innocent or too easily deceived.”<sup>16</sup> “The court does not sit to protect imbeciles” declared Vice-Chancellor Hall “but to protect ordinary persons using ordinary common sense.”<sup>17</sup> In *Henry Thorne & Co., Ltd. v. Eugen Sandow*,<sup>18</sup> Neville, J., observed: “You ought not to consider what mistakes merely ignorant or thoughtless people

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of whom approximately 80 per cent. are Chinese-speaking and the remainder mainly Malay-speaking. Most of these customers are unable to read or speak English, though some can recognise English numerals.” “I do not think that so far as persons who deal in the shares of limited companies engaged in mining operations are concerned, there would be any fear of persons of that kind confusing the name of the Plaintiff Company with the name of the Defendant Company.” Bennett, J., *Tigon Mining and Finance Corporation, Ltd. v. South Tigon Mining Co., Ltd.*, (1931) 48 R.P.C. 526. See also *Palli Ram v. Emperor*, A.I.R. 1931 Oudh 277; 8 O.W.N. 827.

(13) Lord Halsbury in *Schweppes, Ltd. v. Gibbens*, (1905) 22 R.P.C. at p. 607. See also *Coleman & Co., Ltd. v. Stephen Smith & Co.*, (1911) 2 Ch. 572; 29 R.P.C. 81 at p. 98, Farewell, L. J.

(14) See *Seizo v. Provezende* (1896) L.R. 1 Ch. 192; *St. Mungo Manufacturing Co. v. Viper & Recovering Co.*, (1910) 27 R.P.C. 420. “By an ordinary purchaser I mean a person of ordinary intelligence and endowed with the usual senses, amongst them, that of sight, not a blind person or one who is exceptionally ignorant or stupid.” Warrington, J., in *De Long Hook and Eye Co. v. Newey Bros., Ltd.*, (1911) 29 R.P.C. at p. 58. “Ordinary observant individual midway perhaps between the one who studies in detail that which attracts his attention and the one who perhaps, is too negligent to read what is staring him in the face and too indifferent to remember it and who goes away with the vague idea but no real recollection of what he has seen.” Eve, J., in *Goodall & Sons, Ltd. v. Waddington, Ltd.*, (1924) 41 R.P.C. at p. 471. “Although I am not prepared to attribute to people who deal in these commodities an excessive amount of carefulness or good sense, at the same time I am not going to treat them as devoid of sufficient intelligence to distinguish between these two names.” Eve, J., in *Societe La Parfumerie Nilde v. Ernalde, Ltd.*, (1929) 46 R.P.C. at p. 456.

(15) *Prices Patent Candle Co., Ltd. v. Jeyes' Sanitary Compounds Co., Ltd.*, (1884) 19 R.P.C. at p. 210, Joyce, J.

(16) *Payton & Co., Ltd. v. Titus Ward & Co.*, (1900) 17 R.P.C. at p. 57.

(17) *Reddaway & Co., Ltd. v. Frictionless Engine Packing Co., Ltd.*, (1902) 19 R.P.C. at p. 516.

(18) (1912) 106 L.T. 926; 29 R.P.C. at p. 453.

may make; it is far more important that fair and honest trading should not unnecessarily be interfered with than that every fool in the country should be protected from the consequences of his own folly. Therefore, I think you must deal with the ordinary man and woman who should take ordinary care in purchasing what goods they require and, if desiring a particular brand, would take ordinary precautions to see that they get it.”<sup>19</sup> The Court is thus not bound to interfere where ordinary caution will enable the purchasers to distinguish between the plaintiff’s and the defendant’s trade marks.<sup>20</sup>

Even the evidence of a person who had been actually deceived may not be, therefore, conclusive. For, probability of deception does not mean “the probability of a casual deception of a particular individual, but the likelihood of the probable purchasers, or of members of the trade or of the public being deceived by the use of the word in question.”<sup>21</sup> So, in *Houghton v. Film Booking Offices, Ltd.*,<sup>22</sup> Bennett, J., in dismissing the action, observed: “Just as one swallow does not make a summer so it seems to me the fact that three people identify the title with Mr. Stanley Houghton’s play does not go sufficiently far to establish that the public identifies the title with Mr. Stanley Houghton’s play.” In *Civil Service Supply Association v. Dean*<sup>23</sup> the plaintiffs opened a store for boots and shoes. Shortly after, the defendant, a boot-maker, put a sign “Civil Service Boot Supply” on his shop which was situated in another street. The words “Civil Service” were common to the trade. It was held by Vice-Chancellor Malins that,

(19) “When we speak of a customer, we must, according to the decisions on the point, deal with one, or include one, not an expert, or in the trade, but a man of ordinary intelligence, who goes in not expecting deception, and to that extent unwary, but who knows generally the characteristics of Hennessy’s label—not incautiously looking out for differences from others, but treating the label fairly.” Sir Samuel Walkers, L. C., (Ireland) in *Hennessy & Co. v. Keating*, (1908) 1 I.R. 43; 25 R.P.C. at p. 131.

(20) “The testimony of individuals who do not take the trouble to examine even cursorily and superficially what is presented to their view, is of no help to the plaintiffs. On the contrary, their admission that the exercise of a minimum amount of care would have prevented any misapprehension on their part, goes a long way to disprove the existence of any real ground for the plaintiff’s apprehension.” Eve, J., in *Smith’s Potato Crisps, Ltd. v. Paige’s Potato Crisps Ltd.*, (1928) 45 R.P.C. at p. 46.

(21) *Maugham, J.*, in *T. & C. Associated Industries, Ltd. v. Victoria Wagon Works Ltd.*, (1931) 48 R.P.C. at p. 152.

(22) (1931) 48 R.P.C. at p. 339.

(23) (1879) L.R. 13 Ch.D. 512.

notwithstanding the positive testimony of a lady who said that she had been deceived, the defendants' use of the trade name was not unfair and injunction was refused. And in *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps, Ltd.*,<sup>24</sup> the action was dismissed by Eve, J., on the ground that, although even some persons in the trade had failed to recognize the distinction between the plaintiffs' and the defendants' tins, their failure had been only momentary and that the defendants' goods were clearly distinguishable from those of the plaintiffs. The decision was upheld on appeal.

**View taken by the Indian Courts.**—In view of the fact that a large majority of the people in India are illiterate, the Indian courts have often emphasized that the probable purchaser should be regarded as the incautious, ignorant or unwary person.<sup>25</sup> In *The Swadeshi Mills Co. v. Juggilal Kamalapat and Cotton Spinning and Weaving Mills Co., Ltd.*,<sup>1</sup> Mears, C. J., observed: "In considering the English authorities we shall have to be extremely careful always to bear in mind that the percentage of illiteracy in this country exceeds 90 per cent. of the population and that English, Hindi and Gujrati characters convey nothing to the unlettered. . . . In other words the standards differ and education is one of the factors. Quite apart from inability to read, we are satisfied that most of the illiterates in this country are so untrained as to the eye and brain in the reading and understanding of pictures that they would be quite unable to point out, for example, the

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(24) (1928) 45 R.P.C. 36, 132. See also *Fitchetts, Ltd. v. Loubet & Co., Ltd.*, (1919) 36 R.P.C. 296; *Mathieson v. Sir Isaac Pitman & Sons, Ltd.*, (1930) 47 R.P.C. 541; *Lundberg & Sons, Ltd. v. Letrik, Ltd.*, (1932) 49 R.P.C. at p. 21.

(25) *The Manockji Petit Manufacturing Co., Ltd. v. The Mahalaxmi Spinning and Weaving Co.*, 10 Bom. 217; *Badische Aniline v. Maneckji Shapurji*, 17 Bom. 584; *Nallaya v. Rangasami*, (1895) 1 Weir 556; *Nemichand v. Wallace*, 34 Cal. 495; 11 C.W.N. 537; *Aswini Kumar Pal v. Emperor*, 34 C.W.N. 524; *Abdul Salam v. Hamidullah*, 166 P.W.R. 1912. *The Swedish Match Co. v. Adamjee Hajee Dawood & Co., Ltd.*, A.I.R. 1927 Rang. 49; 4 Rang. 381; *Steel Bros. & Co., Ltd. v. Ahmed Ibrahim Bros.*, 99 I.C. 723; *Herbert Whitworth Ltd. v. Jamnadas*, 52 Bom. 228; A.I.R. 1928 Bom. 227; *Chwan Swee Bee v. National Carbon Co.*, A.I.R. 1930 Rang. 326; *Nagendra Nath Saha v. Emperor*, A.I.R. 1930 Cal. 274; *Moolji Sicca & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678; *Chetarpal Sharma v. Jagannath Das*, A.I.R. 1922 All. 178; 44 All. 608; *Kareem v. Kareem*, A.I.R. 1931 Mad. 461; *Mohideen Bawa v. Rigaud Perfume Manufacturers*, 10 Rang. 133; A.I.R. 1932 Rang. 114; *Faqir Chand v. Emperor*; 16 Lah. 114; A.I.R. 1934 Lah. 687; *Macdonald & Co. v. Holland and Moss*, (1914) 10 S.L.R. 175; 41 I.C. 539.

(1) 49 All. 92; A.I.R. 1927 All. 81; 24 A.L.J. 975. See also *Ralli v. Fleming*, 3 Cal. 417 (Garth, C. J.).

differences in the two coloured lotus pictures of the plaintiffs and the defendants, even if put side by side before them and wholly unable to carry the essential characteristics of either of them in their mind. They would know nothing more than they wanted a cloth with a red coloured flower gummed or affixed to it." It was, however, made clear in the above case that the standard to be considered is that of a "purchaser using ordinary caution." As has been pointed out already, the standard will no doubt depend upon the class of customers who are likely to buy the defendant's goods. So, in *Thomas Bear & Sons (India) v. Prayag Narain*,<sup>2</sup> Niamatullah, J., observed: "Persons who generally use this kind of tobacco are drawn from better class of villagers and men of the same position residing in towns. They are mostly Hindus, and probably for this reason the inscription on the packets is only in Hindi. . . . Any one who can read Hindi can at once find out the brand and the name of the manufacturer." His Lordship said that the probable purchasers should be neither those who are devoid of all sense of discrimination, nor persons who are very careful observers of things around them. And, in *Malumiar & Co. v. Finlay Fleming & Co.*,<sup>3</sup> the rule laid down by Lord Justice Romer in *Payton, Ltd. v. Snelling Lampard & Co.*,<sup>3a</sup> was quoted and followed by Carr, J. The English authorities are thus followed by the courts in India and the probable purchaser is taken to be an average person using ordinary caution satisfying the test proposed by Romer, L. J.

It is also well settled that non-deception of middlemen and vendors is immaterial and that it is the ultimate purchaser who has to be considered in deciding whether the defendant's mark is calculated to deceive.<sup>4</sup> For instance, in *Abdul Kareem Sahib v. Abdul Kareem Sahib*,<sup>5</sup> the court observed that "the imitation is

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(2) 57 All. 510; A.I.R. 1935 All. 7.

(3) 7 Rang. 167; A.I.R. 1929 Rang. 345. See also *Byramjee Cowasjee v. Vera Somabhai Motibhai*, (1916) 36 I.C. 965; 8 L.B.R. 561; 10 Bur.L.T. 53.

(3-a) 17 R.P.C. 48, 628.

(4) See *Balfour & Co. v. Kilburn & Co.*, 1 Hyde 270; *Steel Bros. & Co., Ltd. v. Ahmed Ibrahim Bros.*, 99 I.C. 723; *Nemi Chand v. Wallace*, 11 C.W.N. 537; *Madhavji Dharamsey Manufacturing Co., Ltd. v. The Central India Spinning, Weaving and Manufacturing Co., Ltd.*, 41 Bom. 49; *National Bank of India v. National Bank of Indore*, A.I.R. 1923 Bom. 119; 24 Bom.L.R. 1181; *Sirumal v. Emperor*, A.I.R. 1932 Sind 94; 26 S.L.R. 241; *Moolji Sica & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678.

(5) A.I.R. 1931 Mad. 461. See also *Sirumal v. Emperor*, 26 S.L.R. 241; A.I.R. 1932 Sind 94.



of course directed not to deceive the retail vendor, who must know the source from which he obtains his stock in trade and whose co-operation the defendant had endeavoured to enlist by selling his packages at one anna cheaper than those of the plaintiff," but that such non-deception was immaterial.

**Evidence in passing-off action.**—It is pointed out in the earlier sections that in every passing-off case the plaintiff has first to establish his title to the mark by proving that he is the prior user, and that the mark in question is inherently distinctive or has become associated in the market exclusively in connection with his goods. It is also mentioned that while the absence of evidence that persons have actually been deceived is not fatal to the plaintiff's right of action, the production of a few actual cases of deception would be of the utmost importance, especially where the court is in doubt as to whether the defendant's mark is calculated to deceive. Evidence may therefore be given of the presence or absence of confusion in the past.<sup>6</sup> Thus, where the marks of the plaintiff and the defendant had been used in the market concurrently for a long period and no case of any mistake or error can be established, the natural inference of the court would be that the defendant's mark is not calculated to deceive. It is further stated that innocent infringement is no valid defence, but where fraudulent intent on the defendant's part is established the court will, without further enquiry, generally presume that the mark is calculated to deceive. Evidence to show that the defendant adopted the mark with the express object of deceiving the public will, therefore, be very valuable. Thus, in the *Camel Hair Belting* case,<sup>7</sup> the correspondence between the defendant and his agent in India showing that the defendant's goods were stamped for fraudulent purposes largely influenced the decision of the House of Lords. Referring to this correspondence Lord Halsbury said: "The writer who doubtless knew what he was doing specially desires that the thing which he is ordering should bear no other stamp than 'Camel Hair Belting' and if he gets that, he adds 'I think I can take this order from Reddaways.' My Lords, with this letter before them the jury were perfectly right, and that my

(6) *Hutchinson's Application*, (1924) 41 R.P.C. 538; *Smith's Application*, (1923) 40 R.P.C. 77; *Egg Products Ltd.'s Application*, (1922) 39 R.P.C. 155; *Jones and Campbell Ltd.'s Application*, (1924) 41 R.P.C. 523.

(7) *Reddaway v. Banham*, (1896) A.C. 199; 13 R.P.C. 218. Similar correspondence by the defendant to the German manufacturers formed part of the evidence in *Radische Aniline and Soda Fabrik v. Maneckji Shapurji Kattrak*, 17 Bom. 584; *Smidt v. Reddaway & Co.*, 32 Cal. 401.

*prima facie* impression arising from the words being only descriptive of the article sold would have been wrong. The result is, in my mind, that the proof is satisfactory, and that one man's goods are being sold as if they were the goods of the other." But even in cases where fraud is shown the plaintiff may succeed in satisfying the court that the mark is not calculated to deceive the purchasers and evidence may be adduced for this purpose. Again, where special damage is alleged the onus is on the plaintiff to prove such special damage.

**Witness shall not be asked whether mark is calculated to deceive the public.**—On the other hand, evidence of so-called experts, who say, whether, in their opinion, a customer is or is not likely to be deceived is not admissible. This rule is now well settled since the decision of the House of Lords in *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*<sup>8</sup> In that case the respondents had carried on business for several years in Manchester and elsewhere. The North Cheshire Brewery Co., whose brewery was at Macclesfield but who had also been doing some business at Manchester, had their trade name registered as "North Cheshire and Manchester Brewery Co., Ltd." On motion by the plaintiffs, injunction was granted restraining the defendants from trading under the new name, on the ground that it was likely to lead the public to the wrong belief that the two firms had amalgamated. Lord Halsbury said: "When one comes to see that the real question is, it is contained in a single sentence—Is this name so nearly resembling the name of another firm as to be likely to deceive? That is a question upon which evidence, of course, might be given, as to whether or not there was another brewery, either in the one place or in the other, or whether there were several breweries, nearly resembling it in name; what the state of the trade was; or whether there was any trade name; all those are matters which are proper to be dealt with upon evidence, but upon the one question which Your Lordships have to decide, whether the one name is so nearly resembling another as to be calculated to deceive, I am of opinion that no witness would be entitled to say that, and for this reason; that is the very question which Your Lordships have to try."<sup>9</sup>

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(8) L.R. (1899) A.C. 83.

(9) This ruling is followed in the Indian courts, see for instance *Nemi Chand v. Wallace*, 11 C.W.N. 537, where Maclean, C. J., observed: "In order to arrive at a conclusion as to whether or not one mark is calculated to deceive purchasers into the belief that they are buying the goods of one

The same rule was stated in the House of Lords by Lord Macnaghten, two years later, in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*,<sup>10</sup> thus: "A great deal of the evidence is absolutely irrelevant and I do not myself altogether approve of the way in which the questions were put to the witnesses. They were put in the form of leading questions and the witnesses were asked whether a person going into the shop as a customer would be likely to be deceived and they said that they thought they would. But that is not matter for the witness; it is for the judge. The judge, looking at the exhibits before him and also paying due attention to the evidence adduced must not surrender his own independent judgment to any witness whatever."

**London General Omnibus Company v. Lavell.**—Lord Halsbury's ruling in the North Cheshire Brewery case was discussed by the Court of Appeal in the *London General Omnibus Company v. Lavell*.<sup>11</sup> In the latter case the defendant had painted his bus in imitation of the plaintiffs' but no evidence of actual or probable deception was adduced though it was admitted that the defendant's omnibus had been running in practically the same condition for ten years. Farwell, J., after inspecting the two buses decided that the general get-up of the defendant's bus was a close imitation of the plaintiffs' bus and granted an injunction. This order was, however, set aside on appeal. Referring to Mr. Justice

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manufacturer when they are not his goods, we may look at the two marks in question with our own powers of forming an opinion, accompanied by the evidence which is given in the case." *Nooroodeen Sahib v. Charles Souden*, 33 Mad. 402; *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, A.I.R. 1925 Cal. 220; 40 C.L.J. 230. *Jamal Noor Mohamed Sait Co. v. Abdul Kareem & Co.*, 57 Mad. 600; A.I.R. 1934 Mad. 211. Opinion of experts as to whether the goods are calculated to deceive is inadmissible under Sec. 45 of the Indian Evidence Act, *Macdonald & Co. v. Holland & Moss*, (1914) 41 I.C. 539; 10 S.L.R. 175.

(10) (1901) A.C. 308; 17 R.P.C. at p. 635. See also *Alaska Packers' Association v. Crooks & Co.*, (1899) 16 R.P.C. 503; 18 R.P.C. 129; *Addley Bourne v. Swan and Edgar, Ltd.*, (1903) 20 R.P.C. 105; *Lambert and Rutler, Ltd. v. Goodbody*, (1902) 18 T.L.R. 394; *Weingarten Bros. v. Charles Bayer & Co.*, (1905) 22 R.P.C. 341; *Cropper Minerva Machine Co., Ltd. v. Cropper Charlton & Co., Ltd.*, (1906) 23 R.P.C. 388; *Apollinaris Co., Ltd. v. Duckworth & Co.*, (1906) 22 T.L.R. 744; 23 R.P.C. 540; *In re Jelley, Son and Jones Application*, (1878) 51 L.J.Ch. 639; 46 L.T. 381; *Coleman & Co., Ltd. v. Stephen Smith & Co.*, (1911) 2 Ch. 572; 29 R.P.C. 81. In *Jones Bros., Ltd. v. Anglo-American Optical Co.*, (1912) 29 R.P.C. 361, Cozens-Hardy, M. R., said: "So far as my eyes enable me to say, and so far as it is my duty to judge by that, I can see no resemblance such as is calculated to deceive."

(11) (1901) 1 Ch. 135; 18 R.P.C. 74.

Farwell's judgment, Lord Alverstone, C.J., said: "It seems to me to have proceeded upon the theory . . . that the plaintiffs are entitled to succeed on the simple proving of the colour and design of their own omnibus, and on the learned judge viewing the defendant's omnibus and the plaintiffs' and comparing them together. In my opinion, that is not sufficient evidence to justify a plaintiff in obtaining either an injunction or damages. We have no evidence as to what is the custom or practice or habit of persons who travel by these omnibuses. We have no evidence as to what have grown up to be regarded as the leading features of omnibuses on any particular route; but we are asked to say that the learned judge was right in coming to the conclusion that, because he thought that the two omnibuses so resembled one another that they might be mistaken, that is sufficient evidence to support an injunction in an action for deceit. I wish to say, in the first place, that I think if any such view were to prevail a very undesirable and erroneous practice might grow up with reference to the viewing or seeing by the judge of the subject-matter of the action or anything relating to the subject-matter of the action. I have never heard it said, and speaking for myself, I should be very sorry to endorse the idea that a learned judge is entitled to put a view in the place of evidence. . . . Of course it is quite possible that there may be cases in which all the circumstances connected with the dispute are of such common knowledge, and are so well known to the tribunal, that it may be said that no evidence is necessary." The learned Chief Justice then referred to Lord Halsbury's ruling and observed: "It is said that in the case of the *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*,<sup>11-a</sup> the Lord Chancellor said he would not have required any evidence in that case, and he perhaps, in one respect, went further, and said that the particular question could not have been put to the witness, because it was a question which the Judge had to decide. But I am satisfied, that the Lord Chancellor did not mean to lay down any general rule that no evidence that things were calculated to deceive was ever to be required. In that case evidence had been given, and it was merely, so to speak, the comparison of the two names which may be said to speak for themselves. Here, the court is obliged to make itself acquainted with, or to make an assumption as to, what are the habits of people travelling in omnibuses and the matters which are important for their consideration." And Vaughan Williams, L. J., added: "The moment you get a

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(11-a) (1898) 1 Ch. 539; (1899) App. Ca. 83.

case in which it is possible to give evidence, and in which such evidence would obviously be material and important, one draws the very strongest inference from the fact that no such evidence is called or tendered."

The above judgment has been the subject of some discussion in later cases. For instance, in *Bourne v. Swan and Edgar, Ltd.*,<sup>12</sup> Mr. Justice Farwell said that the judgment of the Court of Appeal reversing his decision in the London Omnibus Company's case was based on the footing that it was an action for deceit and that the judgment had consequently no application to passing-off cases. This view is, however, open to some criticism. For, it may be noted that, although it was said in that case that there was not sufficient evidence "to support an injunction for an action for deceit,"<sup>13</sup> it is clear from the judgment of the Court of Appeal that the case was not treated as merely an action for deceit under the Common Law. So, in *Hennessy & Co. v. Keating*,<sup>14</sup> Lord Justice Fitzgibbon observed that the judgment of the Court of Appeal in the London Omnibus Company's case would apply to cases in which proof of actual deceit was not necessary. His Lordship proceeded to state the rule in the following passage: "I respectfully submit that though judges, whether at law or in equity, cannot delegate to so-called experts the pronouncement of the only authoritative opinion upon the question at issue, parties are entitled to give and judges are bound to consider, wherever it is material, the evidence of those who are better acquainted than they are with the circumstances under which the question arises, before deciding whether either actual deceit has been proved or whether any particular resemblance is likely to deceive. I do not understand Lord Alverstone to have decided otherwise."

**Evidence of fact may be adduced.**—Thus while no evidence may be necessary where the defendant's trade mark or name is an exact or substantial copy of the plaintiff's or where the two marks or names "speak for themselves," in other cases the plaintiff "cannot appeal solely to the eye of the judge, and ask him without more to compare the two things."<sup>15</sup> It is for the plaintiff to prove his

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(12) (1903) 1 Ch. 211; 20 R.P.C. 105.

(13) Per Lord Alverstone, C.J., *London General Omnibus Company v. Lavell*, (1901) 1 Ch. 135 at p. 139; 18 R.P.C. 74, but his Lordship proceeded to say that, "it is not necessary to show actual deception, because a thing may be calculated to deceive, and the plaintiffs may be justified in coming to stop the practice before the actual deception has taken place."

(14) (1908) 25 R.P.C. at p. 138; (1908) 1 I.R. 43.

(15) Per Cozens-Hardy, M. R., in *Perry & Co. v. T. Hessin & Co.*,

case and he will have to establish that the way in which the defendant's goods are put upon the market is such as to enable them to be passed off as and for their goods. "It would be very rash *a priori*," said Lord Halsbury, "to say how far a thing might or might not be described without being familiar with the technology of the trade."<sup>16</sup> Much weight will therefore be given to expert evidence where such evidence is confined to the facts upon which the decision of the court has to be based; evidence, for example, to prove what features are common to the trade, and what additions are peculiar to the plaintiff's and the defendant's articles respectively, whether the purchasers are likely to be literate or illiterate, and about the manner in which the goods are dealt with in the market.<sup>17</sup> Evidence as to the practice of the trade may be very material in some cases in order that the court may decide whether the mark is calculated to deceive. So in *Schweppees, Ltd. v. Gibbens*<sup>18</sup> where the dispute related to the use of certain labels on

(1912) 29 R.P.C. at p. 528. See also *Clark v. Sharp*, (1898) 15 R.P.C. 141; In *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, (1907) 24 R.P.C. 27, Parker, J., said: "In coming to a conclusion of a case of this nature, the way it strikes the individual mind of the judge is of importance, and it is also important that the judge should have evidence to confirm his impression and the conclusion he comes to on the point whether or not he thinks on a comparison of the way the letters are used by the rival traders having regard to the surrounding circumstances, confusion might arise" In *Rose & Co., Ltd. v. Alexander Riddle & Co., Ltd.*, (1914) 31 R.P.C. 48, Swinfen Eady, L. J., said:—"Although the judge looks at the various exhibits, he has to decide according to the evidence, and is not entitled to decide merely on his own view by looking at the Exhibits."

(16) *Reddaway v. Banham*; (1896) A.C. 199; 13 R.P.C. 218 (H.L.).

(17) "I am supposed to be ignorant of the ways of the people who buy these things and have to be instructed as to what the get-up would convey to them." Warrington, J., in *De Long Hook and Eye Co. v. Newey Bros., Ltd.*, (1912) 29 R.P.C. p. 60. See also *Mitchell v. Henry*, (1880) 15 Ch.D. 181; In re *Worthington*, (1880) 14 Ch.D. 8; In re *Christiansen*, (1886) 3 R.P.C. 54; *Clark v. Sharp*, (1898) 15 R.P.C. 141; *Prichard & Constance (Wholesale), Ltd. v. Amata, Ltd.*, (1925) 42 R.P.C. 63; *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, 40 C.L.J. 230; A.I.R. 1925 Cal. 220; *Upendra Nath Brahmachari v. Union Drug Co., Ltd.*, 34 C.L.J. 405; A.I.R. 1926 Cal. 837; *Rose & Co., Ltd. v. Alexander Riddle Co., Ltd.*, (1914) 31 R.P.C. 48; *Farrow's Tm. case*, (1890) 63 L.T. 233; 7 R.P.C. 260.

(18) (1905) 22 R.P.C. at p. 118. Evidence of experts in the Chemist's trade as to the nature of trade that is done by Chemists, wholesale and retail was given in *Prichard & Constance, (Wholesale), Ltd. v. Amata, Ltd.*, (1925) 42 R.P.C. 63; evidence of brokers was admitted in *National Bank of India v. National Bank of Indore*, 24 Bom.L.R. 1181; A.I.R. 1923 Bom. 119; commission to take evidence in South Africa as to the manner in which the goods were dealt with was allowed in *Rose & Co., Ltd. v. Alexander Riddle & Co., Ltd.*, (1914) 31 R.P.C. 48.

soda-water bottles Warrington, J., said that in order to appreciate the question properly the Court should consider evidence from licensed victuallers as to how soda-water is served by them to customers. "It seems to me" said His Lordship "that each of these cases must be looked at by itself, and the Judge, looking at the label or the get-up or device, whatever it may be that is complained of, with such assistance as to the practice in the trade as he can get from the witnesses, must decide for himself whether the article complained of is calculated to deceive or not."

**Rule by Buckley, L. J. as to relevant evidence.**—The rule as to what evidence is admissible in passing-off cases has been admirably summed up by Buckley, L.J., in the following passage:<sup>19</sup> "What the plaintiffs have set out to prove is that the get-up is one calculated to deceive. Here let me say what evidence it is competent to the plaintiffs to produce for that purpose. What is relevant evidence, of course it is relevant to call a person who says he was deceived in fact, he went to buy the one and bought the other. . . . If you cannot do that, you have to prove that the article is calculated to deceive; then you may call as a witness any person who is in a position to say:—'I know that market. I am accustomed to hear persons asking for goods in that market, and I am able to say that purchasers pay particular regard to the colour of this box or the shape of this bottle, or to the existence of a particular disc coloured red, or to the fact that there is a picture of an elephant, or to any detail to which particular attention can be called;'—in other words you may call any witness to say: 'I know the market, and I know the particular thing by this get-up which is what catches the public eye, and that is what they look for, and you have repeated that.' Of course a witness may say that. Then he may say that the article in question has obtained by usage a name which is a verbal description of some prominent characteristic of the get-up, as for instance, if a thing has got an elephant upon it, and people ask for elephant blacking, or elephant sealing wax, or whatever it may be. . . . All that is relevant evidence, and that has to be addressed to the tribunal in order that the tribunal may form its own opinion; but you cannot go on and call a witness to say, 'Looking at that thing it would deceive someone, not myself, in this market.' That is not admis-

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(19) *Perry & Co., Ltd. v. Hessin & Co.*, (1912) 29 E.P.C. at p. 533; 56 Sol. Jo. 572.

sible, because it is the very thing which the tribunal has to decide,—whether it would deceive other people.”

**Witness may state the effect of the mark on his mind.**—While a witness shall not be asked whether the mark is likely to deceive the public,<sup>20</sup> he may be questioned whether he himself would be deceived by it. As Earl Loreburn, Lord Chancellor, said: “Although it is not competent for a witness to be asked his opinion about the conclusion to which the Court is to arrive, namely, whether the public generally, or a special class of the public, would be likely to be deceived, it is competent to ask him the question whether he himself, being in the trade and familiar with the subject-matter concerned, would be misled.”<sup>21</sup> But it was pointed out by Farwell, L. J., in *Addley Bourne v. Swan and Edwar, Ltd.*,<sup>22</sup> that it would be extremely difficult to get any such evidence. “Nobody quite likes to admit that he is so extremely foolish, as in many cases he would have to do.”

**Evidence of fraud by a third person inadmissible.**—The defendant cannot be made responsible for a retailer passing-off the defendant's goods as the goods of the plaintiff, if the defendant has done his legal duty in distinguishing his goods from those of the plaintiff. The court may not, therefore, allow a witness to be asked whether, considering that the get-up of the defendant's goods is similar to the plaintiff's it would not enable a dishonest trader to pass off the one for the other.<sup>23</sup> Such evidence relating to a third party is irrelevant to the point at issue. A charge of fraudulent intention, if made, must be made out in the person who

(20) For instance, in *Hennessy & Co. v. Dompe*, (1902) 19 R.P.C. p. 333, Kekewich, J., declined to allow to be put to the witness the question whether the mark was calculated to deceive the public. See *Harrod's Ltd. v. R. Harrod, Ltd.*, (1923) 40 T.L.R. 195; 41 R.P.C. p. 74; *Macmillan v. Ehrmann, Bros., Ltd.*, (1904) 21 R.P.C. 357. “You do not take the evidence of witnesses as experts as to what they think other people would believe or not. It is what they speak of as to themselves.” *Coleman & Co., Ltd. v. Stephen Smith & Co.*, (1911) 2 Ch. 572; 29 R.P.C. at p. 98 (Farwell, L.J.).

(21) *Claudius Ash, Sons & Co., Ltd. v. Invicta Manufacturing Co. Ltd.*, (1912) 29 R.P.C. at p. 476. See also *Dimech (William) v. Goffredo Alessandro Chretien*, A.I.R. 1931 P.C. 15; 61 M.L.J. 334 (P.C.); *Mohideen Bawa v. Rigaud Perfume Manufacturers*, 10 Rang. 133; A.I.R. 1932 Rang. 114.

(22) (1903) 1 Ch. 211; 20 R.P.C. 105.

(23) See Lord Macnaghten's judgment in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, (1901) A.C. 308; 17 R.P.C. at p. 635.



is charged and the plaintiff's case cannot be based on the supposed fraud of one who is not a party in the suit. So, in *Schweppes, Ltd. v. Gibbens*,<sup>24</sup> it was contended that a barman might fraudulently substitute the defendant's soda-water bottles for those of the plaintiffs, but this argument was summarily rejected by Lord Chancellor Halsbury when the case was heard before the House of Lords.

**Earlier decisions relevant as evidence only.**—It has been held that, in considering the complainant's title to the mark judgments of courts which are on record, where the same issue had been tried and decided, are relevant under Sec. 13 of the Indian Evidence Act as a particular instance in which the right was claimed and disputed.<sup>25</sup> But it will have to be borne in mind that circumstances may have so altered since the earlier decision that a mark previously held to be descriptive has subsequently become distinctive or *vice versa*. Thus, in the Daimler cases although the word 'Daimler' was held in the first case<sup>1</sup> to be descriptive of a system of motors and not to have acquired a secondary meaning, the Court of Appeal in the second case<sup>2</sup> granted an injunction on the ground that the word 'Daimler' had in the meantime become distinctive of the plaintiffs' motor cars.

**Trap orders.**—It may often be difficult to get evidence of independent witnesses to prove the passing-off of goods by the defendant. In such cases trap orders may be the only method open to a plaintiff to establish his case. The plaintiff generally resorts to making test purchases through his servants or agents from the defendant's shop with a view to establish a few cases of passing-off. These agents go to the defendant's shop with the express purpose of entrapping him if possible, and obviously, will not, therefore, themselves be deceived by the spurious goods supplied. Evidence relating to trap orders is, however, admissible and is of value as it shows the course of conduct generally adopted by the defendant when the plaintiff's goods are ordered and the effect of such con-

(24) (1905) 22 R.P.C. 601.

(25) *Palli Ram v. Emperor*, A.I.R. 1931 Oudh 277; 8 O.W.N. 827, Kisch, J.

(1) *Daimler Motor Car Co., Ltd. v. British Motor Traction Co., Ltd.*, (1901) 18 R.P.C. 465.

(2) *Daimler Motor Co., (1904), Ltd. v. London Daimler Co., Ltd.*, (1906) 23 R.P.C. 718; (1907) 24 R.P.C. 379.

duct in the minds of the ordinary purchasers using ordinary caution. Certain important points must be observed, however, with regard to evidence of this nature. "It is now well settled that in these cases of trap orders the court must be very careful that plaintiff proves his case beyond peradventure."<sup>3</sup> As was pointed out by Mr. Justice Byrne, it is necessary to remember in dealing with such evidence that "when a party goes in who has his mind full of catching another one out through the medium of a trap, he goes with his mind full of the kind of answer he expects to get and the kind of question he is going to put."<sup>4</sup> This is not the case with an ordinary purchaser. The plaintiff must, therefore, satisfy the court that the trap orders were fairly set.<sup>5</sup> The order must be placed in clear and unambiguous form and the attention of person supplying the goods should be expressly drawn to what was being asked for.<sup>6</sup> Written orders should, therefore, be preferred.<sup>7</sup> Wherever practicable, the order must be placed with a person of responsibility.<sup>8</sup> The court may refuse to attach weight to evidence of casual transactions where the matter depends upon some exchange of remarks made weeks or months before the trial.<sup>9</sup> Legal proceedings should be taken as quickly as possible after the trap order has been effected. Immediately after the trap order the defendant must be informed of the intention of the party to rely upon what had taken place, so that "warning may be given to the defendant that certain transactions are going to be called in question before the memory grows dull with reference to such

(3) *C. C. Wakefield & Co., Ltd. v. Russell*, (1930) 47 R.P.C. at p. 477 (Clauson, J.). See also *Wakefield & Co., Ltd. v. Purser*, (1934) 51 R.P.C. 167.

(4) *Truefitt, Ltd. and H. P. Truefitt v. Edney*, (1903) 20 R.P.C. 321 at page 328.

(5) *California Fig Syrup Co. v. Taylor's Drug Co., Ltd.*, (1897) 14 R.P.C. 341, 564; *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, (1912) 106 L.T. 472; 29 R.P.C. 225; *The General Electric Co., Ltd. v. Pryce's Stores*, (1933) 50 R.P.C. 232; *C. C. Wakefield & Co., Ltd. v. Purser*, (1934) 51 R.P.C. 167.

(6) *Carr & Sons v. Crisp & Co., Ltd.*, (1902) 19 R.P.C. 497, *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps Ltd.*, (1928) 45 R.P.C. 132; *Burberrys v. Watkinson*, (1906) 23 R.P.C. 141; *Fox's Glacier Mints, Ltd. v. Joblings*, (1932) 49 R.P.C. 352.

(7) *Smith's Potato Crisps, Ltd. v. Paige's Potato Crisps, Ltd.*, (1928) 45 R.P.C. at p. 152, Lawrence, L. J.

(8) *C. C. Wakefield & Co., Ltd. v. Board*, (1928) 45 R.P.C. 261; *Wakefield & Co., Ltd. v. Russell*, (1930) 47 R.P.C. 473.

(9) *Byrne, J., in Burroughs, Wellcome & Co. v. Thompson & Capper*, (1904) 21 R.P.C. 69.

transactions.”<sup>10</sup> “If you want the Court to rely upon the testimony of persons trapping,” said Farwell, J., “when they have completed their trap and have got the victim in it, the least they can do is to tell him that that is the occasion that they are going to give evidence about in Court, so that, then and there, he may be able to recall and recover his recollection of the circumstances and be ready to give his account in Court, so that the Court should not be asked to rely upon the testimony of witnesses for the Plaintiffs on the ground that the Defendant cannot possibly remember what took place.”<sup>11</sup> The defendant must be provided with complete particulars immediately after the trap order. “It is essential,” said Lawrence, L. J., “in cases of trap orders, that the circumstances should be most carefully investigated, the manner in which the goods were asked for, the occasion upon which they were asked for, with all such particulars which might or might not lead the Court to assume that there had been a mistake, rather than fraud.”<sup>12</sup> Evidence of trap orders may often have to be corroborated by other independent evidence, as the court may not attach much weight to the evidence of detectives,<sup>13</sup> and other interested agents, especially when this is contradicted by the ‘honest evidence’ of the defendant’s servants.<sup>14</sup>

(10) Evidence of a trap order was rejected as nothing was said of it until after the proceedings had been instituted, *C. C. Wakefield & Co., Ltd. v. Russell*, (1930) 47 R.P.C. 473; *C. C. Wakefield & Co., Ltd. v. Purser*, (1934) 51 R.P.C. 167; *Carr & Sons v. Crisp & Co., Ltd.*, (1902) 19 R.P.C. p. 502; *C. C. Wakefield & Co., Ltd. v. Board*, (1928) 45 R.P.C. 261; *Hampshire & Co.*, (1927) *Ld. v. General Kaputine Syndicate, Ltd.*, (1930) 47 R.P.C. 437.

(11) *Ripley v. Griffiths*, (1902) 19 R.P.C. 590 at p. 597. See also *Smith’s Potato Crisps, Ltd. v. Paige’s Potato Crisps, Ltd.*, (1928) 45 R.P.C. 132; *C. C. Wakefield & Co., Ltd. v. Purser*, (1934) 51 R.P.C. 167.

(12) *Smith’s Potato Crisps, Ltd. v. Paige’s Potato Crisps, Ltd.*, (1928) 45 R.P.C. at p. 152.

(13) “I distrust the trap order method of obtaining evidence,” Cunliffe, J., in *The Swedish Match Co. v. Adamjee Hajee Dawood & Co., Ltd.*, 4 Rang. 381; A.I.R. 1927 Rang. 49. “I attach no weight to the evidence of witnesses who set out on an expedition to entrap as many salesmen as they could in the time at their disposal,” Lawrence, L. J., in *Smith’s Potato Crisps, Ltd. v. Paige’s Potato Crisps, Ltd.*, (1928) 45 R.P.C. at pp. 151, 152. “Must be regarded with just a little suspicion,” Clauson, J., in *Hampshire & Co.*, (1927), *Ld. v. General Kaputine Syndicate, Ltd.*, (1930) 47 R.P.C. at p. 443. “It is a method that instinctively one dislikes,” Clauson, J., in *C. C. Wakefield & Co., Ltd. v. Russell*, (1930) 47 R.P.C. at p. 476. “Trap orders are scrutinised by the Courts with some jealousy,” Farwell, J., in *C. C. Wakefield & Co., Ltd. v. Purser*, (1934) 51 R.P.C. at p. 171.

(14) *Montgomerie & Co., Ltd. v. Young Brothers*, (1904) 21 R.P.C. at p. 292, (Lord Young).

**Imitation of get-up.**—A combination of labels or designs arranged in a novel manner or a distinctive mode of packing may be used by a manufacturer to distinguish his goods from similar goods of other make. When such get-up acquires by user an exclusive reference to his goods in the market a rival manufacturer will be restrained from imitating the same.

One of the earliest cases dealing with imitation of get-up is *Knott v. Morgan*.<sup>15</sup> The defendants painted their own omnibuses exactly like the plaintiffs' and copied even the livery of their servants. Injunction was granted by Lord Langdale, M. R., who said: "I have not the least doubt that the defendant did intend to induce the public to believe that the omnibus which he painted and appointed, so as to resemble the carriages of the plaintiffs was in fact an omnibus belonging to the plaintiffs. . . . It is not to be said that the plaintiffs have any exclusive right to the words 'Conveyance Company' or 'London Conveyance Company,' or any other words; but they have a right to call upon this Court to restrain the defendant from fraudulently using precisely the same words and devices which they have taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business by attracting custom on the false representation that carriages, really the defendant's, belong to and are under the management of the plaintiffs."

In *Lever v. Goodwin*<sup>16</sup> the plaintiffs were selling their "Sun-light selfwasher soap" in 12 oz. tablets, which form had not been used before. The tablets were put up in wrappers made of imitation parchment paper on which certain letter press was printed in spaced printing and the defendants began selling their "Goodwin self washing soap," also in 12 oz. tablets, in similar wrappers with a similar letter press. An action for passing-off was successful and an injunction was granted.<sup>17</sup>

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(15) (1836) 2 Keen 213; 48 E.R. 610. Followed: *London General Omnibus Company v. Turner*, (1894) 38 Sol.Jo. 457. See also *London General Omnibus Co. v. Felton*, (1896) 12 T.L.R. 213 and *London Road Car Co. v. Era Omnibus Association*, Times, June 23rd, 1898.

(16) (1887) 36 Ch.D. 1; 4 R.P.C. 492. Cf. *Lever Brothers, Ltd. v. Bedingfield*, (1898) 80 L.T. 100; 16 R.P.C. 3, where an injunction was refused. See also *W. & G. Du Cros, Ltd. v. Gold*, (1912) 29 T.L.R. 163; 30 R.P.C. 117 ('Get-up of motor cabs'); *Day v. Eiley and Whittaker*, (1900) 48 W.R. 556; 17 R.P.C. 517 (use of bottle of similar shape and labels and title 'Black Drink for animal medicines').

(17) Injunction was also granted in *Jones v. Hallworth*, (1897) 14 R.P.C. 225, where the defendants had imitated the colour, border and size of the plaintiffs' "Selvyt" polishing cloth; but

*Chetarpal Sharma v. Jagannath Das*<sup>18</sup> is a similar case. The plaintiff who was selling a medicine by the name of "Sudha Sindhu" complained that the defendant commenced to sell another medicine under the name "Piyus Sindhu" adopting closely the get-up used by the plaintiff. In granting an injunction the court observed: "No one comparing these two sets of labels can have any reasonable doubt that the person, who a year before the commencement of this action brought the defendant's label into existence, had the plaintiff's labels before him and copied them as accurately as he dared to do. . . . Inside the outer covering of each of these medicines, there are directions and advertisements. They are of the usual florid character which are used in patent medicines. But point of importance is this, that when the defendant is describing all the virtues which his medicine possesses, we find that he is taking in many cases word for word the advertisements which the plaintiff had previously drafted years before. . . . Two persons sitting down independently to describe coughs, asthma, diarrhoeas, etc., would no doubt give generally a similar description but a comparison of the text shows beyond doubt that the defendant copied the text of the plaintiff, being careful, however, to make occasional transpositions."

**Pictorial representations.**—Distinctive pictures and portraits are often used as part of the plaintiff's trade mark or get-up.<sup>19</sup> Where such pictures have acquired a secondary signification fraudulent imitation of them becomes actionable. Thus, in *Jay v.*

cf. *Jones Bros., Ltd. v. Anglo-American Optical Co.*, (1912) 29 R.P.C. 1, 361, where the plaintiffs' action was dismissed. In *Briggs* (trading as *Briggs & Co.*) v. *Dunn & Co.*, (1911) 28 R.P.C. 704, the plaintiffs' mark consisted of the representation of a pick together with the word "Pick" while the defendants advertised their goods by show cards and posters on which appeared a pick with the words, "Bargains, Pick them Out." In spite of the defendants' contention that they had not used the device of a pick on the goods themselves and that they used the word 'Pick' as a verb in calling attention to their goods an interlocutory injunction was granted.

(18) 44 All. 608; A.I.R. 1922 All. 178. See also *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461; *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, A.I.R. 1925 Cal. 220; 40 C.L.J. 230.

(19) See, for instance *James' Trade Mark*, (1886) 55 L.J.Ch. 95; 3 R.P.C. 340; *Upper Assam Tea Co. v. Herbert & Co.*, 7 R.P.C. 183; *In re Magnolia Metal Co.'s Trade Marks*, (1897) 2 Ch. 371; 14 R.P.C. 265; 621. *Cowie Bros. & Co. v. Herbert*, (1897) 14 R.P.C. 436; *Sphinter Grip Armoured Hose Co.'s Trade Mark*, (1893) 10 R.P.C. 84; *Hodgson and Simpson v. Kynoch, Ltd.*, (1898) 15 R.P.C. 465; *Rowland v. Mischell*, (1897) 1 Ch. 71; 14 R.P.C. 37; *Jawala Prasad v. Munna Lal Serowjee*, 37 Cal. 204; *Faqir Chand v. Emperor*, A.I.R. 1934, Lah. 687; 16 Lah. 114.

*Ladler*<sup>20</sup> the picture of a bear and a lady was held to designate the plaintiff's furs and that of no one else, and in *Herbert Whitworth, Ltd. v. Jamnadas Nemichand Mehta*<sup>21</sup> the picture of a Somali horseman and a Somali girl was held to have become distinctive of the plaintiffs' shirtings. The use of pictures of mythological persons and Hindu deities as trade marks is common in this country.<sup>22</sup>

**Colour, etc.**—The essence of the get-up of the plaintiff's goods may lie in the use of a particular colour. The use of the same or a similar get-up in a different colour by a rival trader on his goods may not then be restrained. Thus in *Dunhill v. Bartlett and Bickley*<sup>23</sup> injunction restraining the defendants from using the plaintiff's mark was limited to the use of the particular colour which had become distinctive of the plaintiff's goods.

A special type adopted for printing the trade name or description may be protected, although the name or description may not itself be distinctive.<sup>24</sup>

**Get-up does not include useful parts of the article.**—It has been ruled that the get-up of an article does not include any constructional feature that has a value in use. A plaintiff cannot claim a monopoly of adjuncts of his goods that are merely objects of utility as distinguished from capricious additions. "The get-up of an article" said Lord Justice Fletcher Moulton in *Williams Co. v. Bronnley & Co., Ltd.*,<sup>25</sup> "means a capricious addition to the article itself,—the colour, or shape, it may be, of the wrapper, or anything of that kind; but I strongly object to look at anything, that has a value in use, as part of the get-up of the article. Anything which is in itself useful appears to me rightly to belong to the article itself." In the case cited above the question arose whether a monopoly could be claimed in the use of tin lined boxes for soaps. The action failed and an appeal was dismissed.

(20) (1889) 40 Ch. D. 649; 6 R.P.C. 136.

(21) 52 Bom. 228; A.I.R. 1928. Bom. 227.

(22) See for instance *The British American Tobacco Co., Ltd. v. Mahboob Buksh*, 15 C.W.N. 280, "Sri Durga" and "Jagatdhatri" cigarettes).

(23) (1922) 39 R.P.C. 426.

(24) *Weingarten Bros. v. Charles Bayer & Co.*, (1905) 92 L.T. 511; 22 R.P.C. 341.

(25) (1909) 26 R.P.C. 765 at p. 773.

A similar question arose in *Edge and Sons Ltd. v. Niccolls and Sons, Ltd.*<sup>1</sup> The plaintiffs complained that their "Dolly" blue wrapped in a bag of cotton from which a stick protruded had acquired reputation in the market and that the defendants sold other blues in similar bags with a stick protruding therefrom. It was admitted that the stick served as a handle enabling the user to hold the bag in the washing water without staining the fingers, and was as such an article of utility. The judgment of Swinfen Eady, J., granting an injunction was reversed by the Court of Appeal who held that the stick being a useful part of the article could not be regarded as part of the get-up. An appeal to the House of Lords, was, however, successful on a different issue.

The principle underlying the above rule was explained by Farwell, L.J., in the following passage: "No man can acquire a monopoly of manufacture, except under a patent; if he makes an article and relies solely on its necessary or useful component parts to distinguish his make from that of others, he is not entitled to complain because others, who make the same article, adopt the same shape and form, although they may thereby lead people to believe that their articles are those of the plaintiff: he has deliberately run the risk of such deception in order to try to obtain a monopoly to which he can never be entitled; such an attempt is not fair trading from the point of view of his rivals or of the public; it puts his rivals in the disagreeable dilemma of having to run the risk of misleading or of giving up the whole of the trade in a particular article, and it is a fraud on the public as an attempt to establish a monopoly, not for fourteen years as given by a patent, but for all time, and not in consideration of any merit but simply by lapse of time."<sup>2</sup>

**Registered designs are not trade marks.**—The enormous increase in design piracies in recent years in this country has led to enquiries by the commercial community as to whether action could be taken to restrain such piracies under the law of unfair competition. It may be stated at the outset that legal proceedings against infringement of registered designs can be instituted under the Indian Patents and Designs Act<sup>3</sup> and not under the law of

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(1) (1911) A.C. 693; 27 R.P.C. 671; 28 R.P.C. 53; 582.

(2) *Edge & Sons, Ltd. v. Niccolls & Sons, Ltd.*, (1911) 1 Ch. 5 at p. 17; 28 R.P.C. at p. 65.

(3) Section 53.

passing-off.<sup>4</sup> The distinction between the two branches of law is that, while the law of unfair competition is based on the broad proposition that no man has a right to pass off his goods as and for the goods of another, the law of designs manifestly proceeds on the principle that giving to an article of manufacture certain new and original appearances, which arrest and please the eye of the purchasers, is an act of service to the public deserving encouragement by the State. The law of designs, therefore, proposes to secure for the registered proprietor all the advantages flowing from his inventive effort, but the law makes it clear that the copyright is allowed only for a limited period,<sup>5</sup> and that at the end of this period the design becomes common to the trade. Any member of the public is entitled thereafter to copy, sell or use the registered design for his own purpose, and no charge of unfair competition can in these circumstances be made against a rival.<sup>6</sup>

**Designs may acquire secondary signification.**—The distinction between a trade mark and a design was stated by Sargant, L. J., thus: "A trade mark and a design are two quite different things, ordinarily speaking. A design forms part of the goods themselves. A trade mark is something which is extra, which is added to the goods for the purpose of denoting the origin of the goods."<sup>7</sup> Although, speaking generally "the same thing is not a trade mark and a design" his Lordship pointed out that the two are not necessarily mutually exclusive.<sup>8</sup> So also, Tomlin, J., said: "I am not going to say that there may not be cases where a man may form container for goods on the lines of a registered design and use it in such a way as to constitute thereby an infringement of trade mark. It is true that a trade mark does not give a man a monopoly in the form which is represented in the mark; on the other hand, it may be that the form may be so used as to indicate origin and thereby constitute infringement."<sup>9</sup> Where, therefore, the plaintiff esta-

(4) The circumstances under which an unregistered design may be protected as a trade mark are discussed in a later section.

(5) Copyright lasts for five years from the date of registration and may be extended for further periods under Sec. 47 of the Indian Patents and Designs Act, 1911.

(6) See judgment of Byrne, J., in *Winser Co., Ltd. v. Armstrong & Co.*, (1899) 16 R.P.C. 167.

(7) *Goodall (Charles) & Son, Ltd. v. John Waddington, Ltd.*, (1924) 41 R.P.C. 658 (C.A.) at p. 668.

(8) See, for instance, *United States Playing Cards Co.'s Application*, L.R. (1908) 1 Ch. 197.

(9) *Careless, Capel and Leonard v. F. Pilmore-Bedford & Sons*, (1928) 45 R.P.C. at p. 216. An action for passing-off and to restrain the defendants



blishes that a particular design had been so used with his goods in the market that it serves as a "distinctive signal that the goods are the goods of the plaintiff," a rival trader may not be allowed to use it with other goods in a manner which would enable him to pass off such goods as the plaintiff's goods. It must be remembered in these cases, as Pollock, M. R., pointed out, that "if the action is treated as a passing-off action, the basis of it must be that the defendants have, by the production and sale of their design, represented that their goods are the goods of the plaintiffs; in other words that their design is a colourable imitation of the plaintiffs' trade mark."<sup>10</sup> *Elliot & Co., Ltd. v. Hodgson*<sup>11</sup> is a typical case where the distinctive shape or configuration of the plaintiffs' article had acquired a secondary signification. The plaintiffs had acquired reputation in connection with bull nosed or flat ended cigars which were the only cigars of this style sold, and sought to restrain the defendant from selling cigars of similar shape which were not of the plaintiffs' manufacture. Although the two boxes containing the cigars were distinct, the Court observed, that, if the defendant's cigars were taken out of their box and sold they would mislead the purchasers. Injunction was accordingly granted, restraining the defendant from selling cigars made in the distinctive "shape adopted by the plaintiffs, namely, bull nosed or flat ended and cylindrical throughout without clearly distinguishing such cigars from the cigars made by the plaintiffs."<sup>12</sup>

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from selling petrol from automobile pumps constructed in the form of a light house was unsuccessful.

(10) *Goodall (Charles) and Son, Ltd. v. John Waddington, Ltd.*, (1924) 41 R.P.C. 658.

(11) (1902) 19 R.P.C. 518. In *Ripley v. Bandey*, (1897) 14 R.P.C. 591 and 944, it was held that the packets of oval shape in which the plaintiff was selling his laundry blue had acquired secondary signification but the action was dismissed on the ground that due diligence to assert his rights had not been shown by the plaintiff. See also *Edge & Sons, Ltd. v. Nicolls & Sons, Ltd.*, (1911) 1 Ch. 5; 27 R.P.C. 671; (1911) A.C. 693; 28 R.P.C. 53 and 582.

(12) A number of decided cases deal with the use of bottles moulded with the plaintiff's name or mark. Many of these have been decided under the Merchandise Marks Act. In deciding these cases the general principles of the law of passing-off have been followed. Injunction granted:—*Rose v. Henley*, (1878) 47 L.J.Ch. 577; Seb. Dig., p. 328; *Allen v. Richards*, 26 Sol.J. 658; *Thwaites & Co. v. McEvilly*, (1904) 21 R.P.C. 397. Injunction refused:—*Welch v. Knott*, (1857) 70 E.R. 310; 4 K. & J. 747; Seb. Dig., p. 87; *Rose v. Loftus*, (1878) 47 L.J.Ch. 576; 38 L.T. 409; *Barrett v. Gomm*, 74 L.T. (Journal) 888; *Wolley & Son v. Morrison*, (1904) 21 R.P.C. 63;

Where monopoly is claimed in the form or shape of the plaintiff's goods, it is necessary to see whether the form or shape forms a useful part of the article. If so the monopoly claimed cannot be allowed as other traders may require the shape for their goods, because of its function and without any idea of passing-off.

**Designs on Piece-goods.**—Designs in the cotton class are very numerous and form a group by themselves. They are used mainly to please the eye of the purchaser and do not ordinarily indicate the origin of the goods. Such designs cannot therefore be generally protected as trade marks. In *Narumal Khemchand v. The Bombay Co., Ltd.*,<sup>13</sup> the question arose whether a design printed on chintz covering the whole body of the goods could constitute a trade mark or trade description within the meaning of the Merchandise Marks Act. It was pointed out that a design as defined under the Indian Patents and Designs Act excluded a trade mark as defined in the Indian Merchandise Marks Act and that in cases of infringement of designs a legal remedy did not lie under the Merchandise Marks Act.

**Pictorial representation of a registered design may be used as a trade mark.**—Pictorial representation of the registered design of an article may be a good trade mark, although the design itself had become common to the trade and any member of the public could use the design. Thus, in *James' Trade mark Case*<sup>14</sup> the plaintiffs had registered a design for the shape or configuration of blocks of black lead, consisting of a short cylinder with a dome-shaped top. After the registration had expired they had registered a trade mark consisting of the pictorial representation of the dome-shaped cakes of black lead with their name and other descriptive matter. An action for infringement was brought against the defendants who then moved to rectify the Register. It was contended that the pictorial representation of the article was as much descriptive as the name of the article and that as every one could

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*Donohoe, Ltd. v. Cherry Bros., Ltd.*, (1909) 26 R.P.C. 545; *Olpadvolla v. James Wright*, 32 C.W.N. 115.

(13) 8 S.L.R. 39. Many complaints have been made regarding piracy of well-known British designs on piecegoods in India, some of which though very old are still popular.

(14) (1886) 31 Ch.D. 340; 3 R.P.C. 340. Cf. *Hans Lawritzen's Application*, (1931) 48 R.P.C. 392 where registration was refused of the word "brick" as a trade mark for boiler water powder, on the ground that many articles of commerce are put up in blocks of the shape of bricks, that the blocks may be asked for as "bricks," and that the word "brick" was, therefore, descriptive of such blocks.

make and sell black lead in the shape of dome every one could use the picture of black lead in that shape. The plaintiffs, however, showed that though the picture represented the article sold, the black lead to which it was attached was understood by the trade as of the plaintiffs' manufacture. The trade mark was ordered to be expunged from the Register by Pearson, J., but his judgment was reversed by the Court of Appeal, on the ground, that the mark in question was a distinctive device, and that, as it was registered for black lead generally, it could be used on black lead of any shape, and not, necessarily, only on the dome shaped goods.

**Passing-off by advertising.**—An injunction may be granted where a person so advertises his goods for sale that the public are likely to be misled from the advertisements into believing that the goods offered for sale are those of the plaintiff, when they are not. As Kekewich, J., said in *Jay v. Ladler*,<sup>15</sup> "A man is not entitled—whether in trade or out of trade—to take that which is another man's, and when a man in trade advertises his goods as being the goods of another person, he is doing that which is wrong in itself, and liable to injunction in this Court." The same rule applies to trade circulars, price lists and catalogues. In *Singer Manufacturing Co. v. Wilson*,<sup>16</sup> where the defendant described in his price lists sewing machines, not of the plaintiffs' manufacture as "Singer Machines," it was held by Jessel, M. R., and the Court of Appeal that, in order to constitute an infringement, fraud was not essential in cases where the trade name was affixed to the goods, but was necessary if the trade name was not placed on the article. This distinction was, however, not recognised by the House of Lords and it was laid down that it was not necessary to aver or prove fraud in either case. Lord Chancellor Cairns said: "A representation made by advertisements that the articles sold at a particular shop are articles manufactured by A.B. .... must, in my opinion, be as injurious in principle, and may possibly be quite as injurious in operation, as the same representation made upon the articles themselves." The simple and plain issue is, as was stated by Kekewich, J., in another *Singer* case<sup>17</sup>: "Are the advertisements issued by the Defendants calculated to deceive intending

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(15) (1888) 40 Ch.D. 649; 6 R.P.C. 136.

(16) (1877) 3 App. Cas. 376.

(17) *Singer Manufacturing Co. v. British Empire Manufacturing Co., Ltd.*, (1903) 20 R.P.C. 313. See also *Burberrys v. Raper and Pulleyn*, (1906) 23 R.P.C. 170; *Masson Seeley & Co., Ltd. v. Embosotype Manufacturing Co.*, (1924) 41 R.P.C. 160.

purchasers of sewing machines into the belief that the machines which the Defendants are prepared to sell are manufactured by the Plaintiffs, when, in fact, they are not."

In *Spalding & Bros. v. Gamage Ltd.*,<sup>18</sup> the defendants purchased the old and discarded stock of the plaintiffs' foot balls which were known under the name "Orb" balls and advertised them as the "Improved Orb" balls. On complaint by the plaintiffs they withdrew this advertisement, and advertised and sold them as "Orb" balls. An injunction was granted by Sarjant, J., and an enquiry as to damages was ordered. It was held by the Court of Appeal that the plaintiffs were not entitled to relief. An appeal was, however, allowed, with costs, by the House of Lords, and the judgment of Sarjant, J., was restored by them. But, in *Anglo-Swiss Condensed Milk Company v. Pearks, Gunston, and Tee, Ltd.*,<sup>19</sup> where the plaintiffs complained of certain posters and handbills of the defendants, an action for passing-off failed as it was held that the device alleged to be infringed was common to the trade, and that the plaintiffs had no right of user of the mark for the class of goods sold by the defendants.

**Discovery and Inspection.**—The ordinary rules governing discovery and inspection as contained in Order XI of the Civil Procedure Code apply to passing-off actions. Where the plaintiff alleges that the wrongful use of his mark by the defendant had deceived diverse persons the defendant is entitled to discovery for particulars of the addresses of the persons so deceived.<sup>20</sup> Again, in cases where an account of profits is directed the defendant may be ordered to deliver to the plaintiff a list of the names and addresses of customers to whom the spurious goods had been sold.<sup>21</sup> Interrogatories may be ordered in respect of matters which are alleged by the defendant to be common to the trade.<sup>22</sup>

(18) (1915) 32 R.P.C. 273; 113 L.T. 198 (H.L.).

(19) (1903) 20 R.P.C. 509.

(20) *Humphries v. Taylor Drug & Co.*, (1888) 39 Ch.D. 693; 5 R.P.C. 687; see also *Imperial Tobacco Co., (of Great Britain and Ireland) Ltd. v. Funnell & Co.*, (1903) 20 R.P.C. 718.

(21) *Leather Cloth Co. v. Hirschfeld*, (1863) 71 E.R. 129; 1 H. & M. 295; *Powell v. The Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54; 14 R.P.C. 1. Discovery may also be ordered in case of an inquiry as to damages, *B. E. Draper (trading as Hubert H.P. Trist & Co.) v. Hubert H. P. Trist and Tristbestos Brake Linings, Ltd.*, (1936) 53 R.P.C. 66.

(22) *Perry & Co., Ltd. v. T. Hessin & Co.*, (1910) 28 R.P.C. 108.

Before ordering discovery the court will take all the special circumstances of the case into consideration. Where the discovery of the particulars sought by the plaintiff are of such nature that the giving of it may be prejudicial to the defendant the court may allow only such restricted discovery as is absolutely necessary for the plaintiff and will protect the defendant against undue inquisition into his affairs by the plaintiff.<sup>23</sup> A discovery will, therefore, be offered only for legitimate purposes,<sup>24</sup> and may be refused where it would be oppressive. The order may provide safeguards as to secrecy in inspection of the books, as, otherwise, great harm is likely to be done by the disclosure from the books of information having nothing to do with the order for discovery.<sup>25</sup>

In *Howe v. M'Kernan*<sup>1</sup> the defendant continued, after his dismissal, to represent himself fraudulently as the plaintiff's agent and sold sewing machines of other manufacture, as and for the plaintiff's machines. The plaintiff sought a discovery of all sewing machines sold by the defendant as and for the plaintiff's, their prices, profits, the names of the purchasers and other particulars. The defendant refused to answer as he would thereby be disclosing the names of his customers and the secrets of his trade. It was held that the defendant was bound to answer. In the *Imperial Tobacco Co., (of Great Britain and India), Ltd. v. Purnell & Co.*,<sup>2</sup> the plaintiffs alleged that their cigars had come to be known as "Little Red Band" cigars and "Red Banders" from their labels having a narrow red band. Upon application by the defendants, the plaintiffs were ordered to give particulars of the dates when the cigars were first known by the respective names, the dates when the alleged passing-off took place and the addresses of the persons alleged to be deceived by the defendants' cigars. In a recent case<sup>3</sup> the plaintiff who had acquired the goodwill of the business of the defendants complained that the latter had restarted similar business under a name which was calculated to deceive and had continued to solicit their old customers. At the trial the

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(23) *Moore v. Craven*, (1870) L.R. 7 Ch. 94-n (Lord Hatherley, C.).

(24) *Benbow v. Low*, (1880) 16 Ch.D. 93. (Disallowed as the interrogatory was not for the ordinary purposes of discovery, but was directed to the details of plaintiff's evidence).

(25) *B. E. Draper (trading as Hubert H. P. Trist & Co.) v. Hubert H. P. Trist and Tristbestos Brake Linings, Ltd.*, (1936) 53 R.P.C. 66.

(1) (1862) 30 Beav. 547; 54 E.R. 1001.

(2) (1903) 20 R.P.C. 718.

(3) *B. E. Draper (trading as Hubert H. P. Trist & Co.) v. Hubert H. P. Trist and Tristbestos Brake Linings, Ltd.*, (1936) 53 R.P.C. 66.

defendants consented to judgment, including an inquiry as to damages. An application for discovery of the customers solicited by the defendants and of sales made under the wrongful business name, was dismissed in the Court of the first instance on the ground that an inquiry as to damages and an account of profits should be distinguished and that the plaintiff must under both inquiries prove special damage before a discovery is ordered. On appeal, it was held that when once some damage had been proved the plaintiff was entitled to know particulars of the misrepresentations made by the defendants, and an order for discovery was made subject to certain safeguards.

**Trading names of business.**—The trading name of a business which has acquired reputation is a valuable asset<sup>4</sup> and the wrongful assumption by a rival of such business name, or a colourable imitation thereof, would be calculated to injure the plaintiff's business. In these cases it is not enough for the defendant to show that he had adopted a get up for his goods which is different from that of the plaintiff's goods. For, notwithstanding the differences between the two labels or packing, the wrongful use of the plaintiff's name may result in orders intended for the plaintiff passing to the defendant for compliance. The plaintiff will be entitled to protection under the common law and it does not matter for purposes of obtaining such relief whether the plaintiff firm has been registered or not under the Companies Act.

**Registration of names under the Indian Companies Act.**—By Sec. 11 of the Indian Companies Act of 1913, it is laid down: “(1) *A company shall not be registered by a name identical with that by which a company in existence is already registered or so nearly resembling that name as to be calculated to deceive, except where the company in existence is in the course of being dissolved and signifies its consent in such manner as the Registrar requires.* (2) *If a company, through inadvertence or otherwise, is, without such consent as aforesaid, registered by a name identical with that by which a company in existence is previously registered, or so nearly resembling it as to be calculated to deceive, the first-mentioned company may, with the sanction of the Registrar, change its name.*”

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(4) “The name is a very important part of the goodwill of the business” Wood, V.C., in *Churton v. Douglas*, (1859) 70 E.R. 385; 7 W.R. 365; Seb. Dig., p. 96; See also *Mrs. Pomeroy, Ltd. v. Seale*, (1907) 24 R.P.C. 177; 23 T.L.R. 170.

The wording of the section follows the corresponding section (Sec. 8) of the English Companies (Consolidation) Act of 1908. In his note under this section Lord Wrenbury (formerly Buckley, L.J.,) points out, (i) that the section merely prevents a company from registering as its own, a name that is identical with or is a colorable imitation of one already on the register, (ii) that it does not prevent registration, if the name sought to be registered belongs to an already existing unregistered company and (iii) that the rights of parties are not affected by registration; in other words, that registration by itself confers no right to institute legal proceedings for infringement of a registered name.

It is significant that the above section does not make any reference to the nature of the business or class of goods dealt in by a registered firm. The section does not therefore allow registration of the same name by a subsequent company dealing in an entirely different class of goods although such name, if registered, would not obviously, be calculated to cause confusion with the business name of the first company. Thus, while before registration of his business John Smith can restrain his rivals from trading under the same name only in respect of the same class of goods, after registration under the Companies Act, said John Smith can restrain them from trading as a registered company under that name in respect of any class of goods.

#### **Common Law Rights not affected by the Companies Act.—**

While the Companies Act thus places a severe restriction in the matter of registration of names by newly formed companies, it does not affect in any manner the right of a party to a passing-off action in cases of misrepresentation. Non-registration of the business of the plaintiff firm is no bar to relief under the common law. A leading case on this point is *Hendriks v. Montagu*.<sup>5</sup> The Universal Life Assurance Society which had been doing for several years a large business in life assurance sought to restrain the defendants who were the promoters of the Universe Life Assurance Association, Ltd., from registering the proposed name under the Companies Act. Injunction was refused by Jessel, M.R., on the ground that the plaintiff company was not registered and had consequently no cause of action under the Act. His decision was, however, reversed by the Court of Appeal, who said that equity provides relief to the injured party without reference to the Companies Act. An

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(5) (1881) 17 Ch. D. 638. See also *Hoby v. Grosvenor Library Co., Ltd.*, (1880) 28 W.R. 386; *Tussaud v. Tussaud*, (1890) 44 Ch.D. 678.

injunction was accordingly granted restraining the defendants from applying to the Registrar of Joint Stock Companies for registration of the trade name "Universe Life Assurance, Ltd.," or any other name likely to mislead the public into the belief that the company is the same as the plaintiff company, and from issuing circulars or prospectuses or carrying on business under the said name.

The fact that the defendant company has already been registered, or that at the time of registration they were entirely ignorant of the existence of the plaintiff company, is again no bar to the plaintiff's right to relief.<sup>6</sup> Thus, in a case<sup>7</sup> where an English company was registered in a name similar to that of a French motor car company, who had no place of business in England, but whose goods were often imported by purchasers in England, an injunction was granted against the English company, and also individually against the seven signatories of the Memorandum of Association. Injunction was similarly granted in *Toms & Moore v. Merchant Service Guild, Ltd.*,<sup>8</sup> where the Imperial Merchant Guild, an unincorporated body brought an action restraining the defendants, a registered company, from using the name "Merchant Service Guild."

Sufficient time may in certain cases be granted to enable the defendant company to alter its name in a manner which will avoid confusion among the public.<sup>9</sup> Injunction may be suspended for a reasonable period, and the defendants may have to undertake until change of name not to solicit the plaintiffs' customers without

(6) *Accident Insurance Co., Ltd. v. Accident Disease and General Insurance Corporation, Ltd.*, (1884) 54 L.J.Ch. 104; 51 L.T. 597; *Gurkha Association, Simla v. Md. Umar*, A.I.R. 1919 Lah. 193; *Shallis v. Freeman and Stirling Press, Ltd.*, (1931) 48 R.P.C. 370; *British Legion v. British Legion Club (Street)*, *Ld.*, (1931) 48 R.P.C. 555; *Crystalate Gramophone Record Manufacturing Co., Ltd. v. British Crystalite Co., Ltd.*, (1934) 51 R.P.C. 315; *Radio Rentals, Ltd. v. Rentals, Ltd.*, (1934) 51 R.P.C. 407.

(7) *Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, (1901) 18 R.P.C. 405; (1901) 2 Ch. 513. See also *Daimler Motor Car Co., Ltd. v. British Motor Traction Co., Ltd.*, (1901) 18 R.P.C. 465.

(8) (1908) 25 R.P.C. 474.

(9) *Lloyd's v. Lloyd's (Southampton)*, *Ld.*, (1912) 28 T.L.R. 338; 29 R.P.C. 433; *Poiret v. Jules Poiret, Ltd., and A. F. Nash*, (1920) 37 R.P.C. 177; *Ewing v. Buttercup Margarine Co., Ltd.*, (1917) 2 Ch. 1; 34 R.P.C. 232; *Woolworth & Co., Ltd. v. Woolworths (Australasia)*, *Ld.*, (1930) 47 R.P.C. 337; *British Legion v. British Legion Club (Street)*, *Ld.*, (1931) 48 R.P.C. 555; 47 T.L.R. 571. But this may not be allowed in case of fraud, see *Harrow's Ltd. v. E. Harrod, Ltd.*, (1923) 40 T.L.R. 195; 41 R.P.C. 74.



clearly indicating that they are a new company.<sup>10</sup> In the case of registered companies non-compliance with certain sections of the Companies Act,<sup>11</sup> or the fact that the company had been only recently registered,<sup>12</sup> will be no bar to protection under common law.

**Basis of relief.**—The principles of law discussed in the preceding sections with regard to passing-off actions by imitation of trade marks and trade names of goods are followed by the Courts in cases relating to infringement of business names. The foundation of the action is that a trader will not be allowed to misrepresent that his business is the business of another. “It should never be forgotten,” said Lord Justice James, in *Levy v. Walker*,<sup>13</sup> “that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade mark. That is to say, somebody has a right to say, ‘You must not use a name, whether fictitious or real or a description, whether true or not, which is intended to represent, or is calculated to represent, to the world that your business is my business, and therefore deprive me by a fraudulent mis-statement of yours of the profits of the business which would otherwise come to me.’ ”

**Business Names classified.**—Relief may, therefore, be obtained, where a plaintiff establishes that the defendant is trading under a name, which is reasonably calculated to cause injury to his business by misleading the public. Such business names may be classified into three groups:—(a) where the name in question is the defendant’s own name, (b) where the name is fanciful or inherently distinctive, and (c) where the name is descriptive of the plaintiff’s business. In the first class of cases

(10) Generally about one to two months. *Edison Accumulators, Ltd. v. Edison Storage Batteries, Ltd.*, (1929) 46 R.P.C. 432; *Edison Storage Battery Co. v. Britannia Batteries, Ltd.*, (1931) 48 R.P.C. 350; *Crystallite Gramophone Record Manufacturing Co., Ltd. v. British Crystalite Co., Ltd.*, (1934) 51 R.P.C. 315; *Radio Rentals, Ltd. v. Rentals, Ltd.*, (1934) 51 R.P.C. 407; *Hasketh Estates, Southport, Ltd. v. Droitwich Brine Baths, Ltd.*, (1935) 52 R.P.C. 39.

(11) *Randall, Ltd. v. British and American Shoe Co.*, (1902) 2 Ch. 354; 19 R.P.C. 393; *Pearks, Gunston & Tee, Ltd. v. Thompson, Talmey & Co.*, (1901) 17 T.L.R. 250, 354; 18 R.P.C. 185; *Wright v. Horton & Co.*, (1887) 12 App. Cas. 371.

(12) *Edison Accumulators, Ltd. v. Edison Storage Batteries, Ltd.*, (1929) 46 R.P.C. 432.

(13) (1879) 10 Ch.D. 436.

there is *prima facie* no ground of complaint maintainable at law. Every man has a right to trade honestly under his own name, and this applies not only to the case of an individual but also to an association of persons. But, even here there may be circumstances in which this *prima facie* right cannot be claimed. Thus, where a defendant by reason of the similarity of his name to the plaintiff's deliberately seeks to obtain fraudulently the trade of the plaintiff injunction will be given. Cases of this class are discussed in a later section.

In the second class of cases where the business name which is infringed is not the true name of the plaintiff but is a fancy name, it will, generally, be easy to get an injunction as the defendant's fraudulent motive will be readily presumed. "Such was the case . . . of *Hendriks v. Montagu*,<sup>14</sup> and such one may say was the case in the *North Cheshire and Manchester Brewery Co.'s case*,<sup>14-a</sup> where there were already existing companies with certain titles, themselves fancy in their origin, not representing anything that could be called names or representing a title which had existed; from the first there had been trade carried on under the names; and then a company comes and takes practically the same fancy name and seeks to do business. In that class of case the question of fact arises—Is the similarity such that there is good ground of complaint? Because there will be, either in relation to the business a possible taking away of the business from the first company through a mistake, or a passing-off of products as the products of the one company when they are really the products of the other."<sup>15</sup>

In cases grouped in the third class where the name is *prima facie* descriptive of the business an exclusive monopoly in the name cannot be claimed ordinarily as such names must be open to other traders dealing in the same class of goods to describe their businesses. Even in these cases, however, the business name will be entitled to protection, if it is shown that it had lost its descriptive meaning, and has acquired a secondary signification.

**Probability of deception essential.**—The same considerations that determine the probability of deception in relation to trade mark or trade name cases apply to infringement of business names.

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(14) (1881) 17 Ch.D. 638. See also *Harrod's, Ltd. v. R. Harrod, Ltd.*, (1923) 40 T.L.R. 195; 41 B.P.C. 74.

(14-a) (1898) 1 Ch. 539; (1899) App. Ca. 83.

(15) Per Kennedy, L.J., in *Daimler Motor Co., (1904), Ltd. v. London Daimler Co., Ltd.*, (1907) 24 B.P.C. 379.

The Plaintiff's claim to relief depends solely upon the finding of the court whether the name in question is calculated to deceive the public. It is not necessary to charge the defendant with fraud,<sup>16</sup> but if fraudulent intent is shown it would generally be presumed that the representation is calculated to deceive, and the onus is then on the defendant to prove that such deception is not probable. On the other hand, even if the representation had been honestly made it may still be restrained if in the opinion of the court it is calculated to mislead the public and cause injury to the plaintiff. To quote the words of Lord Halsbury in the *Manchester Brewery case*,<sup>17</sup> the simple question is, "Is this name so nearly resembling the name of another as to be likely to deceive." Or, as Lord Shand stated in the same case, "was the taking of the name of the 'Manchester Brewery Co., Ltd.,' calculated to induce the belief amongst the public or the trade that the business which was carried on by the respondents is now the business carried on by the new firm?"

A mere similarity between the two names is not enough. It must be shown that what the defendants are threatening, and intending to do, would, in all probability, seriously affect the plaintiffs' business.<sup>18</sup> The mere fact of liability to misdirection of correspondence is not sufficient ground for relief. A mere confusion of the two names and consequent misdelivery of letters would, no doubt, cause annoyance to the plaintiff, but is not actionable under the law of passing-off.<sup>19</sup>

In considering whether a business name is calculated to deceive, it is usual to consider the probable effect on purchasers of goods.

(16) "I further agree that it is not necessary in a case of this kind that an improper motive or a fraudulent intention should be made out. Here the simple question to be decided is, assuming *bona fide* on the part of the appellants, whether or not use of this particular name is calculated to injure another firm which had been using that same name, I believe for a period of eight years. Whether this question arises under statute or under the common law, the issue which the Court or this House has to decide appears to me to be the same". Lord Shand in *North Cheshire & Manchester Brewery Co. v. Manchester Brewery Co.*, (1899) App. Cas. 83.

(17) *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*, (1899) App. Cas. 83.

(18) *Merchant Banking Co. of London, Ltd. v. The Merchants' Joint Stock Bank*, (1878) 9 Ch.D. 560; *Harrod's Ltd. v. Harrod Ltd.*, (1923) 40 T.L.R. 195; 41 R.P.C. 74.

(19) *Day v. Brownrigg*, (1878) 10 Ch.D. 294; *Street v. Union Bank of Spain and England*, (1885) 30 Ch.D. 156; *Meikle v. Williamson*, (1909) 26 R.P.C. 775; *Buttons, Ltd. v. Buttons Covered, Ltd.*, (1920) 37 R.P.C. 45.

Injunction may also be granted, where it is shown that the name is likely to cause confusion to persons who supply the raw material to the plaintiff company for the purpose of manufacture.<sup>20</sup>

**Descriptive Names.**—The nature of the business name in question is an important factor in considering whether the name is calculated to deceive. Where the name consists of simple words in common use descriptive of the goods sold a monopoly in the use of the words cannot be generally claimed. It is not "right that a trader by taking words which are not fancy, not uncommon, but purely descriptive of the nature and extent of the business carried on can claim such a monopoly of the use of those particular words as to prevent another trader honestly and apart from fraud using those words with an addition, which addition makes the words used by the defendant truly and accurately descriptive of the goods which the defendant sells."<sup>21</sup> As Farwell, J., observed: "In considering whether a name is calculated to deceive it is . . . material to see what that name is, and if the name is simply a word in ordinary use representing a machine or an article of commerce, the probability of deception is out of all proportion less than it would be in the case of an invented or fancy word, or even of the name of a place. The latter may well point to a particular company; the former certainly points *prima facie* to the machine or article."<sup>22</sup> Thus, in a case<sup>23</sup> where the plaintiffs who had adopted the name "American Shoe Company" as their trade name sought to restrain the defendants from trading under the name "Anglo-American Shoe Company" injunction was refused, as the term was held to be purely descriptive of the class of goods dealt in by the defendants. Fletcher-Moulton, I. J., said: "If a person chooses to trade under a name which is highly non-specific, which consists of simple words in common use in the general language of the people, he must take the consequences. For instance, if a person who is going to trade in leather calls himself "The Leather Company," he has no right to expect that his neighbours will abstain from indicating the business in which they engage by proper descriptive titles, even though such titles make use of the word 'Leather.' "

(20) *Pullman (R. & J.) Ltd. v. Pullman*, (1919) 36 R.P.C. 240.

(21) Per Cozens-Hardy, M. R., in *Randall Ltd. v. Bradley & Son*, (1907) 24 R.P.C. 773.

(22) *Aerators, Ltd. v. Tollit*, (1902) 2 Ch. 319; 19 R.P.C. 418.

(23) *Randall, Ltd. v. Bradley & Son*, (1907) 24 R.P.C. 773.

Under very exceptional circumstances, by a long course of usage, a name descriptive of the business of a trader may acquire a secondary signification. As Lord Halsbury observed: "It would require very strong evidence, indeed, to establish the fact that a man who sought, apparently, to monopolise one particular trade, and the only proper designation of the trade could restrain another man from carrying on business under that name."<sup>23-a</sup>

**Nature of the business to be considered.**—The nature of the business carried on by the two companies is another important factor in the consideration of the question of probability of deception. Where the objects of the two companies are different it is not likely that the public would mistake the one for the other. "Mere resemblance of the name would not necessarily be sufficient to entitle the Plaintiff Company to relief, if the scope of the operations carried on by the two companies was so entirely different, that there was no real danger of confusion."<sup>24</sup> To use the language of Jessel, M. R.: "If John Brown sells coal, another John Brown may sell potatoes, and there is no law that I know to prevent him from selling his potatoes under the name of John Brown."<sup>25</sup> Thus, in *Aerators, Ltd. v. Tollit*<sup>1</sup> where the plaintiffs commenced an action to restrain the defendants from registering a company under the name, "Automatic Aerators Ltd.," injunction was refused as the articles in which the plaintiffs dealt were very different from those proposed to be manufactured by the defendants. In *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*,<sup>2</sup> the plaintiffs, a well-known manufacturing firm of motor tyres failed in an action to restrain the defendant firm of cycle and motor repairers from using "Dunlop" as part of their business name. In *Scottish Union and National Insurance Co. v. Scottish National Insurance Co., Ltd.*,<sup>3</sup> both the plaintiff and the defendant companies had power to

(23-a) *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 25 R.P.C. at p. 154.

(24) *Woolworth & Co., Ltd. v. Woolworths (Australasia), Ltd.*, (1930) 47 R.P.C. at p. 344 (Farwell, L.J.).

(25) *Merchant Banking Co. of London v. The Merchants' Joint Stock Bank*, (1878) 9 Ch.D. at p. 563.

(1) (1902) 2 Ch. 319; 19 R.P.C. 418.

(2) (1907) A.C. 430; 24 R.P.C. 572.

(3) (1908) 25 R.P.C. 560; 26 R.P.C. 105. See also *Waring & Gillow, Ltd. v. Gillow & Gillow, Ltd.*, (1910) 33 T.L.R. 389; 33 R.P.C. 173, where injunction was refused on the ground that there was no likelihood of deception between the business of the plaintiffs who were auctioneers and that of the defendants who were house furnishers and decorators.

do business in all kinds of insurance; but as a matter of fact the plaintiffs' business did not extend to marine insurance, while the defendants' business was confined to this particular line of insurance. Interdict was refused on the ground that there was no risk of injurious competition between the two companies, the classes of business actually done by them being entirely distinct.

On the other hand, for an injunction to be granted it is not necessary that the two businesses should be identical; it is enough if a close similarity is shown. In the *National Bank of India v. National Bank of Indore*,<sup>4</sup> the plaintiffs had been doing extensive banking business in India for several years, and besides, were importing and selling gold bars stamped with the name "National Bank of India." The defendant bank was registered having for its objects, among other things, banking business, the buying and selling of bullion and specie, and the buying, selling and refining of metals and manufactured products thereof for commercial purposes. The defendants contended that their name was not a colourable imitation of the plaintiffs' name, that their bank was formed principally with a view to finance merchants carrying on business in Indore, in cotton seeds, piece goods and other commodities, and that the object of their business was thus different from that of the plaintiffs. Injunction was granted by Mulla, J., who observed that, in his opinion, the defendant company had been formed with the object principally of dealing in gold bars and that, although the business might not at the time be large it might subsequently increase.<sup>5</sup>

Where fraudulent intention is shown, as in the above case, too close a similarity between the two businesses will not be insisted upon. For example, in *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*,<sup>6</sup> the Kodak Company who were manufacturing cameras suitable for bicycles and appliances for fixing the same to bicycles were successful in an action to restrain the defendants from trading as, "The Kodak Cycle Co., Ltd."

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(4) A.I.R. 1923 Bom. 119; 24 Bom.L.R. 1181. See also *Oriental Government Security Life Assurance, Co., Ltd. v. Oriental Assurance, Co., Ltd.*, 40 Cal. 570. *Crystalate Gramophone Record Manufacturing Co., Ltd. v. British Crystalite Co., Ltd.*, (1934) 51 B.P.C. 315, (Plaintiffs selling electrical accessories while the defendants sold electrical lamps, the possibility of plaintiffs extending their activities was taken into consideration.)

(5) *The Standard Bank of South Africa, Ltd. v. The Standard Bank, Ltd.*, (1909) 25 T.L.R. 420; 26 B.P.C. 310 was followed.

(6) (1898) 15 B.P.C. 105. See also *Harrod's, Ltd. v. R. Harrod, Ltd.*, (1923) 40 T.L.R. 195; 41 B.P.C. 74.

**Injury to trade reputation actionable.**—Thus, even in the absence of any material injury involving actual pecuniary loss to the plaintiff, a defendant may be restrained from using a well-known business name of the plaintiff with the object of falsely suggesting to the public that his business has some sort of connection with the plaintiff's business. In *Walter v. Ashton*,<sup>7</sup> a dealer in cycles advertised his goods in a manner which satisfied the court that he intended the public to believe that the proprietors of the well-known "The Times" newspaper, were in some way responsibly connected with the sale of his "Times Cycles." It was held that there was a reasonable probability of the plaintiffs, the proprietors of "The Times," being exposed to litigation on account of such advertisement and an interim injunction was, accordingly, granted restraining the defendant from representing in any manner that he was carrying on business as a department of "The Times," or that the proprietors of that newspaper were the owners of, or connected with his business. In the course of his judgment, Byrne, J., observed: "The principle is clear enough. The court does not grant an injunction to restrain the use of a man's name merely because it is liable or calculated to do him injury, but if what is being done is calculated to injure his property and the probable effect of it will be to expose him to a risk or liability, then, if I rightly understand the law, an injunction is the proper remedy."

In *Harrod's Ltd. v. R. Harrod, Ltd.*,<sup>8</sup> the plaintiffs, a well-known company doing extensive business including a banking department sought to restrain the defendant firm of money lenders from using a trade name of which "Harrod" formed a part, in a manner calculated to deceive. It was contended that, as the plaintiffs were precluded by the Articles of Association from carrying on money lending business, there was no probability of competition between the two businesses. Injunction was refused by Romer, J., but an appeal was allowed, as further evidence showed that actual confusion had arisen in some cases in consequence of the use by the defendants of the name "R. Harrod, Ltd." In granting an

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(7) (1902) 2 Ch. 282; 71 L.J.Ch. 839. Applied:—*Clerk v. Motor Co.*, (1905) *Ld. & Ford*, (1905), 49 Sol. Jo. 418, Referred:—*Wertheimer v. Stewart Cooper & Co.*, (1906) 23 R.P.C. 481; *Dutton Massey & Co. (Liverpool), Ltd. v. Dutton, Massey & Co.*, (1923) 40 R.P.C. 413; *Harrod's, Ltd. v. R. Harrod, Ltd.*, (1923) 40 T.L.R. 195; 41 R.P.C. 74, *Society of Motor Manufacturers and Traders, Ltd. v. Motor Manufacturer's and Traders' Mutual Insurance Co., Ltd.*, (1925) Ch. 675; 42 R.P.C. 307.

(8) (1923) 40 T.L.R. 195; 41 R.P.C. 74.

injunction Warrington, L. J., said: "I should be very sorry indeed if the arm of the court were too short to reach that which I consider in the result to have been a deliberate attempt to obtain at least reputation and advantage from taking this particular name." Referring to *Walter v. Ashton*, Lord Justice Sargant, said: "It seems to me it is essential for an action of that sort that there should be tangible probability of injury to the property of the Plaintiffs, but I think that under the word "property" may well be included the trade reputation of the Plaintiffs, and that, if tangible injury is shown to the trade reputation<sup>9</sup> of the Plaintiffs, that is enough. I think that Byrne, J., in his decision went on too narrow a ground, because he thought that it was necessary, in order that the plaintiffs should succeed, that they should show there was some probability of their being involved in actual pecuniary liability to the customers of the defendants. It seems to me it was quite enough for him to have found, as was obviously the case there, that the proceedings of the defendants involved a risk or probability of injury to the trade reputation of the plaintiffs."

**Name suggesting amalgamation, agency or succession to business.**—Fraudulent representation may be made by issuing deceptive circulars or advertisements or by suggesting in any other manner that the defendant company is identical with, or in some way connected with the plaintiff firm. One of the common forms of misrepresentation is by the adoption of a name which would be calculated to lead the public to believe that the defendant company is an amalgamation, or an agency, of, or otherwise connected with the plaintiff company's business. Any such false representation would amount to passing-off. Fraud is not essential in such cases, though most of the reported cases are cases of fraudulent representation. Even where the defendant company had adopted the name *bona fide*, and had taken special pains to avoid confusion, an injunction may be granted if the name of the defendant company is, in fact, calculated to deceive, and is likely to cause damage to the plaintiff's business.<sup>10</sup> In *Ewing v. Buttercup Margarine Co., Ltd.*<sup>11</sup> Lord Cozens-Hardy M. R.,

(9) "A company has, as an individual, a reputation and a credit, which is and may be a matter of great value to itself." Farwell, J., in *Woolworth & Co., Ltd. v. Woolworths (Australasia) Ltd.*, (1930) 47 R.P.C. at p. 345.

(10) *Woolworth & Co., Ltd. v. Woolworths (Australasia), Ltd.*, (1930) 47 R.P.C. 337.

(11) (1917) 2 Ch. 1; 34 R.P.C. 232.



observed: "I know of no power, and I can see no principle for holding that a trader may not be injured, and seriously injured, in his business as a trader by a confusion which will lead people to conclude that the defendants are really connected with the plaintiffs or a branch of the plaintiff's business, or in some way mixed up with them." And, in *North Cheshire & Manchester Brewery Co. v. Manchester Brewery Co.*,<sup>12</sup> where the defendants acquired the North Cheshire Co., and registered themselves as the North Cheshire and Manchester Company, Ltd., injunction was granted by the Court of Appeal, reversing the judgment of Byrne, J., and their decision was upheld by the House of Lords. Lord Halsbury observed in that case that "any one who saw the two names together would arrive at the conclusion without any doubt at all that the two companies both with well-known names, both in particular neighbourhood had been amalgamated." Similarly, in *Lloyd's v. Lloyd's (Southampton) Ltd.*,<sup>13</sup> an injunction was granted as it was held that the business name adopted by the defendant was calculated to induce the belief that their business was the business, agency, or department of the plaintiffs' business.

**May suggest old connection, etc.**—A person may, after leaving the service of a well-known firm, start similar business on his own account provided he is not barred from doing so by the terms of his contract with the late employers. He can then lawfully indicate to the public by advertisement or otherwise, that he had been in such employment and he may, in that way, appropriate to himself some of the benefits arising from the reputation of his former employers.<sup>14</sup> But in so doing he must take special care that it is done in such a way as not to mislead the public into thinking that the new business is a continuation of the old business, or that the former connection between the old business and the person is still existing.<sup>15</sup> In *Glenny v. Smith*<sup>16</sup> a tradesman

(12) (1898) 1 Ch. 539; (1899) App. Cas. 83.

(13) (1912) 29 T.L.R. 338; 29 R.P.C. 433. See also *Harrod's Ltd. v. R. Harrod, Ltd.*, (1923) 40 T.L.R. 195; 41 R.P.C. 74.

(14) *Clark v. Leach*, 32 L.J.Ch. 290; (1862) Seb. Dig., p. 117; *Hookham v. Pottage*, (1872) 8 Ch. 91; *Thorley's Cattle Food Co. v. Massam*, (1877) 6 Ch.D. 582 Seb. Dig., p. 336.

(15) *Burgess v. Burgess*, (1853) 43 E.R. 351; 3 De G.M. & G., 896; *Scott v. Scott*, (1866) 16 L.T. (N.S.) 143, Seb. Dig., p. 160; *Wheeler & Wilson Manufacturing Co. v. Shakespear*, (1869) 39 L.J.Ch. 36; *Hookham v. Pottage*, (1872) L.R. 8 Ch. 91; Seb. Dig., p. 236; *Goodman v. Way*, (1892) 36 Sol.Jo. 830; *Van Oppen & Co., Ltd. v. Van Oppen*, (1903) 20 R.P.C. 617.

(16) (1865) 62 E.R. 701; 2 Drew and Sm. 476; Seb. Dig., p. 144.

who had been in the employ of a large firm put his own name over his shop along with the words "from Thresher, Glenny & Co.," his former employers, the word "from" being in small letters. It was shown that some persons were actually misled into thinking that the shop was the shop of the former employers. An injunction was granted restraining the defendant from using the name of the plaintiff firm, in such manner as to mislead the public. In *Rickett, Cockerell & Co., Ltd. v. Nevill*<sup>17</sup> a former manager of the coal business of the plaintiff firm set up business on his own account under the style "Nevill from Cockerell & Co., Ltd.," and on his death his widow continued the business under the same style. Injunction was refused and the action was dismissed with costs.

**Injunctions granted.**—The following are some illustrative cases where injunctions were granted:—*Hoby* (carrying on business as "The Grosvenor Library") v. *Grosvenor Library Co., Ltd.*;<sup>18</sup> *Hendriks* (for the *Universal Life Assurance Society*) v. *Montagu* (for the *Universe Life Assurance Association*);<sup>19</sup> *The Accident Insurance Co., Ltd. v. The Accident Disease and General Insurance Co., Ltd.*;<sup>20</sup> *Madame Tussaud and Son, Ltd. v. Louis Tussaud, Ltd.*;<sup>21</sup> *National Folding Box and Paper Co. v. National Folding Box Co., Ltd.*;<sup>22</sup> *Hodge v. Hodge, Dibb & Co.*;<sup>23</sup> *Pinet et Cie v. Maison Pinet, Ltd.*;<sup>24</sup> *North Cheshire and Manchester Brewery, Co. v. Manchester Brewery Co.*;<sup>25</sup> *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*;<sup>1</sup> *Pearks, Gunston & Tee, Ltd.*, (carrying on business as *Talmey & Co.*) v. *Thompson, Talmey & Co.*;<sup>2</sup> *La Societe Anonyme, etc. v. Panhard Levassor Motor Co., Ltd.*;<sup>3</sup> *H. E. Randall, Ltd.*, (trading as *American Shoe Co.*) v. *British and American Shoe Co.*;<sup>4</sup> *International Plasmon, Ltd. v. Plasmonade*,

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(17) (1904) 21 R.P.C. 394.

(18) (1880) 28 W.R. 386.

(19) (1881) 17 Ch.D. 638.

(20) (1884) 54 L.J.Ch. 104; 51 L.T. 597.

(21) (1890) 44 Ch.D. 678.

(22) (1894) 43 W.R. 156.

(23) (1896) 40 Sol. Jo. 728.

(24) (1897) 14 R.P.C. 933; 77 L.T. 322.

(25) (1898) 1 Ch. 539.

(1) (1900) 17 R.P.C. 673; 83 L.T. 259.

(2) (1901) 18 R.P.C. 185; 17 T.L.R. 250 at p. 354.

(3) (1901) 18 R.P.C. 405; (1901) 2 Ch. 513.

(4) (1902) 19 R.P.C. 393; (1902) 2 Ch. 354.

*Ld.*;<sup>5</sup> *Daimler Motor Co. (1904), Ld. v. London Daimler & Co., Ld.*;<sup>6</sup> *Toms and Moore v. Merchant Service Guild, Ld.*;<sup>7</sup> *Resartus Co. v. Sartor Resartus Co.*;<sup>8</sup> *Standard Bank of South Africa, Ld. v. Standard Bank, Ld.*;<sup>9</sup> *Ouvah Ceylon Estates, Ld. v. Uva Ceylon Rubber Estates, Ld.*;<sup>10</sup> *Muratti, Sons & Co., Ld. v. Murad, Ld.*;<sup>11</sup> *Kingston, Miller & Co., Ld. v. Thomas Kingston & Co., Ld.*;<sup>12</sup> *Lloyd's v. Lloyd's (Southampton), Ld.*;<sup>13</sup> *Lloyd's Bank, Ld. v. Lloyd's Investment Trust Co., Ld.*;<sup>14</sup> *Facsimile Letter Printing Co., Ld. v. Facsimile Typewriting Co.*;<sup>15</sup> *Teofani & Co., Ld. v. Teofani*;<sup>16</sup> *May v. May*;<sup>17</sup> *Wood v. Hall*;<sup>18</sup> *Ewing (trading as Buttercup Dairy Co.) v. Buttercup Margarine Co., Ld.*;<sup>19</sup> *Albion Motor Car Co., Ld. v. Albion Carriage and Motor Body Works, Ld.*;<sup>20</sup> *Pullman, Ld. v. Pullman*;<sup>21</sup> *Poirot v. Jules Poirot, Ld., and A. F. Nash*;<sup>22</sup> *Guimaraens & Son (trading in succession to Fonseca Monteiro and Guimaraens) v. Fonseca and Vasconcellos, Ld.*;<sup>23</sup> *Dutton, Massey & Co. (Liverpool), Ld. v. Dutton Massey & Co., Ld.*;<sup>24</sup> *Harrod's, Ld. v. R. Harrod, Ld.*;<sup>25</sup> *Rodgers (Joseph) & Sons, Ld. v. W. N. Rodgers & Co.*;<sup>1</sup> *Reliance Rubber Co., Ld. v. Reliance Tyre Co., Ld.*;<sup>2</sup>

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- (5) (1905) 22 R.P.C. 543.
  - (6) (1907) 24 R.P.C. 379.
  - (7) (1908) 25 R.P.C. 474.
  - (8) (1908) 25 R.P.C. 808.
  - (9) (1909) 26 R.P.C. 310; 25 T.L.R. 420.
  - (10) (1910) 27 R.P.C. 645 at p. 753; 103 L.T. 416.
  - (11) (1911) 28 R.P.C. 497.
  - (12) (1912) 29 R.P.C. 289; (1912) 1 Ch. 575.
  - (13) (1912) 29 R.P.C. 433; 28 T.L.R. 338.
  - (14) (1912) 29 R.P.C. 545; 28 T.L.R. 379.
  - (15) (1912) 29 R.P.C. 557.
  - (16) (1913) 30 R.P.C. 446; 82 L.J.Ch. 490.
  - (17) (1914) 31 R.P.C. 324.
  - (18) (1915) 33 R.P.C. 16.
  - (19) (1917) 34 R.P.C. 110, 232; (1917) 2 Ch. 1.
  - (20) (1917) 34 R.P.C. 257; 33 T.L.R. 346.
  - (21) (1919) 36 R.P.C. 240.
  - (22) (1920) 37 R.P.C. 177.
  - (23) (1921) 38 R.P.C. 388.
  - (24) (1923) 40 R.P.C. 413; 41 R.P.C. 67.
  - (25) (1923) 41 R.P.C. 74; 40 T.L.R. 195.
  - (1) (1924) 41 R.P.C. 277.
  - (2) (1924) 42 R.P.C. 91.

*Henry Blacklock & Co., Ltd.* (Publishers of *Bradshaw Railway Guide*) v. *Bradshaws Publishing Co.*;<sup>3</sup> *Heels* v. *Stafford Heels, Ltd.*;<sup>4</sup> *Heppells, Ltd.* v. *Eppels, Ltd.*;<sup>5</sup> *Edison Accumulators, Ltd.* v. *Edison Storage Batteries, Ltd.*;<sup>6</sup> *Woolworth & Co., Ltd.* v. *Woolworths (Australasia), Ltd.*;<sup>7</sup> *Madeira House, Co., Ltd.* v. *Madeira House (London), Ltd.*;<sup>8</sup> *C. & A. Modes, Ltd.* v. *Central Purchasing Association, Ltd.*;<sup>9</sup> *Edison Storage Battery Co.* v. *Britannia Batteries, Ltd.*;<sup>10</sup> *Radio Rentals, Ltd.* v. *Rentals, Ltd.*;<sup>11</sup> *The Clock, Ltd.* v. *The Clock House Hotel, Ltd.*;<sup>12</sup> *Oriental Government Security Life Assurance Co., Ltd.* v. *Oriental Assurance, Co., Ltd.*;<sup>13</sup> *Haji Anisur Rahman* (trading as *Limton Watch Co.*) v. *Ramnath Kapur* (trading as *Lipton Watch Co.*)<sup>13-a</sup>

**Injunctions refused.**—Injunctions were refused in the following cases:—*London and Provincial Law Insurance Society, Ltd.* v. *London and Provincial Joint Stock Assurance Co.*;<sup>14</sup> *Colonial Life Assurance Co.* v. *The Home and Colonial Assurance Co., Ltd.*;<sup>15</sup> *London and County Banking Co.* v. *Capital and Counties Bank*;<sup>16</sup> *Merchant Banking Co., of London* v. *The Merchants' Joint Stock Bank*;<sup>17</sup> *Army and Navy Co-operative Society, Ltd.* v. *The Junior Army and Navy Stores, Ltd.*;<sup>18</sup> *Daimler Motor Car Co., Ltd.* v. *British Motor Traction Co., Ltd.*;<sup>19</sup> *Aerators, Ltd.* v. *Tollit*;<sup>20</sup> *British*

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(3) (1926) 43 R.P.C. 97.

(4) (1927) 44 R.P.C. 299.

(5) (1928) 46 R.P.C. 96.

(6) (1929) 46 R.P.C. 432.

(7) (1930) 47 R.P.C. 337.

(8) (1930) 47 R.P.C. 481.

(9) (1931) 48 R.P.C. 163.

(10) (1931) 48 R.P.C. 350.

(11) (1934) 51 R.P.C. 407.

(12) (1935) 52 R.P.C. 386.

(13) (1913) 40 Cal. 570.

(13-a) *Statesman*, July 26, 1933.

(14) (1848) 17 L.J.Ch. 37.

(15) (1864) 33 Beav. 548; 55 E.R. 482.

(16) Cited in *Merchant Banking Co., of London* v. *Merchants' Joint Stock Bank*, (1878) 9 Ch.D. 560 at p. 567; *Empire Dig.*, Vol., 43, p. 283.

(17) (1878) 9 Ch.D. 560.

(18) *Seb. Dig.*, p. 393.

(19) (1901) 18 R.P.C. 465 (Registration of the *Daimler Wagon Co., Ltd.*, by the defendant).

(20) (1902) 19 R.P.C. 418; (1902) 2 Ch. 319. (Registration of '*Automatic Aerator Patents, Ltd.*,' by the defendants).

*Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*;<sup>21</sup> *National Cash Register Co., Ltd. v. Theeman* (carrying on business as *Cash Register Co.*);<sup>22</sup> *Plotzker v. Lucas*;<sup>23</sup> *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*;<sup>24</sup> *Randall, Ltd.* (trading as *American Shoe Co.*) *v. Bradley & Sons* (trading as *Anglo-American Shoe Co.*);<sup>25</sup> *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*;<sup>1</sup> *Scottish Union and National Insurance Co. v. Scottish National Insurance Co., Ltd.*;<sup>2</sup> *Royal Insurance Co., Ltd. v. Midland Insurance Co., Ltd.*;<sup>3</sup> *Meikle* (trading as *Kelvinside Chemical Co.*) *v. Williamson* (trading as *Kelvendale Chemical Co.*);<sup>4</sup> *Elliott* (trading as the '*Trade Extension Co.*') *v. Expansion of Trade, Ltd.*;<sup>5</sup> *Standard Ideal Co. v. Standard Sanitary Manufacturing Co.*;<sup>6</sup> *John Brinsmead & Sons, Ltd. v. Brinsmead*;<sup>7</sup> *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*;<sup>8</sup> *Waring and Gillow, Ltd. v. Gillow and Gillow, Ltd.*;<sup>9</sup> *Baird and Tatlock (London), Ltd. v. Baird and Tatlock, Ltd.*;<sup>10</sup> *Buttons, Ltd. v. Buttons Covered, Ltd.*;<sup>11</sup> *Society of Motor Manufacturers and Traders, Ltd. v. Motor Manufacturers' and Traders' Mutual Insurance Co., Ltd.*;<sup>12</sup> *Tigon Mining and Finance Corporation, Ltd. v. South Tigon Mining Co., Ltd.*;<sup>13</sup> *Jay's, Ltd. v. Jacobi and Limburg*;<sup>14</sup> *The Corporation of the Hall of Arts and Sciences* (commonly known as the *Albert Hall*) *v. Albert Edward Hall*;<sup>15</sup> *William Dimech v. Goffredo Alessandro Chretien*.<sup>16</sup>

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(21) (1907) 2 Ch. 312; 24 R.P.C. 641.

(22) (1907) 24 R.P.C. 211.

(23) (1907) 24 R.P.C. 551.

(24) (1907) A.C. 430; 24 R.P.C. 572.

(25) (1907) 24 R.P.C. 657 at p. 773.

(1) (1907) 24 R.P.C. 688; 25 R.P.C. 149; 97 L.T. 196.

(2) (1908) 25 R.P.C. 560.

(3) (1903) 26 R.P.C. 95.

(4) (1909) 26 R.P.C. 775.

(5) (1910) 27 R.P.C. 54; 54 Sol. Jo. 101.

(6) (1910) 27 R.P.C. 789; 103 L.T. 440.

(7) (1913) 1 Ch. 492; 30 R.P.C. 493.

(8) (1913) 30 R.P.C. 609.

(9) (1916) 33 R.P.C. 173; 32 T.L.R. 389.

(10) (1917) 34 R.P.C. 85.

(11) (1920) 37 R.P.C. 45.

(12) (1925) Ch. 675; 42 R.P.C. 307.

(13) (1931) 48 R.P.C. 526.

(14) (1933) 50 R.P.C. 132 (Defendants Trading as Jays).

(15) (1934) 51 R.P.C. 398.

(16) A.I.R. 1931 P.C. 15; 61 M.L.J. 334 (P.C.).

**Use of a Trade name after sale or assignment.**—The respective rights of assignor and assignee of trade marks have already been discussed in Chapter V. The right to use the name of the business passes along with the sale or assignment to the purchaser or assignee. "Where a person carries on business in a particular name, which is not his own name, and then sells the goodwill of the business, the exclusive right to use the trade name in connection with the business passes with the goodwill to the purchaser."<sup>17</sup> In the absence of any restrictive conditions the vendor has a right to commence similar business afresh but he will, ordinarily, be restrained from adopting a trade name which is identical with or a colourable imitation of the name of the business he has sold.<sup>18</sup> The case is, however, slightly different where the name concerned is the personal name of the vendor. In these cases the law recognises the inherent right of a person to use his own name for honest trading purposes. Where, therefore, the trade name is the name of the vendor "the purchaser cannot, unless there be some bargain to that effect, prevent the vendor from continuing to use what is his own name for the purpose of carrying on a similar business, notwithstanding the assignment of the goodwill. The vendor, however, may by express bargain confer on the purchaser of the goodwill the right to carry on business under the vendor's own name and may preclude himself in like manner from using his own name for business purposes." But even in the absence of such agreement the vendor will not be allowed to use his name as the name of the new business except for honest trade purposes. Under the garb of using his own name he cannot attempt to make a false representation to the public that his new business is the same as, or is only a continuation of, his old business and, thereby, divert to himself the custom which might otherwise go to the vendee.

**There must be no risk of liability on late owner.**—It may be observed here that where the trade name is the personal name of the vendor the vendee will not be permitted to use the name *simpliciter* and without explanation, if such use of the trade name is likely to impose on the late owner some personal liability. To quote Lord Justice Farwell, "The Court no doubt qualifies the right which is given under an assignment of goodwill when the actual use of the name is not specified, by limiting the user of

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(17) *Per Parker, J., in Pomeroy (Mrs.), Ltd. v. Scale*, (1906) 24 B.P.C. 177.

(18) *See for instance Wood v. Hall*, (1916) 33 B.P.C. 16.

the name to which the goodwill is annexed so as not to impose a personal liability upon the assignor.”<sup>19</sup>

**Partnerships.**—On the dissolution of partnership if the whole business along with the goodwill pertaining thereto is sold, the right to the exclusive use of the trade name passes on to the purchaser. But if the partners divide the assets among themselves, each partner has an equal right to the use of the former business name, in the absence of any stipulations to the contrary regarding the goodwill. Such right is, however, subject to the limitation already pointed out, *viz.*, that the name should not be used in such a way as to impose any personal liability on any of the late partners.

**Right to use personal name cannot be conferred without goodwill.**—While a person has a proprietary right in his own name and may honestly use it for his own business in competition with a similar business, the right to use his name cannot be assigned in gross. If the person has never carried on such a business on his own account or in partnership with others he cannot by promoting and registering a company with a title of which his name forms a part, confer upon that company the rights which he, as an individual, possesses in the use of that name. As Chitty, J., said: “A man cannot sell his own name to another for the purpose of carrying on a rival trade fraudulently.”<sup>20</sup> The courts have, thus, “recognised a distinction between the case of a man using his own name in his business, and that of the creation by him of an artificial person or company for which a name has to be chosen *ad hoc*.”<sup>21</sup> The reason was explained by Stirling, J., in the following passage: “The company is proposed to be called ‘Louis Tussaud, Ltd.’, and the natural effect of that would be to convey to the public the idea that there has been a business carried on under the name of ‘Louis Tussaud,’ and that for some reason or another that business so carried on had been handed over to a public company. But in point of fact there never has been any business carried on by Louis Tussaud either under his own name, or under any other, nor has there been a business of which he has been the proprietor, and I think that the presumption which ought to be

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(19) *Townsend v. Jarman*, (1900) 2 Ch. 698; 17 R.P.C. 649 at p. 663. See also *Thynne v. Shove*, (1890) 45 Ch.D.577; *Burchell v. Wilde*, (1900) 1 Ch. 551.

(20) *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, and *U. Melachrino*, (1887) 4 R.P.C. 215.

(21) *Per Astbury, J.*, in *Waring and Gillow, Ltd. v. Gillow and Gillow, Ltd.*, (1916) 33 R.P.C. 173; 82 T.L.R. 389.

made is. . . . .that *prima facie* the object of the defendant in promoting the proposed company is to induce the world to believe that the business intended to be carried on is that of the plaintiff or a branch of it."<sup>22</sup>

In these cases it is no defence that the individual whose name has been adopted as the trade name of the new company is himself one of its partners, or directors or its manager. In *Massam v. Thorley's Cattle Food Co.*,<sup>23</sup> Joseph Thorley had for many years manufactured and sold extensively an article called "Thorley's Food for Cattle" made according to a secret recipe. After his death a company was formed by other persons under the name of J. W. Thorley's Cattle Food Co., in which J. W. Thorley a brother of Joseph Thorley had a nominal share. J. W. Thorley who had been employed under Joseph Thorley and knew the secret of manufacture was employed by the company to conduct their business. On action by the executors of Joseph Thorley the defendant company was restrained from selling the article under the name, "Thorley's Food for Cattle," without sufficiently distinguishing it from the article manufactured and sold at the establishment of Joseph Thorley. In *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*,<sup>24</sup> U. Melachrino, a brother of one of the plaintiffs, who had been formerly employed in the plaintiffs' business, entered into an agreement with one Poulides to act as manager of the latter's cigarette business to be carried on under the name "The Melachrino Egyptian Cigarette Co." The new firm commenced business in the neighbourhood of plaintiff's business. Injunction was granted restraining defendants from carrying on business under the name of Melachrino & Co., or of Melachrino. Again, in *Tussaud v. Tussaud*<sup>25</sup> the plaintiffs were

(22) (1890) *Tussaud v. Tussaud*, 44 Ch.D. 678.

(23) (1880) 14 Ch.D. 748; 28 W.R. 966. *Applied Warner v. Warner*, (1889) 5 T.L.R. 327; 359.

(24) (1887) 4 R.P.C. 215. See also *Teofani & Co., Ltd. v. Teofani*, 30 R.P.C. 76, 446; (1913) 1 Ch. 191; 109 L.T. 114.

(25) (1890) 44 Ch.D. 678. See also *Isaacson v. Thompson*, (1871) 41 L.J.Ch. 101, where the plaintiff was trading under the name "Madam Louise," while the defendant used on his shops the names of "Agnes Ellis" and "E. Louise" under the pretence that they were his daughters' names. Injunction was refused on the ground of plaintiffs' delay in bringing action. In *Rendle v. Edgumbe Rendle & Co., Ltd.*, (1890), 63 L.T. 94, J. E. Rendle who carried on glass roofing business under the name of "J. Edgumbe Rendle & Co.," made an assignment for the benefit of his creditors of his business and all his property. He subsequently promoted a company of which he was the manager and registered it under the name "J. Edgumbe Rendle & Co., Ltd.,"



successors in business to the well-known wax work exhibition of Madam Tussaud while the defendant Louis Tussaud, a wax modeller promoted a rival company of which he was to be the manager under the name "Louis Tussaud, Ltd.". In granting an injunction Stirling, J., said that "the defendant could not either for valuable consideration or otherwise confer on another person the right to use the name of "Tussaud" in connection with a business, which the defendant had never carried on, and in which the defendant had no interest whatever." This case was followed in *Fine Cotton Spinners and Doublers' Association, Ltd. and J. Cash & Sons, Ltd. v. Harwood Cash & Co., Ltd.*<sup>1</sup> An injunction was granted to restrain one John Harwood Cash, formerly the manager of Cash & Sons, Ltd., a well-known firm of cotton doublers and spinners from registering a rival company under the name 'Harwood Cash & Co., Ltd.,' for carrying on similar business. Joyce, J., said: "The defendant company has no legal right to the name Cash or any other name previously belonging to some one else the use of which might lead to deception. I consider, as the law stands at present, that a new company with a title of which the name "A" for instance, forms part has not the natural rights that an individual firm with the name of "A" would have. I think, also, that such a company, merely by registration, does not acquire and incorporate the individual rights which its promoters may respectively have had to carry on business in their own names; and, further I think that a person of the name of "A" without transferring a business and goodwill cannot, by merely authorising the promoters of a company to use his name as part of their title, confer upon such a company a right to do so as against other people who would be damaged thereby."<sup>2</sup>

**Unauthorised use of a designation indicating membership of Learned Society.**—A learned Society which has established a reputation has a right to restrain a person from representing himself to be its member when he is not. In such cases it must be made out that the designation in question denoted to the public that the person to whom it is applied is a member of the plaintiff

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to-carry on the business of glass roofing. Injunction was granted as the name was held to be calculated to deceive.

(1) (1907) 2 Ch. 184; 24 R.P.C. 533. See also *Kingston, Miller & Co., Ltd. v. Thomas Kingston & Co., Ltd.*, (1912) 1 Ch. 575; 29 R.P.C. 289; *Guimaraens & Son v. Fonseca & Vasconcellos, Ltd.*, (1921) 38 R.P.C. 388.

(2) See also observation of Farwell, L.J., in *Randall, Ltd. v. Bradley & Son*, (1907) 24 R.P.C., p. 780.

Society. An illustrative case is that of the *Society of Accountants and Auditors v. Goodway*.<sup>3</sup> The plaintiff Society was incorporated in 1885 to provide a central organisation for accountants and auditors and it held examinations to encourage a greater degree of efficiency in book-keeping. The Society published the "Incorporated Accountants' Year Book" containing a list of its members, and the "Incorporated Accountants' Journal." In 1902, a company, called the London Association of Accountants, Ltd., was formed with objects of a similar nature and claimed the right to use the words "Incorporated Accountant" for its members. In an action brought by the plaintiff Society it was held that the expression "Incorporated Accountant" was not a descriptive term as contended by the defendants but meant a member of the plaintiff Society, and that the unauthorised use of the expression by the defendants was calculated to deceive the public. In granting an injunction Warrington, J., said that it was a matter of pecuniary value to the plaintiff Society to have as many members as possible, that the possession of the status arising from the fact of membership was an inducement to persons to become members and that the defendants' act would reduce that status and thus tend to remove some of the inducement which would actuate people in becoming members of the plaintiff Society.<sup>4</sup> The above case was followed in *British Medical Association v. Marsh*<sup>5</sup> where an injunction was granted to restrain the defendant from selling drugs or medical remedies under the description "B.M.A.," or under a name of which these initials formed a part, so as to represent that the plaintiffs were in any way connected with the defendant's business. It was held that the initials "B.M.A." were associated in the minds of the public with the plaintiff association, and that the acts of the defendant tended to injure the plaintiffs in their business both by tending to cause existing members of the Association to leave and by causing qualified medical men not yet members of the Association to abstain from joining it.

**Names of charitable societies.**—A charitable society is entitled to restrain a rival society from using a name which is likely to be mistaken for the former, provided it is shown that the similarity in names would cause pecuniary loss. The Gurkha Associa-

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(3) (1907) 1 Ch. 489; 24 R.P.C. 159.

(4) *Society of Accountants in Edinburgh v. Corporation of Accountants, Ltd.*, 20 R. (Scotch) 750. 30 Scottish Law Reporter, 677 followed.

(5) (1931) 47 T.L.R. 472; 48 R.P.C. 565.

tion,<sup>6</sup> a society registered under Act XXI of 1860, brought an action for an injunction restraining the defendants from using the name "Gurkha Sabha" for a rival charitable institution, on the ground that it was likely to be mistaken and thereby to divert to itself the money intended for the plaintiff society. The District Judge held that the allegations made in the plaint did not disclose any cause of action but on appeal the case was remitted for decision on the merits, and it was laid down that there is no distinction in the rule applicable to the names of business concerns and charitable societies.

*British Legion v. British Legion Club (Street), Ltd.*,<sup>7</sup> is another similar case. The plaintiff society was formed in 1921, for the purpose of promoting the benefit and welfare of ex-service men and officers while the defendant company was registered for the purpose of a non-political social club. It was held that the name "British Legion" had become well known as meaning the plaintiff society, that the name of the defendant society was likely to cause confusion and that there was a real possibility of consequent damage to the plaintiff society. In granting an injunction, Mr. Justice Farwell observed that, to an ordinary person the name of the defendant company would suggest that it was either a branch of the plaintiff association, or that it was a club in some way connected with or under the supervision of the plaintiff association. If, therefore, the defendant company was at any time in financial trouble or in some other way of discredit the result would be that many of the persons who knew of the existence of the defendant club might think that the plaintiff association had been very ill-advised and very unfortunate in having any connection with such a company and that might well tend to prevent persons who otherwise would have supported the plaintiff association by subscriptions or otherwise from continuing to do so. "In appealing as they do to the public and requiring as they do vast sums to carry out their objects, it is obvious that they (plaintiff Association) must have a clear sheet if they are to appeal successfully, and if the defendant company were to fall on evil days that might, although not to a great number of persons, but to a certain number of persons, reflect discredit on the plaintiff Association and might result in damages to that Association."

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(6) *Gurkha Association, Simla v. Mahomed Umar*, (1919) 51 I.C. 905; 97 P.W.R. 1919.

(7) (1931) 47 T.L.R. 571; 48 R.P.C. 555. See also *British Medical Association v. Marsh*, (1931) 48 R.P.C. 565; 47 T.L.R. 472.

**Right to Trade under one's own name.**—The *prima facie* right of every man to compete with another in business and to use his own name for this purpose has been recognised from early times. In the epigrammatic language of Lord Justice Knight Bruce, "all the Queen's subjects have a right, if they will, to manufacture and sell pickles and sauces and not the less that their fathers have done so before them. All the Queen's subjects have a right to sell these articles in their own names, and not the less so, that they bear the same name as their fathers."<sup>8</sup> In these cases a plaintiff cannot claim an exclusive monopoly to the use of his personal name for trading purposes on the ground of prior user and restrain a subsequent rival of the same name from trading under that name. But this apparent exception to the general rule is an exception made in the interests of honest trading. The law will not allow a person by reason of the similarity of his name to that of a well established business to steal the custom and trade reputation of the other business, or to pass-off his goods fraudulently as the goods of his better known rival. The need for restraining such unfair competition has never been questioned. But, whether apart from fraud, there are any circumstances under which a person may be restrained from honestly trading under his own name, was not free from doubt in the past and it is only in recent years that it has come to be recognised that fraud is not necessary to constitute an actionable wrong in the case of personal names also.

Three distinct stages may be noticed in the evolution of the law. In the earlier authorities, e.g., *Croft v. Day*,<sup>9</sup> it was clearly laid down that a person shall not be allowed to use his own name fraudulently for the purpose of deceiving the public. From one or two of these well-known judgments it would appear that fraud was not considered as an essential requirement for an action of this sort, but nowhere was it thus expressly stated. On the other hand, in *Turton v. Turton*<sup>10</sup> which was decided in 1889, the Court of Appeal stated in clear and unambiguous terms that the innocent use by a trader of his own name could under no circumstances be challenged. But this view was finally modified by *Reddaway v. Banham*<sup>11</sup> and other well-known cases. Here the limitation of the

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(8) *Burgess v. Burgess*, (1853) 43 E.R. 351; 3 De G.M. & G. 896.

(9) (1843) 49 E.R. 994; 7 Beav. 84.

(10) (1889) 42 Ch. D. 128.

(11) (1896) A.C. 199; 13 R.P.C. 218.

right to use one's personal name was carried a definite stage further *viz.*, that where a plaintiff's name has acquired secondary signification he is entitled to an injunction, notwithstanding the absence of fraud on the part of the defendant. The judgment of Lord Herschell in that famous case makes it clear that a man may so use even his own name in connection with the sale of goods as to make a false representation and that a personal name should be treated in the same manner as any descriptive word, mark, device, or get-up for purposes of protection under the common law. In other words, if in fact the use of the personal name by the defendant does lead, or is likely to lead to a misrepresentation that the goods of the defendant are the goods of the plaintiff then the defendant is not entitled to use his name, though it is his own name and though he has not any fraudulent intention. This principle has been followed in later cases and forms the basis of law at the present time. A number of leading cases are discussed below to illustrate the various stages in the historical development of the law relating to the use of personal names.

**Croft v. Day.**—One of the earliest cases dealing with personal names is *Croft v. Day*<sup>12</sup> decided in 1843. The executors of the firm "Day and Martin," well-known blacking manufacturers, brought an action against the defendant, a nephew of Day, who started a rival business, and who after obtaining the permission of one Martin to use his name, sold his blacking with a label containing the names "Day & Martin." Fraud was definitely established. In granting an injunction Lord Langdale observed that while the defendant was not debarred from carrying on the business of a blacking manufacturer honestly and fairly and using for this purpose his own name or any other name likely to benefit him in an honest manner he would be prevented from using it in such a way as to deceive and defraud the public and to obtain for

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(12) (1843) 49 E.R. 994; 7 Beav. 84. Referred:—*Edelsten v. Vick*, (1853), 68 E.R. 1194; 11 Hare 78; *Burgess v. Burgess*, (1853), 22 L.J.Ch. 675; *Rodgers v. Nowill*, (1853) 43 E.R. 241; 3 De G. M. & G. 614; *Taylor v. Taylor*, (1854) 2 Eq. Rep. 290; 22 L.T. 271; *Leather Cloth Co. v. American Leather Cloth Co.*, (1863) 46 E.R. 868; 4 De G. J. & S. 137; *Maxwell v. Hogg*, (1867) 2 Ch. App. 307; 36 L.J.Ch. 433; *Wotherspoon v. Currie*, (1870) 18 W.R. 562; *Cheavin v. Walker*, (1877) 37 L.T. 300; *Massam v. Thorley's Cattle Food Co.*, (1877) 6 Ch.D. 574; *Metzler v. Wood*, (1878) 8 Ch.D. 606; *Hendriks v. Montagu*, (1881) 44 L.T. 879; *Tussaud v. Tussaud*, (1890) 44 Ch.D. 678; *Powell v. Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54; *Reddaway v. Banham*, (1896) App. Cas. 199; *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, (1900) 83 L.T. 259; 17 R.P.C. 673.

himself, at the expense of the plaintiff an undue and improper advantage.

**Holloway v. Holloway.**—*Holloway v. Holloway*<sup>13</sup> is another early case. The plaintiff, who made and sold pills as “Holloway pills and ointment” obtained an injunction restraining his brother from selling other pills and ointment as “H. Holloway’s pills and ointment.” It was proved that the defendant had adopted the name with fraudulent intention to profit by the similarity between the two names. This case was also decided by Lord Langdale, M.R., who observed: “The defendant’s name being Holloway he has a right to constitute himself a vendor of Holloway’s pills and ointment, and I do not intend to say anything tending to abridge any such right. But he has no right to do so with such additions to his own name as to deceive the public, and make them believe that he is selling the Plaintiff’s pills and ointment.” It is clear from this passage that the learned Master of the Rolls, to whom we are indebted for the first clear enunciation of the law of passing-off<sup>14</sup>.—and the law stands to-day exactly as his Lordship originally stated it—did not contemplate any distinction between the law applicable to the case of a personal name and any trade mark or trade name.

**Burgess v. Burgess.**—The next important case is *Burgess v. Burgess*,<sup>15</sup> a “great case” as Lord Halsbury calls it,<sup>16</sup> which has

(13) (1850) 51 E.R. 81; 13 Beav. 209. Referred:—*Powell v. Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54; 12 R.P.C. 496; *Jamieson & Co. v. Jamieson*, (1898) 14 T.L.R. 160; 15 R.P.C. 169; *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, (1893) 83 L.T. 259; 17 R.P.C. 1, 673; *Bile Bean Manufacturing Co. v. Davidson*, (1905) 22 R.P.C. 553, 23 R.P.C. 725.

(14) See *Perry v. Truefitt*, (1842) 6 Beav. 66; 1 L.T. (O.S.) 384.

(15) (1853) 43 E.R. 351; 3 De G. M. & G. 896. Referred:—*Massam v. Thorley’s Cattle Food Co.*, (1880) 14 Ch.D. 748; *Turton v. Turton*, (1889) 42 Ch.D. 128; *Tussaud v. Tussaud*, (1890) 44 Ch.D. 678; *Reddaway v. Banham*, (1896) A.C. 199; 13 R.P.C. 218; *Jamieson & Co. v. Jamieson*, (1898) 15 R.P.C. 169; 14 T.L.R. 160; *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, (1900) 83 L.T. 259; 17 R.P.C. 1, 673; *Warsop v. Warsop*, 21 R.P.C. 481; *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, (1907) A.C. 430; 24 R.P.C. 572; *Brinsmead v. Brinsmead*, (1913) 30 R.P.C. 137, 493; *Teofani & Co., Ltd. v. Teofani*, 30 R.P.C. 76, 446; (1913) 1 Ch. 191; 109 L.T. 114; *Goddard v. The Watford Co-operative Society, Ltd.*, (1924) 41 R.P.C. 218. See also *Fullwood v. Fullwood* (No. 1) W.N. 93, 185, (1873); (No. 2) 9 Ch.D. 176 (1878); Seb. Dig., p. 367.

(16) *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, (1907) 25 R.P.C. 149; 98 L.T. 258.

been cited in several of the later judgments. The plaintiff was selling "Burgess essence of Anchovies," while the defendant, his son, set up a similar business and called his goods by the same name. Injunction was refused on the ground that that term "essence of Anchovies" was merely descriptive of the goods and that the defendant was entitled to use his own name to sell his "essence of Anchovies." Lord Justice Turner, to whose "accurate and masterly summary of the law"<sup>17</sup> Lord Macnaghten and other eminent judges have paid glowing tributes, laid down the law thus: "No man can have any right to represent his goods as the goods of another person, but in applications of this kind it must be made out that the defendant is selling his own goods as the goods of another. Where a person is selling goods under a particular name, and another person, not having that name, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name and it happens that the plaintiff has the same name, it does not follow that the defendant is selling the goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not."

The above judgment clearly emphasizes that a person shall not be allowed to represent falsely his goods as the goods of another. There is therefore an implied idea that if as a matter of fact it is shown that the defendant has been selling his goods as the goods of the plaintiff, the former cannot then plead in defence that he has been trading only under his own name. Referring to Lord Justice Turner's judgment Lord Herschell observed in *Reddaway v. Banham*<sup>18</sup> that it "clearly recognises that a man may so use even his own name in connection with the sale of goods so as to make a false representation." And, Lord Halsbury observed in the same case, "I cannot understand that there is any principle of law laid down which would have prevented an injunction, although the defendant's name was Burgess, and although the article was described by a descriptive name, which, however, had not, as a matter of fact in that case, in the view of the judges, the technical signification of being only made by Burgess, the father."<sup>19</sup>

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(17) *Per* Lord Macnaghten in *Reddaway v. Banham*, (1896) A.C. 199; 13 R.P.C., at p. 233.

(18) (1896) A.C. 199; 13 R.P.C. 218.

(19) See also *Massam v. Thorley's Cattle Food Co.*, (1880) 14 Ch.D. 748,

**Turton v. Turton.**—On the other hand, an entirely different principle was laid down in *Turton v. Turton*<sup>20</sup> which was decided in 1889. In that case the Court of Appeal observed that, provided the name used by a defendant is an accurate statement of actual fact, he was not liable for any injury caused to the plaintiff's business arising from similarity of the two names. In the view of the Court of Appeal the only limitation to a person's right to the use of his name was that a defendant should not have adopted it for a fraudulent purpose. The facts of the case were the following: The plaintiffs were the successors in business to Thomas Turton & Sons, Ltd., while the defendants who had hitherto been trading under the style of 'John Turton & Co., took his two sons into partnership and changed the name of his company to "John Turton & Sons." Apart from the fact that certain letters had been misdelivered, it was not shown that the defendants' use of the name was calculated to deceive. Nor was fraudulent intent on the part of the defendants shown. Injunction was granted by North, J., but his order was reversed by the Court of Appeal.

**Lord Esher's judgment.**—In his learned judgment, in the Court of Appeal, Lord Esher stated that in the absence of fraud a person cannot be restrained from using his personal name for trading purposes, and that the defendant had not done anything fraudulently for the purpose of making the use of his name look as if his name was the name of the plaintiffs. "In some cases, besides using the name, parties have to use, what I think is a happy phrase of my brother Cotton's, 'garnished that use,' that is, they have done things besides using the name, in order that the use of that

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where Lord Justice James observed:—"Burgess v. Burgess has been very much misunderstood if it has been understood to decide that anybody can always use his own name as a description of an article, whatever may be the consequences of it, or whatever may be the motive for doing it, or whatever may be the result of it." See also *Brinsmead & Sons, Ltd. v. Brinsmead*, (1913) 30 R.P.C. 493.

(20) (1889) 42 Ch.D. 128. Referred:—*Tussaud v. Tussaud* (1890) 44 Ch.D. 678; *Powell v. Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54; 12 R.P.C. 496; *Reddaway v. Bankam*, (1896) A.C. 199; 13 R.P.C. 218; *Rodgers v. Rodgers Simpson*, (1906) 23 R.P.C. 297; *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, (1916) 17 R.P.C. 1, 673; 83 L.T. 259; *Brinsmead v. Brinsmead*, (1913) 30 R.P.C. 137, 493; *Teofani & Co., Ltd. v. Teofani*, (1913) 2 Ch. 545; 30 R.P.C. 76, 446; *Waring and Gillow v. Gillow and Gillow, Ltd.*, (1916) 32 T.L.R. 389; 33 R.P.C. 173; *Rodgers v. W. N. Rodgers & Co.*, (1924) 41 R.P.C. 277.



name might look as if it were being used by the old firm. There is nothing of that kind here." His Lordship then observed: "He (defendant) is simply stating that he is carrying on business with his two sons as partners. I say that is the accurate and exact truth of what he is doing. I will assume for the moment that it is pointed out to him what he is doing, that blunders will occur in the business and that the results which are complained of will happen. Is there anything dishonest,—is there anything wrong morally, in any, even in the strictest sense, in a man using his own name, or stating that he is carrying on business exactly as he is carrying it on? Is there anything wrong in his continuing to do so, because people make blunders, and even, if you please, because they make probable blunders? What is there wrong in what he is doing? . . . . But they (plaintiffs) have no right to say that a man may not rightly use his own name. I cannot conceive that the law is such. If the law were such, the law would be most extraordinary, and, to my mind, most unjust, to prevent a man using his own name. . . . The proposition goes to this length; that if one man is in business and has so carried on his business, that his name has become a value in the market, another man must not use his own name. If that other man comes and carries on business he must discard his own name and take a false name. The proposition seems to me so monstrous, that the statement of it carries its own refutation. Therefore, upon principle, I should say it is perfectly clear that if all that a man does is to carry on the same business, and to state how he is carrying it on, that statement being the simple truth, and he does nothing more with regard to the respective names, he is doing no wrong. He is doing what he has an absolute right by the law of England to do, and you cannot restrain a man from doing that which he has an absolute right by the law of England to do."

**Secondary signification of personal names.**—*Turton v. Turton*<sup>20-a</sup> thus enunciated the doctrine that a person had a right to trade in his own name, notwithstanding that the name was calculated to deceive, provided, however, there was no fraud. This proposition of law was best expressed by Lord Kyllachy in the *Dunlop* case.<sup>21</sup> "Far as the law may have gone in its justifiable anxiety to prevent imposition upon the unwary purchaser, and content as it has sometimes been to pursue that object at the expense of encouraging the

(20-a) (1889) 42 Ch.D. 128.

(21) *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, (1906) 23 B.P.C. at p. 770.

acquisition of virtual monopolies by traders and companies prepared to spend largely in systematic advertising and litigation, it has never as yet, at least so far as I know, gone the length of debarring any merchant or manufacturer from selling his own goods under his own name, unless there has been, in addition to the use of that name, some overt act or course of conduct plainly indicative of fraud—that is to say, of dishonest effort to pass-off his own goods as the goods of another.”

But the above proposition does not represent the correct position of law at the present day. *Turton v. Turton* has been much modified by a number of later decisions which emphasize the importance of secondary signification of personal names. The result is that the courts nowadays recognize hardly any distinction between a personal name and any descriptive word mark. The importance of secondary signification in trade mark cases was forcibly brought out in the historic judgment of the House of Lords in the Camel Hair Belting case.<sup>22</sup> The fallacy in the argument that equity would not enjoin against telling the truth and that a person was, therefore, entitled to use his own name for trade purposes which formed the basis of the judgment in *Turton v. Turton* was shown by Lord Herschell who pointed out that in the case of a descriptive word which had acquired a secondary meaning the use of it would “none the less be a falsehood because in its primary sense it may be true.”<sup>23</sup> According to his Lordship a personal name should be treated as belonging to the same category as descriptive marks. “The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves, without explanation or qualification by another manufacturer, would deceive a purchaser into the belief that he was getting the goods of A, when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a word, name, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put-off his goods as the goods of the plaintiff.” The principle thus stated is that where secondary signification of a personal name is proved it is not necessary to show that the defen-

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(22) *Reddaway v. Banham*, (1896) A.C. 199; 13 R.P.C. 218. This case was decided in 1896 seven years after *Turton v. Turton*.

(23) Per Lord Herschell *Ibid* at p. 229.

dant had used the name with a fraudulent motive. It is enough to show that the defendant's use of his name, *simpliciter* and without explanation is calculated to lead the public to believe that his business is that of the plaintiff.

**Present view.**—The above principle of law is now well settled and was stated in the *Valentine Meat Juice case*<sup>24</sup> by Collins, L.J., thus:—"The action is for passing-off, and the main defence set up . . . . was that the basis of the claim for passing-off was the identity of the name of the defendant and the name of the plaintiffs; and that, so long as the defendant used his own name, and that was the real source of the deception, his position could not be impugned. Now from that proposition I absolutely dissent. If you introduce into it that which has been found as a fact in this case . . . . namely, that the name, which does form the basis of the deception, has acquired a secondary significance, and means only . . . the juice or extract manufactured by the plaintiffs—it does not seem to me to matter a pin's point whether the deception arises from the use of a name which is, as it happens, the name of the defendant, or whether it arises from the use of any other description which, in a sense, may be accurate of that which he sells. For, if the thing which he sells has come to be known in the market as meaning something made by somebody other than himself, it is impossible for him to sell it *simpliciter* by that name, although it be his own, without misleading purchasers." The law was expressed in substantially the same language by Lord Halsbury: "Proper names, when they occur, are distinctive enough; although I do not deny that a person might be restrained even from using his own name. If in point of user a particular thing had become so identified with the proper name of a person who carried on business under his own name that he could establish, as a matter of fact, that the name had become associated with the particular manufacture, I do not deny that another person who set up in business under that name, although it might be that person's own proper name, might be restrained from carrying on business under that name. But these are all questions of fact."<sup>25</sup>

**Difficulty in proving secondary signification of personal names.**—It is clear from the above judgments that the general

(24) *The Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, (1900) 17 R.P.C. at pp. 686, 687; 83 L.T. 259.

(25) *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, (1907) 98 L.T. 258; 25 R.P.C. at p. 154.

principles of the law of passing-off are applicable to personal names in the same manner as in the case of other trade marks or names. Where, therefore, a defendant has been using his name honestly and the plaintiff seeks to restrain him from doing so the plaintiff will have to establish clearly that his name had acquired secondary signification and that the defendant's use of the same name would, in the circumstances, be calculated to deceive.<sup>1</sup> As Lord Justice Vaughan Williams observed: "A plaintiff can never complain of the user by the defendant of either the plaintiff's personal name or of any other name that he chooses to use for the purpose of denoting his goods, unless he first establishes that in the market his goods have come to be known by that name."<sup>2</sup> Whether a personal name has acquired secondary signification or not is a question of fact and would depend upon the nature of the name,<sup>3</sup> the class of goods and a number of other factors. Such secondary meaning would in general be extremely difficult to establish. The burden of proving secondary signification lies on the plaintiff and this burden is generally very great. But if this fact is established the legal consequence follows without exception. A few of the leading cases illustrating these general principles are discussed below.

**Jamieson & Co. v. Jamieson.**—In *Jamieson & Co. v. Jamieson*<sup>4</sup> the plaintiffs who were manufacturers of harness composition failed to get an injunction restraining the defendant from doing similar business under his personal name. It was held by the Court of Appeal that the get-up of the defendant's tins was distinct and had no similarity to that of the plaintiffs' goods and that there was no passing-off. Lindley, M.R., said:—"When we are asked to

(1) The form of injunction generally granted is to restrain the defendant from carrying on business under the name in question in such manner as to be calculated to deceive. See *Cash, Ltd. v. Cash*, (1902) 86 L.T. 211; 19 R.P.C. 181. See however, *Pinet et cie v. Maison Louis Pinet, Ltd.*, (1898) 1 Ch. 179; 15 R.P.C. 65, where the defendant was restrained absolutely from using the name "Pinet." This name was not the defendant's name, but was adopted by him fraudulently for passing-off his goods as the goods of the well-known French firm.

(2) *Jamieson & Co. v. Jamieson*, (1898) 14 T.L.R. 160; 15 R.P.C. at p. 193.

(3) "The degree of probability of confusion, arising from people being deceived, depends very often upon the nature of the name that is sought to be taken." *Ibid.*, per Lord Halebury. For instance, a surname of rare occurrence may acquire secondary signification with less difficulty than one which is common, see *Teofani & Co., Ltd. v. Teofani*, (1913) 2 Ch. 545; 30 R.P.C. 76, 446.

(4) (1898) 14 T.L.R. 160; 15 R.P.C. 169.

restrain a man who is carrying on business in his own name, we must take very great care what we are about. The principle applicable to the case, I take it, is this:—The court ought not to restrain a man from carrying on business in his own name simply because there are people who are doing the same and who will be injured by what he is doing. It would be intolerable if the court were to interfere, and to prevent people from carrying on business in their own names in rivalry to others of the same name. There must be something far more than that, *viz.*, that a person who is carrying on business in his own name is doing it in such a way as to pass-off his goods as the goods of somebody else. We must not lose sight for a moment of the real question which we have to try—the question of fact. . . . It is said, because yours may be mistaken for ours, you are bound to take extra precautions to prevent yours from being mistaken for ours. I am not aware of any case that goes so far as that.”

In the same case Vaughan Williams, L.J., observed: “I do not understand that there is any case, or ever has been any case, in which it has been laid down that a man, who happens to bear a particular name, is debarred from entering into any trade which he chooses to enter into, merely, because, there is somebody else of the same name who has acquired a great reputation in the manufacture of the particular goods dealt with in this trade. . . . The personal name of the plaintiff only comes into the matter, because the plaintiff, by the reputation that he has acquired in the business, has really come to denote his goods by his own personal name, just as he might denote them by some fancy name that he chose to use. . . . I mention this for the purpose of calling attention to the fact that a plaintiff never can complain of the user by the defendant of either the plaintiff’s personal name or of any other name that he chooses to use for the purpose of denoting his goods, unless he first establishes that in the market his goods have come to be known by that name. It is not a question as it has been sometimes suggested, of the right of the law to restrain a man from using his own name. The right and duty of the court always is to restrain a man from using a name, that has come to be recognized as the name of a particular trader’s goods, for his, the defendant’s, goods so as to suggest that the defendant’s goods are the plaintiff’s goods, and to pass them off as such.”<sup>5</sup>

**The Valentine Meat Juice case.**—In *The Valentine Meat Juice Co. v. The Valentine Extract Co., Ltd.*,<sup>6</sup> the plaintiffs were selling their well-known meat juice under the name “Valentine” while the defendant company was promoted for manufacturing an extract of meat according to the patent of C. R. Valentine. Injunction was refused by Stirling, J., on the ground that fraud was not found, although secondary signification of the word was established. An appeal was successful, and an injunction was granted. Although the Court of Appeal held that the name ‘Valentine’ had been adopted for fraudulent purpose their Lordships preferred to base their judgment on the broader proposition that there was no distinction in law between the use of a personal name and a descriptive expression, if it, in fact, distinguished the goods of the plaintiff. Lord Alverstone, M. R., observed that the test in both cases was the same, whether or not the goods of the defendant had been represented as the goods of the plaintiff. “Of course it is more difficult to deal with cases where the name is the name of the person, . . . . as distinguished from a fancy name which has been created for the purpose of the particular goods, but I can see no difference in principle between the two cases.”

**Cash, Ltd. v. Cash.**<sup>8</sup>—The plaintiffs as the successors in business of J. & J. Cash were manufacturing and selling in Coventry “Cash’s frillings” and “Cash’s woven names and initials” which were well known. It was proved that these expressions had acquired secondary signification in connection with the plaintiffs’ goods. The defendant started similar business at the same place under the name of ‘Joseph Cash & Co.’ but did not call his goods “Cash’s frillings,” etc. Injunction was, nevertheless, granted by Kekewich, J., restraining the defendant from carrying on business as a manufacturer or seller of frillings or woven names or initials under the name of “Joseph Cash & Co.,” or under the name of “Cash” and from carrying on any such business under any name or in any manner so as to mislead the public. The defendant appealed successfully against that part of this order that restrained him from carrying on business

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(6) (1901) 17 R.P.C. 1, 673; 83 L.T. 259; Considered: *Morrall, Ltd. v. Hessin, & Co.*, 19 R.P.C. 557; *Joseph Rodgers & Sons, Ltd. v. Joseph Rodgers Simpson*, (1906) 23 R.P.C. 297. Applied: *Brinsmead v. Brinsmead*, (1913) 30 R.P.C. 137, 493.

(7) See also judgment of Collins, L.J., in this case.

(8) *J. & J. Cash, Ltd. v. Cash*, 18 R.P.C. 213; (1902) 19 R.P.C. 181; 86 L.T. 261; Followed: *Rodgers (Joseph) & Sons, Ltd. v. Joseph Rodgers Simpson*, (1906) 23 R.P.C. 297.

under the name of 'Cash.' The form of injunction was modified restraining the defendant from carrying on the business either in the name of 'Cash' or under any style in which the name 'Cash' appeared, without taking reasonable precautions to distinguish clearly the defendant's business from the business of the plaintiffs. Vaughan Williams, L. J., observed: "It may be that a trade is of such a nature that the products of the trade will become almost indissolubly connected with the business carried on by a particular manufacturer, who, it may be, created the particular trade; but still, even though that may be so, and even though such fact is to be taken into consideration in an action for an injunction, there never has been a case yet in which an order has been made restraining a man altogether from carrying on in his own name a particular trade."

**Teofani & Co., Ltd. v. Teofani.**—In *Teofani & Co., Ltd. v. Teofani*<sup>9</sup> the plaintiffs were well-known cigarette manufacturers and their cigarettes were known as "Teofani's cigarettes;" while the defendant Athanasium Teofani commenced to sell his cigarettes as "A. Teofani's Non soluk cigarettes." Injunction was granted by Warrington, J., restraining the defendant from marking his cigarettes with the name "Teofani" without clearly distinguishing his goods from the plaintiffs'. An appeal was rejected. It was held by the Court of Appeal that the defendant had used the name with the fraudulent intent and that a surname which was not in common use was registrable as a trade mark. Kennedy, L. J., stated: "As I understand the law there is nothing to prevent a person who is setting up in a trade in which there are already others of the same name from using his own name, but alike from the legal and from the moral point of view a person is forbidden to use his own name in connection with the goods in that business in such a way as to represent that the goods are the goods of somebody else of the same name. If he does that he is doing that which is wrong and which the court, as it seems to me, has consistently through a long list of cases refused to allow him to do. He must carry on his business under his own name honestly, and he does not carry on the business in his own name honestly, if he so uses his name in connection with the business or goods as to lead those who deal with him in that business as purchasers, to believe that they are goods which are the goods of another trader of the same name."

**Brinsmead & Sons, Ltd. v. Brinsmead.**—In *Brinsmead & Sons, Ltd. v. Brinsmead*<sup>10</sup> the plaintiffs were a well-known firm of piano manufacturers and had put their names in Roman characters on their pianos. The defendant Stanley Brinsmead, formerly in the employ of the plaintiff firm set up separate business and marked his name on his pianos in a distinctive manner. In refusing an injunction Warrington, J., observed that, although the defendant knew that he was deriving some advantage from the similarity of his name with the plaintiff company he had not acted fraudulently.<sup>11</sup> The learned judge, following *Turton v. Turton*, observed, that a defendant was entitled to trade in his own name, even if that name was calculated to deceive the public, but this view was expressly dissented from by the Court of Appeal.<sup>12</sup> Referring to this point Lord Justice Buckley observed: "I think the learned judge, with very great respect to him, went wrong in his law. *Turton v. Turton*, upon the doctrine for which he is using it, is no longer law. *Turton v. Turton* was qualified by *Reddaway v. Banham*."

**Law explained by Buckley, L. J.**—The following passage taken from his Lordship's judgment contains a comprehensive statement of the law on this point: "The law, as I understand it, is this:—if a man makes a statement which is true, but which carries with it a false representation and induces the belief that his goods are the plaintiff's goods, he will be restrained by injunction. He cannot rely on the fact that his statement is literally and accurately true, if, notwithstanding its truth, it carries with it a false representation..... Secondly, if it is found that a man's object in doing that which he did was to deceive—that he had an intention to deceive—the Court will be very much more ready to infer that his object has been achieved if the facts tend to show that that is the case, and to say that his intention to deceive ripening into deceit gives ground for an injunction; but it is not necessary to prove intention to deceive..... If the fact is that the act which the defendant is doing does deceive, with the result that

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(10) (1913) 29 T.L.R. 706; 30 R.P.C. 493.

(11) See also the same learned judge's observations in *Teofani & Co., Ltd. v. Teofani*, 30 R.P.C. at p. 90. "It has often been said that a man who is carrying on business under a name cannot prevent another person of the same name from carrying on his business under his own name. That of course is absolutely true, unless, in addition to merely using his own name, he does something by way of garnishment of that name."

(12) The decision of Warrington, J., in this case was, however, upheld on other grounds.



a man, who intends to be a customer of the plaintiffs, is induced by something which the defendant has done to become a customer of the defendant instead, even if the defendant has done that innocently, yet as soon as he learns that in point of fact that which he had no intention of using for the purpose of deceit does create deception, then he is doing that which is wrong, and he will be restrained from pursuing a course of action the result of which is, in point of fact, to take that which is the plaintiffs' property and give it to him, to defraud the plaintiffs' customers into becoming the defendant's customers. Thirdly, in the application of the principles which I have stated, there is, in my opinion, no difference whatever where the true statement consists in an accurate statement of the defendant's name as distinguished from any other true statement of fact, if of course you have evidence that from the use of his own name deception results. If a trader takes a name which is not his own name, but is that of a rival trader, and uses it in his trade, no doubt that is very strong evidence that he intends to deceive, and the court will fasten upon that in any case in which it occurs; but if that is not so, if he is simply using his own name and it is proved that its use results in deception, he will be restrained even from using his own name, without taking such steps as will preclude the deception which, by hypothesis, is engendered by his using his own name. There are many authorities for this proposition."

The learned Lord Justice further observed that the defendant "is perfectly entitled to get such advantage, pecuniary or otherwise, as he can from the fact that his name is Brinsmead, that the family of Brinsmead are supposed to make pianos well, and that if he is a Brinsmead, not being John Brinsmead & Sons, a buyer may buy his piano thinking that he will get a good piano. That is a perfectly legitimate use of his name. The only illegitimate use is, if he so uses it as to convey that he is not himself, but John Brinsmead & Sons, or some member of that firm."

**Goddard v. The Watford Co-operative Society, Ltd.**—In *Goddard v. The Watford Co-operative Society, Ltd.*,<sup>13</sup> it was shown that the terms "Goddard Plate Powder" and "Goddard's Non-mercurial plate powder" had acquired secondary signification, in connection with the plaintiffs' goods. The defendant Society claimed the right to sell under the same name a product supplied to them by one Rosina Goddard. It was established that this Miss

Goddard had the right of concurrent user of the above trade descriptions for her plating powder, though only to such a trifling extent as not to have prevented the expressions from acquiring a secondary meaning in connection with the plaintiffs' powder. It was held that the defendants were disentitled to sell plate powder not of the plaintiffs' manufacture as "Goddard Plate Powder" and injunction was granted. Astbury, J., said: "If you once establish, as the plaintiffs have done, that 'Goddard's plate powder' means the plaintiffs' powder, it seems to me that the plaintiffs are in practically the same position as the owners of very well-known name articles. . . . Supposing that anyone of the name of Guinness served up stout in a bottle with a blue label and called it 'Guinness' Stout' I should have thought they would be stopped without hesitation. The same applies to 'Colman's mustard,' 'Lazenby's Sauce' and lots of other cases where the original descriptive character of a name, whether it is a surname or not, has become obviously and universally distinctive." His Lordship said that the only difference between the case of a descriptive word mark and one of a surname is that in the latter case the burden of proof "is different from and greater than that of many other originally descriptive expressions. If once it is established that the plaintiffs' goods are known under a particular originally descriptive term which has become distinctive, then it is only a question of whether the Defendants have or have not exceeded that which they are entitled to do."

**Rodgers v. Rodgers.**—Lord Esher's dictum in *Turton v. Turton* was discussed in a recent case, *Joseph Rodgers and Sons, Ltd. v. W. N. Rodgers & Co.*<sup>14</sup> The plaintiffs had been carrying on business for over 200 years at Sheffield and the word "Rodgers" in the cutlery trade had become identified with their goods. The defendant firm consisting of three partners, Joseph Muller, Wilfred Newbound Rodgers, and Mrs. Manoin, the mother of W.N. Rodgers commenced business as manufacturers of cutlery in 1922 in Sheffield. The plaintiffs, thereupon, sought for an injunction restraining the defendants from carrying on cutlery business under the name of W. N. Rodgers & Co., or any name of which the word "Rodgers" formed a part, and from marking and selling their goods with the name "Rodgers." It was held by Romer, J., that the injunction asked for was too wide and a modified form of injunction was granted.<sup>15</sup> His Lordship said: "I think the law

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(14) (1924) 41 R.P.C. 277.

(15) See Appendix XIX.

can be very simply stated. It is the law of this land that no man is entitled to carry on his business in such a way as to represent that it is the business of another, or is in any way connected with the business of another; that is the first proposition. The second proposition is, that no man is entitled so to describe or mark his goods as to represent that the goods are the goods of another. To the first proposition there is, I myself think, an exception; a man, in my opinion, is entitled to carry on his business in his own name so long as he does not do anything more than that to cause confusion with the business of another, and so long as he does it honestly. It is an exception to the rule which has of necessity been established. It is impossible to say, because Mr. Joseph Rodgers, in the past established a business in cutlery, which has now become so successful that his goods are known as "Rodgers" cutlery, that no one whose name is Rodgers may embark upon a cutlery business if, as I say, he does it honestly, and if he does not do anything more to cause confusion than merely carry on business in his own name. That is what I think was meant by Lord Justice Cotton in the well-known case of *Turton v. Turton*, where he says: 'In my opinion, the court cannot stop a man from carrying on his business in his own name, although it may be the name of a better known manufacturer, when he does nothing at all in any way to try and represent that he is that better known and successful manufacturer.' "I ventured in the course of the argument to give an illustration. A man of the name of Pears is, in my opinion, entitled to carry on the business of the manufacture of soap, but he is not entitled to sell his soap as "Pears' soap;" and, he is not entitled so to mark his soap as to lead to the belief that it is "Pears' soap." The exception to the first rule is, however, an exception made in the interests of honest trading; again, it is an exception which only authorises the use by a man of his own name; it is not an exception which, even in an honest case, entitles a man to use something that is not his own name; that is to say, it does not entitle him to use his name in combination with something else, such as the words "& Company".....To the second rule, to which I have referred, I think there is no exception at all; that is, that a man is not entitled so to describe his goods as to lead to the belief that they are the goods of somebody else. It is not necessary that there should be an exception to that. It is perfectly legitimate for a man in the cutlery business to carry on business under his own name whatever that name may be, but I can see no necessity for his marking his cutlery with a name (although it be his own

name) which may have the effect of passing-off those goods as the goods of the plaintiffs.”

**Other cases.**—A few other important cases may be mentioned. In *Massam v. Thorley's Cattle Food Co.*,<sup>16</sup> J. W. Thorley was the manager of and had a nominal interest in the defendant firm. It was shown that the name was adopted by the defendants for the purpose of passing-off their cattle food for that of the well-known plaintiff firm and injunction was accordingly granted. In *Rigden v. Jones*<sup>17</sup> it was held that “Fownes’ Gloves” meant the plaintiffs’ gloves and the defendants who were trading as “F. and A. Fownes” were not entitled to represent their gloves and business as those of the plaintiffs. In *Abel Morrall, Ltd. v. Hessin & Co.*,<sup>18</sup> the defendant purchased a small business carried on by one Morrall with the object of adopting this name to pass off his needles for the well-known needles of the plaintiff firm. Injunction was accordingly granted. So also in *Rodgers & Sons, Ltd. v. Hearnshaw*,<sup>19</sup> where the defendants bought the business of Rodgers Bros., for the purpose of passing off their cutlery for the well-known goods of the plaintiff firm injunction was granted. In *Pinet et cie v. Maison Louis Pinet, Ltd.*,<sup>20</sup> the defendant fraudulently adopted the name of the famous French shoe manufacturers for the purpose of passing off his shoes, and subsequently sold the business to the defendant company. Injunction was granted restraining the defendant company from trading under a name of which the word “Pinet” formed a part. Injunction was also granted in *J. Lyons & Co., Ltd. v. T. Lyons*.<sup>21</sup>

On the other hand, injunction was refused in *Chivers and Sons v. Chivers & Co., Ltd.*,<sup>22</sup> where Farwell, J., held that the name “Chivers” had not acquired universal secondary signification in connection with the plaintiffs’ jelly. In *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*,<sup>23</sup> the well-known manufacturers

(16) (1880) 14 Ch.D. 748.

(17) (1905) 22 R.P.C. 417.

(18) (1902) 19 R.P.C. 557; 20 R.P.C. 429. See also *Mappin and Webb, Ltd. v. Leapman*, (1905) 22 R.P.C. 398; *Toms and Moore v. Merchant Service Guild, Ltd.*, (1908) 25 B.P.C. 474.

(19) (1906) 23 B.P.C. 349.

(20) (1898) 1 Ch. 179; 15 R.P.C. 65. See also (1897) 14 R.P.C. 933.

(21) (1932) 49 B.P.C. 188.

(22) (1900) 17 B.P.C. 420.

(23) 22 R.P.C. 533; 23 R.P.C. 761; (1907) A.C. 430; 24 B.P.C. 572.

of motor tyres sought unsuccessfully to restrain the defendants, a firm doing retail business in repairing motors and cycles from carrying on business under that name. So also in the "Haematogen" case<sup>24</sup> the plaintiffs who had been selling "Hommel's Haematogen" sought to restrain Hommel & Co., Ltd., from selling "Hommel's Haematogen." Injunction was refused by Mr. Justice Eve, who observed that the "court will not intervene to prevent a man using his own name unless he is so using it as to lead the court to the conclusion that he is using it for the fraudulent and dishonest purpose of filching improperly the trade of the plaintiff," and that no such case had been established. In *Warsop & Sons, Ltd. v. Warsop*<sup>25</sup> the defendant Alfred Warsop, formerly in the plaintiffs' employ commenced to sell cricket bats stamped with his initial and surname. It was held that the markings on the two bats were distinct and the action was accordingly dismissed. In *Uberoi Ltd. v. Kirpal Singh*<sup>1</sup> the plaintiffs did not establish that their firm was exclusively known to the public as "Uberoi" or "Uberoi & Co." As Uberoi was the name of the caste to which both the plaintiffs and the defendant belonged the Court held that the claim to restrain the defendant from using the names "Uberoi" and "Uberoi and Company" could not be sustained.

**Name of business premises.**—The name of the business house or factory where a person has been carrying on business can be protected in the same manner as his trade name. Where it is shown that the name of a shop or premises has acquired a valuable reputation in connection with the plaintiff's business, the plaintiff is entitled to restrain unauthorized use of the name in a manner calculated to deceive the public.<sup>2</sup> Thus, in *The Bodega Co., Ltd., and Rieviere v. Owens*<sup>3</sup> the plaintiffs who had several houses of

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(24) *Actiengesellschaft Hommel's Haematogen v. Hommel*, (1912) 29 R.P.C. 378. See also *Jay's Ltd. v. Jacobi and Limburg*, (1933) 50 R.P.C. 132 (defendants trading under the name Jays, one of them having acquired by reputation the name Jay).

(25) (1904) 21 R.P.C. 481. See also *Dewar & Sons, Ltd. v. Dewar*, (1900) 17 R.P.C. 341.

(1) A.I.R. 1920 Lah. 168; 56 I.C. 709.

(2) See for instance the well-known "Stone Brewery" case, *Montgomery v. Thompson*, (1891) A.C. 217; 8 R.P.C. 361.

(3) 7 R.P.C. 31. See also *Hudson v. Osborne*, (1869) 39 L.J.Ch. 79; Seb. Dig., p. 193, where the plaintiffs who were the purchasers of the goodwill and stock in trade of the defendant's business carried on at "Osborne House" were successful in restraining the defendant from styling his new establishment "Osborne House;" *Bickerby v. Beay*, (1903) 20 R.P.C. 380 (Crown Works); *Boussod, Valadon & Co. v. Marchant*, (1907) 24 R.P.C. 665;

refreshment in various places in the United Kingdom, the establishments being called by the name of "Bodega," showed that the name 'Bodega' had acquired secondary signification in connection with their business. The defendant opened a restaurant in Belfast which he called "Bodega." In granting an injunction Chatterton, V. C., said: "It may be fairly inferred that if a person acquainted with 'Bodega' known by him to be rightly carried on under that name, the goods sold in which he had learned to be of high quality, were to find in a locality with which he was unacquainted an establishment called a "Bodega" he would assume that it also was carried on by the Bodega Company, or by their permission. I find a great body of evidence which goes to show that a person seeing the name "Bodega" over an establishment would assume that it was carried on by the plaintiffs." "There is another way in which this might seriously prejudice the plaintiffs' rights; namely that a person in the habit of frequenting "Bodegas" elsewhere visiting such an establishment as that of defendant, and finding it inferior in every respect, probably would not take the trouble of making any enquiries as to the ownership of it, and would form an opinion that the designation "Bodega" was not to be relied on as an indication of the high character of the establishments carried on under that name. This would necessarily mean a serious injury to the plaintiffs."

In *The Clock, Ltd. v. The Clock House Hotel, Ltd.*,<sup>4</sup> the plaintiffs were the proprietors of a road-house the prominent feature of which was a clock on the top of the building. The establishment acquired a reputation and was known as "The Clock." The defendant company's hotel was opened about five miles from the plaintiffs' road-house on land adjoining the same road, and had a clock tower on which were written in large letters the words "Hotel Clock House." An injunction was granted but was limited to restraining the defendants from using the words complained of on their present premises. Mr. Justice Farwell said that "many people, knowing of the defendants' premises would think they were connected in some way with or under the same management as the plaintiff company; and if either of the premises was to fall upon evil days, if either were to commit offences against the law, . . . . and were to fall into disrepute the result might well be that, the

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(1908) 25 B.P.C. 42 (Goupil Gallery); *Pullman Ltd. v. Pullman*, (1919) 36 B.P.C. 240 (Westbrook Mills).

(4) (1935) 52 B.P.C. 386.

public taking the two to be connected, the one that was not in fault might suffer for the misfortune of the other.”

**Name must be calculated to deceive.**—In these cases the plaintiff has to establish that the name of the premises has acquired a secondary signification with his business and the adoption of the name by the defendant would be calculated to deceive the public and injure his business. Otherwise, injunction will be refused. So, in a case<sup>5</sup> where it was shown that the defendant had a concurrent right of user of the name “Castle Brewery” the action was dismissed. The reputation of the plaintiff’s premises may be merely a local one. The plaintiff will none the less be entitled to relief, if in that locality a rival trader adopts a similar name and thereby causes confusion and damage; but in such cases the injunction will be limited to that particular locality.<sup>6</sup> A mere probability of confusion arising from the similarity of the address is not actionable.<sup>7</sup> It must be shown that there is a probability of injury to the plaintiff’s business. A person may not, therefore, acquire an exclusive right in the name of his private house.<sup>8</sup>

Again, as in other passing-off actions, the nature of the business of the two parties will be an important factor in granting an injunction. *Nicholson & Co., Ltd. v. Buchanan*<sup>9</sup> is an illustrative case. A firm of distillers whose principal business was gin were the owners of premises known as “Black Swan Distillery” with the sign of a black swan exhibited on the front. They were also registered owners of a trade mark consisting of the picture of a black swan for spirits. The premises were sold separately from the goodwill and trade mark of the business. The purchaser of the premises, a whisky dealer whose distillery was in Scotland continued to call the premises by the old name, the old sign still

(5) *Cooper & McLeod v. MacLachan*, (1901) 18 R.P.C. 380.

(6) *The Clock, Ltd. v. The Clock House Hotel, Ltd.*, (1935) 52 R.P.C. 386.

(7) *Street v. Union Bank of Spain and England*, (1885) 30 Ch.D. 156, (similar telegraphic address). “It is settled now beyond all doubt that the mere fact that confusion may arise by the use of a name for a person’s house similar to that of his neighbour, does not give rise to any cause of action, unless it can be shown that there is resulting damage. The mere fact that a person chooses the same name, as, or a name so like the name of, his neighbour’s house that there is a great deal of inconvenience to that neighbour does not in itself give the neighbour a cause of action.” Farwell, J., in *The Clock, Ltd. v. The Clock House Hotel, Ltd.*, (1935) 52 R.P.C. at pp. 392, 393.

(8) *Day v. Brownrigg*, (1878) 10 Ch.D. 294; Seb. Dig., p. 387 (Ashford Lodge).

(9) (1902) 19 R.P.C. 321.

remaining on the premises. Action by the purchasers of the goodwill and trade mark was unsuccessful on the ground that the use of the name of premises and sign by the purchaser thereof was not calculated to deceive, the goods dealt in by the latter being of a different kind.

**Sale of premises.**—The name of a person or firm carrying on business may be carved in stone forming part of the shop or building or may be otherwise fixed to it. On removal of the business to another site the former person or firm cannot, in the absence of an agreement to that effect, compel the new occupier of the premises to erase the name from the stone. A question of this nature arose in *Townsend v. Jarman*.<sup>10</sup> In that case Farwell, J., observed: "When the shop used for the business of the old firm, . . . . was built the name E. J. Jarman was carved in stone over the door. Now, if the plaintiff was using that name E. J. Jarman as a means of trading otherwise than by allowing the carving to remain on the shop he has bought, I should certainly think that he was not entitled so to use it. . . . If a man chooses to sell a house which he has built in such a form that his name appears on that house, and he takes no covenant from the purchaser to alter the building in that respect I can see no equity whatever which will afterwards enable him so to compel the purchaser."<sup>10-a</sup>

**Goupil Gallery case.**—The law was also discussed in *Boussod, Valadon & Co. v. Marchant*.<sup>11</sup> The plaintiffs' show room in London was known as the "Goupil Gallery," and the words "Goupil Gallery" were prominently affixed over these premises in iron letters. The plaintiffs sold the premises to the defendants, and by an agreement gave them for a period of five years the exclusive right to describe themselves as sole agents to the plaintiff company. The agreement did not contain any provision as to the use of the title "Goupil Gallery." After the execution of the agreement the defendants carried on business on their own account and also as selling agents to the plaintiff company and continued to use the title the "Goupil Gallery." After the termination of the agreement the defendants continued to carry on business at the same premises using the title the "Goupil Gallery." The plaintiff company started business again on their own account in London under the same title, and brought an action to restrain the defendant from using the title. The defendants counter-claimed that

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(10) (1900) 2 Ch. 698; 17 R.P.C. 649.

(10-a) loc. cit. at pp. 663, 664.

(11) (1907) 24 R.P.C. 665; 25 R.P.C. 42.



they had the right to the exclusive use of the name "Goupil Gallery." The plaintiffs' claim was rejected by Parker, J., and an appeal was dismissed. It was held that there was no misrepresentation in the use by the defendants of the word "Goupil" and that the plaintiff company were not entitled to use the term "Goupil Gallery" without distinguishing their business clearly from the defendants' business. Fletcher-Moulton, L.J., said: "In selling these premises all such advantage in carrying on business as is due to the notoriety of the premises, under the name by which they were known, automatically passes, and is intended to pass to the purchaser. I can quite imagine that in many cases that is the most valuable part of a goodwill, and I do not think the court should hold that a purchaser is in any way going beyond his rights if he exploits to the full without misrepresentation, that which I might call the goodwill of the locality. Supposing, for instance, that the persons who owned the freehold of some noted restaurant, like the Cafe' Royal in Regent Street, were to sell the building. Supposing they sold without a covenant that they would not set up business in a way which might interfere with the business of a restaurant carried on by the purchaser on those premises, the court would hesitate to say that the purchaser might not still call it Cafe' Royal, the name by which it was known, the name fixed up on the premises, and certainly the very slightest evidence of the concurrence of both parties in this being done would render it hopeless for the vendor to seek to restrain the purchaser from obtaining this most valuable part of the purchase that he had made."

A hotel ordinarily connotes the business carried on by the person and the vendor may therefore continue his business under the same name at any other place in the absence of the sale of goodwill. In *Nizam Din v. Sher Bahadur*<sup>12</sup> the lessee rented a vacant space, built a hotel on the site, and carried on hotel business there for about 27 years under the name "Cambridge Hotel." After the expiration of the tenancy the lessee agreed to accept a certain sum "for the buildings and gardens of the Cambridge Hotel." They then commenced to carry on hotel business in new premises under the style "Cambridge Hotel," while the lessor claimed exclusive right to use this name for hotel business. It was held that the name was the property of the lessee and that the lessor did not purchase the goodwill of the defendants' business.

On the other hand, in a case<sup>13</sup> where the owner had constructed a building for purposes of use as a hotel and had rented them to different tenants for the purpose of carrying on business as hotel keepers under the name "Amritsar Hotel," it was held that this name was the property of the owner of the building.

**Summary of the law of passing-off by Kay, L.J.**—The several aspects of the law of passing off have been admirably summed up in logical sequence by Lord Justice Kay in the following passage in his judgment in *Powell v. Birmingham Vinegar Brewery Co., Ltd.*<sup>14</sup>:—

"The law relating to this subject may be stated in a few propositions:—(1) It is unlawful for a trader to pass off his goods as the goods of another. (2) Even if this is done innocently it will be restrained; *Millington v. Fox*, 3 Mylne and Craig 338. (3) *A fortiori* if done designedly, for that is a fraud. (4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal; *Sykes v. Sykes*, 3 B. & C. 451. (5) One apparent exception is that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers; *Burgess v. Burgess*, (1853) 3 De G.M. & G. 896; *Turton v. Turton*, (1889) 42 Ch.D. 128. (6) But this exception does not go far. A man may so use his own name as to infringe the rule of law. "It is a question of evidence in each case whether there is false representation or not," per Turner, L.J., *Burgess v. Burgess*, (1853) 3 De G.M. & G. 905. So he may be restrained if he associates another man with him, so that under their joint names he may pass off goods as the goods of another person; *Croft v. Day*, (1843) 7 Beavan, 84; *Clayton v. Day*, 26 Solicitors' Journal, 43; *Melachrino v. The Melachrino Egyptian Cigarette Company*, (1887) 4 R.P.C. 215. (7) Another apparent exception is where a man trading under a patent had a monopoly for 14 years and has given the article a descriptive name, he cannot when the patent has expired prevent another from selling it under that name; *Young v. Macrae*, (1862) 9 Jurist, N. S. 322; *Linoleum Co. v. Nairn*, (1878) 7 Ch.D. 834. (8) I am not sure that this would be so if the name so used were the name of the patentee, or even a

(13) *Mian Ghulam Nabi, etc. v. Nizam Din*. Unreported No. 1248 of 1906 Chief Court, Punjab referred to in *Nizam Din v. Sher Bahadur*, A.I.R. 1931 Lah. 650; 32 P.L.R. 542.

(14) (1896) 2 Ch. 54 at pp. 80, 81; 13 R.P.C. at p. 256.

purely fanciful name not descriptive. (9) Certainly where there has not been a patent, and an article has been made and sold under a fanciful name not descriptive, so that the article as made by one person has acquired reputation under that name, another trader will not be permitted to use the name for a similar article made by him; *Braham v. Bustard*, 1 H. & M. 447; *Cochrane v. MacNish*, 13 R.P.C. 100. (10) In this last proposition there is again a limitation. If the first maker has slept upon his rights, or allowed the name to be used by others until it has become *publici juris*, this court will not interfere."

## CHAPTER VII.

### RELIEF IN PASSING-OFF ACTIONS.

A plaintiff who is successful in a passing-off action may claim the following reliefs:—(1) Injunction, (2) Delivery up of goods and (3) Damages or an account of profit. Of these, the first is the most useful to the plaintiff as it prevents effectively the repetition of the acts complained of. The principles relating to the granting of these reliefs are discussed in this Chapter. A brief section is also added dealing with the rules generally followed by the courts in awarding costs in trade mark suits.

#### (i) *Injunction.*

**Specific Relief Act.**—The right to injunction in India is governed by the provisions of the Indian Specific Relief Act. Sec. 52 states that preventive relief is granted at the discretion of the Court by injunction, temporary or perpetual. Sec. 53 of the Act lays down:—

*“Temporary injunctions are such as are to continue until a specified time, or until the further order of the court. They may be granted at any period of suit, and are regulated by the Code of Civil Procedure.*

*“A perpetual injunction can only be granted by the decree made at the hearing and upon the merits of the suit; the defendant is thereby perpetually enjoined from the assertion of a right, or from the commission of an act, which would be contrary to the rights of the plaintiff.”*

Section 54 defines the circumstances when perpetual injunctions can be granted. The first paragraph lays down that “subject to the other provisions contained in, or referred to by, this Chapter, a perpetual injunction may be granted to prevent the breach of an obligation existing in favour of the applicant, whether expressly or by implication.” The second paragraph deals with cases in which obligation arises from contract while the third paragraph deals with cases where the “defendant invades or

threatens to invade the plaintiff's right to, or enjoyment of property." In the latter class of cases it is stated that the court may grant a perpetual injunction in certain specific categories of events. At the end of the third paragraph there is an explanation that "for the purposes of this section a trade mark is property" and one of the examples under this section refers to the grant of an injunction restraining infringement of a trade mark.

Section 55 deals with mandatory injunctions.

Section 56 supplements Sec. 54<sup>1</sup> and enumerates the cases where an injunction cannot be granted.<sup>2</sup>

**Relief discretionary.**—The granting of an injunction whether temporary or perpetual is a matter which is entirely within the discretion of the court. But the discretion is a judicial discretion and must be exercised on reasonable grounds and not capriciously. As Lord Mansfield observed: "Discretion, when applied to a Court of law means discretion guided by law. It must be governed by rule and not by humour. It must not be arbitrary, vague, and

(1) See *Ramkissen v. Pooran Mull*, 47 Cal. 733 (Mookerji, J.).

(2) "An injunction cannot be granted—

(a) to stay a judicial proceeding pending at the institution of the suit in which the injunction is sought, unless such restraint is necessary to prevent a multiplicity of proceedings;

\* \* \*

(e) to stay proceedings in any criminal matter;

\* \* \*

(h) to prevent a continuing breach in which the applicant has acquiesced;

(i) when equally efficacious relief can certainly be obtained by any other usual mode of proceeding except in case of breach of trust;

(j) when the conduct of the applicant or his agents has been such as to disentitle him to the assistance of the Court;

(k) where the applicant has no personal interest in the matter.

#### *Illustrations.*

(a) \* \* \*

(b) A manufactures and sells crucibles, designating them as "patent plumbago-crucibles," though, in fact, they have never been patented. B pirates the designation. A cannot obtain an injunction to restrain the piracy.

(c) A sells an article called 'Mexican Balm' stating that it is compounded of divers rare essences and has sovereign medicinal qualities. B commences to sell a similar article to which he gives a name and description such as to lead people into the belief that they are buying A's Mexican Balm. A sues B for an injunction to restrain the sale. B shows that A's 'Mexican Balm' consists of nothing but scented hog's lard. A's use of his description is not an honest one and he cannot obtain an injunction."

fanciful, but legal and regular.”<sup>3</sup> The principle is well settled, that in granting or withholding an injunction, the Courts exercise a judicial discretion, and weigh the amount of substantial mischief done or threatened to the plaintiff, and compare it with that which the injunction, if granted, would inflict upon the defendant.”<sup>4</sup> In *Tituram Mukerji v. Cohen*<sup>5</sup> the Privy Council observed: “The right to an injunction depends in India upon statute and is governed by the provisions of the Specific Relief Act. Sec. 52 of that Act places the grant of an injunction in the discretion of the court—a discretion to be exercised of course as the discretion of courts always is.”

**English authorities generally followed.**—The above rule is based on the practice of the Chancery Courts in England<sup>6</sup> where the granting of an injunction was always a matter for the discretion of the courts and was in general made only where damages could give no adequate relief.<sup>7</sup> So in the early case of *The Emperor of*

(3) Lord Mansfield in *Wilkes's case* cited in *Harbuns v. Bhairo*, (1879) 5 Cal. 259. See also Sec. 22 of the Act. “The jurisdiction to decree specific performance is discretionary and the court is not bound to grant such relief merely because it is lawful to do so; but the discretion of the court is not arbitrary but sound and reasonable, guided by judicial principles and capable of correction by a Court of Appeal.”

(4) *Shamnugger Jute Factory Co., Ltd. v. Ram Narain Chatterjee*, (1886) 14 Cal. 189.

(5) (1905) L.R. 32 I.A. 185; 33 Cal. 203; 15 M.L.J. 379. See also *Subba Naidu v. Haji Badsha Sahib*, (1902) 26 Mad. 168; 13 M.L.J. 13.

(6) See, for instance, *Land Mortgage Bank of India v. Ahmedbhoy Habibbhoy*, (1883) 8 Bom. 35, where Sarjent, C.J., observed that in applying the provisions of Sec. 54 of the Specific Relief Act the court should “do well to be guided by the decisions of the Court of Chancery in England, which it cannot be doubted are the source from which the above provisions have been drawn.” In *Shamnugger Jute Factory Co., Ltd. v. Ram Narain Chatterjee*, (1886) 14 Cal. 189, the court said: “The granting of injunctions is now regulated by Secs. 54 and 55 of the Specific Relief Act. But those sections have never been understood as introducing new principles of law into India, but rather as an attempt, to express in general terms the rules acted upon by Courts of Equity in England, and long since introduced in this country, not because they were English law, but because they were in accordance with equity and good conscience.” See also *Nusserwanji Merwanji Panday v. Gordon*, (1881) 6 Bom. 266; *Chunilal Mancharam v. Manishankar Atmaram*, (1893) 18 Bom. 616; *Ghanasham Nilkant v. Moroba Ramchandra* (1894) 18 Bom. 474; *Benode Coomaree Dossee v. Soudaminy Dossee*, (1889) 16 Cal. 252.

(7) “The very first principle of injunction law is that you do not obtain injunctions for actionable wrongs for which damages are the proper remedy.” *London and Blackwall Railway Co. v. Cross*, (1886) 31 Ch.D. 354. (Lindley, L.J.).

*Austria v. Day and Kossuth*<sup>8</sup> Lord Campbell said: "I consider that this court has jurisdiction to protect property from an act threatened, which, if completed, would give a right of action. I by no means say that in every such case an injunction may be demanded as of right, but if the party applying is free from blame, and promptly applies for relief, and shows that by the threatened wrong his property would be so injured that an action for damages would be no adequate redress, the injunction will be granted."

**When not binding.**—There is, however, a slight departure in the Indian Specific Relief Act from the general principles followed by the Chancery Courts in England in the matter of granting injunctions.<sup>9</sup> According to Secs. 54 and 56 the inadequacy of the relief in damages is the determining factor for granting an injunction by the Indian courts, and the question therefore presents itself in a different light from what it does to the English courts where injunction is regarded as the *prima facie* right of the injured party.<sup>10</sup> The position was explained by Shephard, C.J., in *Boyson v. Deane*<sup>11</sup> in the following passage:—"The question must be decided with reference to the tests prescribed in Sec. 54 of the Specific Relief Act. Assuming that the plaintiffs are entitled to compensation, the court may grant a perpetual injunction in respect of an invasion of a right to, or enjoyment of, property when the invasion is such that pecuniary compensation would not afford adequate relief." . . . "If I may take *Martin v. Price*<sup>12</sup> as a statement of English law on the subject I think it must be admitted that it is different from the law we have to

(8) (1861) 3 De G. F. & J. 217; 45 E.R. 861; Seb. Dig., p. 109.

(9) *Callianji Harjivan v. Narsi Tricoum*, (1894) 18 Bom. 702 at 714.

(10) See, for instance, *Fullwood v. Fullwood*, (1878) 9 Ch.D. 178, where Fry, J., said: "The injunction is, in my opinion a matter of course, if the legal right be proved to exist." In re *Aynsley*, L.R. 18 Eq. 544, Jessel, M.R., observed "that wherever an action can be maintained at law and really substantial damages . . . can be recovered at law there the injunction ought to follow in equity."

(11) (1899) 22 Mad. 251. See also *Dhunjibhoy Cowasji Umrigar v. Lisboa*, (1888) 13 Bom. 252; *Ghanasham Nilkant v. Moroba Ramchandra*, (1894) 18 Bom. 474; *Ausam Ismail v. Jaganath Jamnadas*, (1925) 3 Rang. 230; A.I.R. 1925 Rang. 327. In *Sultan Nawas v. Eustomji*, (1896) 20 Bom. 704, Parsons, J., said: "That an injunction will only be granted where the invasion of the right or enjoyment is such that pecuniary compensation would not afford adequate relief is a correct interpretation of Sec. 54 of the Specific Relief Act which lays down the law binding on the courts in this country. To courts subject to that Act the English decisions cited have no application."

(12) (1894) 1 Ch. 276.

administer here under Specific Relief Act. . . . In *Martin v. Price*, Kekewich, J., having regard among other things, to the term for which plaintiff held, gave judgment for £120 and refused an injunction. The Court of Appeal held that as the plaintiff had sustained material injury he was entitled to an injunction in the absence of proof of circumstances depriving him of the *prima facie* right. No reference was made to the test prescribed by the Specific Relief Act. According to that decision the rule of English law is the converse of the rule prevailing here. There the right to an injunction is a *prima facie* right; here an injunction is not to be given when the remedy in damages is considered as adequate. For a statement of the law in terms more consonant with that which we have to administer I would refer to Lord Westbury's judgment in *Jackson v. Duke of Newcastle*.<sup>13</sup> This case decided in 1864, has with reference to another point, been disapproved in later cases. With regard to that other point the Indian legislature seems to have followed it nevertheless, and it may well have been present to their minds when the Specific Relief Act was being framed."

**Granting of injunction in passing-off actions.**—As regards passing-off actions, however, the Indian courts have closely followed the English law in granting injunctions. An action for passing off is regarded as a *quia timet* action, that is, the Court assists the plaintiff because of the fear of probability of injury to his business in the future. The requirements for obtaining an injunction in a passing-off action and the circumstances when such relief may be granted or refused are set forth in detail in Chapter VI. In every case the court must be satisfied that there had been actual or threatened<sup>14</sup> injury to the plaintiff's business by the defendant's unfair competition, that there is a reasonable probability that the infringement of the plaintiff's trade mark will be continued or repeated,<sup>15</sup> and that the apprehended damage will, if it comes, be substantial, if not irreparable.<sup>16</sup> Injunction will not, therefore, be granted where there have been a few isolated instances of passing-

(13) (1864) 3 De G. J. & S. 275; 46 E.R. 642.

(14) "The life of a trade mark depends upon the promptitude with which it is vindicated," *Johnston v. Orr-Ewing*, (1882) 7 App. Cas. 219.

(15) *C. C. Wakefield & Co., Ltd. v. Purser*, (1934) 51 R.P.C. 167. In *Samuelson v. Producers Distributing Co., Ltd.*, (1931) 48 R.P.C. 447, an injunction was refused but an inquiry as to damages was allowed.

(16) *Fletcher v. Bealey*, (1885) 28 Ch.D. 688. See also *Shankar Roy Chowdhury v. Cetton*, A.I.R. 1925 Cal. 373; 40 C.L.J. 515; *Pandurang v. Bayaja*, A.I.R. 1925 Nag. 251; 20 N.L.R. 106; *Gangabai v. Purshotam Atmaram*, (1907) 32 Bom. 146.



off without any likelihood of the recurrence thereof, or where the damage is trivial or remote.<sup>17</sup>

The circumstances which would justify the granting or refusal of an injunction as the case may be were clearly set forth by Lord Chancellor Herschell in his judgment in the 2-D case.<sup>18</sup> "Where it is shown that a trader has been falsely passing-off his goods as those of a rival trader the court apprehends that one who has done a wrongful act of that description may repeat it, and therefore it does not leave the plaintiff to his remedy by an action for damages, but by an injunction restrains the defendant from repeating the act, in order that if he does repeat it there may be a speedy and effectual remedy without the necessity of a fresh action being brought. My Lords, when once the reason for an injunction is shown to rest upon that basis it seems to me that you must look in each case to the circumstances to see whether an injunction would be proper. Supposing that the manager of a business has been pursuing a wrongful course of this description, and that the manager still continues to be the manager, I can understand the court saying that in that case an injunction ought to be granted, even although the principal himself was ignorant of the fraudulent conduct. Supposing, on the other hand, that the manager had been dismissed in consequence of the act which he had done (I am not saying that that would be necessarily the only test, but it would be an element to be taken into account), the court might well think that under the circumstances it was neither necessary, nor right to grant an injunction, because there was no reason to suppose that the defendant who had so acted would be in the least likely so to act again, or, if, without being dismissed, the manager had ceased to be in the employment of the defendant, upon whom there was no ground for any imputation or suggestion that he was likely to commit the wrongful act, then I can understand the court saying that it was not a case in which an injunction ought to be granted. Nor are those the only elements to be taken into account. In the present case the transaction complained of is an isolated transaction, which is attributed to a shopman in the employment of the defendant, in a single act of sale, led on by the mode in which she was addressed by the witnesses. She has ceased to be in the defendant's employment; and under those circumstances it seems to me

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(17) *Armstrong Oiler Co., Ltd. v. Patent Axlebox and Foundry Co., Ltd.*, (1910) 27 R.P.C. 362; *Rutter & Co. v. Smith*, (1901) 18 R.P.C. 49; *Samuelson v. Producers Distributing Co., Ltd.*, (1931) 48 R.P.C. 447.

(18) *Leahy, Kelly & Leahy v. Glover*, (1893) 10 R.P.C. 141.

that it would be, I was going to say monstrous, to enjoin the defendant from doing acts which there is not the slightest ground for supposing he is ever likely to do, inasmuch as he has not in this action, nor at any time, set up any claim to them, insisted upon any right to do them, or done any act which renders it in the least likely that in the future he will do them. Now my Lords, under these circumstances it appears to me that, assuming the case were established with regard to that one transaction, it does not support the claim of the plaintiffs to an injunction as of right against the defendant."

**Acquiescence.**—Cl. (h) of Sec. 56 of the Specific Relief Act lays down that an injunction cannot be granted "to prevent a continuing breach in which the applicant has acquiesced." A plaintiff who becomes aware of the infringement of his rights cannot stand by deliberately with the object of encouraging the infringer to expend money so that he may ultimately reap the benefit of the defendants' acts. The doctrine of acquiescence may be stated thus: Where a person having a right finds that another is about to commit or is in the course of committing an act infringing on his right and still abstains from asserting his right, which would lead to the inference that he is a consenting party to the infringement, he cannot afterwards complain of the act. But a mere non-interference on the part of the plaintiff is not enough to constitute acquiescence. In order to deprive the plaintiff of his legal right the acquiescence must amount to a fraud. Where the acquiescence is not sufficient to bar entirely the plaintiff's legal right the court may refuse an injunction though it may order damages.

**Delay.**—Injunction will also be refused where the party seeking relief has not shown sufficient diligence in prosecuting his claim after the infringement of his right had come to his knowledge. This doctrine is based on the well-known maxim that equity aids the vigilant, and not those who sleep on their rights. Inordinate delay in asserting one's right unless satisfactorily explained will thus be a bar to the granting of an injunction.<sup>19</sup> In India the

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(19) In *G. C. Varcados v. D. C. McLeod*, (1918) 45 P.R. 1919; 51 I.C. 434, the plaintiff's suit was dismissed on the ground that he came to know of the alleged infringement in 1909 but failed to sue till June, 1914. In *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461, injunction to restrain the defendant from using the words "Kareem beedies" was not allowed, as the plaintiff abstained from bringing the suit for eight years after becoming aware of the infringement of his mark by the defendant.

period of limitation in a suit for an injunction to restrain the infringement of a trade mark is prescribed by Art. 120 of Sch. II of the Indian Limitation Act<sup>20</sup> as six years from the date of infringement, while for a suit for compensation the period of limitation is three years.<sup>21</sup>

**Not granted where equally efficacious remedy is available.—**

Cl. (i) of Sec. 56 of the Specific Relief Act lays down that an injunction cannot be granted “when equally efficacious relief can certainly be obtained by any other usual mode of proceeding.” Thus, an injunction will be refused in cases where the court considers that relief in the form of damages would be adequate. This point has already been dealt with in comparing the Indian law with that in England. Whether in a particular case pecuniary compensation would be as efficacious as an injunction will depend upon the facts of the case and the court will consider all the circumstances in exercising its judicial discretion to granting or refusing an injunction. In this connection it may be pointed out that Sec. 54 of the Act lays down that an injunction will be the proper remedy where there exists no standard for ascertaining the actual damage, or where it is probable that pecuniary compensation cannot be obtained from the defendant, or where, notwithstanding repeated verdicts at law, there would be a multiplicity of judicial proceedings owing to the probability of the infringement being vexaciously persisted in.

**Conduct of the plaintiff.**—As injunction is an equitable relief it is incumbent on the plaintiff to come to the court with clean hands. The principle is laid down in Cl. (j) of Sec. 56 of the Specific Relief Act which states that an injunction should not be granted where the conduct of the plaintiff has been such as to disentitle him to the assistance of the court. “This rule rests on the maxim that ‘he who seeks equity must do equity,’ and implies that a plaintiff seeking an injunction must come with clean hands. With reference to this point, it is laid down in *Kerr on Injunctions*, on the authority of the case therein cited, that a plaintiff, who asks for an injunction, must be able to satisfy the court that his own acts and dealings in the matter have been fair and honest and free from any taint of fraud or illegality, and that if, in his dealings with the person against whom he seeks relief, or with third parties, he has acted in an unfair or inequitable manner, he

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(20) *Aga Mahmood v. Edward Peltzer*, (1903) 2 L.B.R. 113.

(21) Art. 113 of the Limitation Act.

cannot have relief.”<sup>22</sup> Thus, in *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.*,<sup>23</sup> the plaintiffs, on becoming aware that the defendants had received a small consignment of the infringing goods, did not take action immediately, but waited for the arrival of a larger quantity of such goods and then filed a suit for passing off. Vice-Chancellor Malins ordered that the injunction should not extend to the goods already arrived and should be limited to the sale of future consignments only. And, in *Abdul Cadar v. Mahamadally*,<sup>24</sup> where the plaintiff deliberately combined the labels of some of his rivals with the object of passing off his goods for theirs it was held that he was not entitled to an injunction restraining some other person from imitating his label.

It follows from the above rule that a trade mark containing a false claim of patent rights will not be entitled to protection. As Jessel, M.R., said: “No man can claim a trade mark in a falsehood.”<sup>25</sup> Again, in the *Leather Cloth Case*,<sup>1</sup> Lord Kingsdown observed: “If a trade mark represents an article as protected by a patent when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade mark to relief in a Court of Equity against any one who pirated it.” Illustration (b) given under Sec. 56 of the Specific Relief Act refers to such a case and is based on *Morgan v. McAdam*.<sup>2</sup> In that case the plaintiffs who sold their crucibles as “Patent Plumbago Crucibles” although the crucibles were never the subject of a patent, brought an action against the defendants for restraining them from selling their crucibles under the same name. In refusing an injunction Wood, V.C., said: “All that this court has to determine is, has the plaintiff who comes here to seek relief, any ground whatever for asking the court to assist him in the protection of that right which he sets up? If the court finds it to be a right founded upon fraud, the court says it cannot assist a person in carrying on a fraud.” Illustration (c) under the same

(22) *Per Subramania Iyer, J.*, in *Seeni Chettiar v. Santhanathan Chettiar*, (1896) 20 Mad. 58; 6 M.L.J. 281 (F.B.).

(23) W. N. (1871) 163; Seb. Dig., p. 222.

(24) (1901) 3 Bom.L.R. 220.

(25) *Cheavin v. Walker*, (1877) 5 Ch.D., p. 862.

(1) *Leather Cloth Co., Ltd. v. American Leather Cloth Co., Ltd.*, (1865) 11 E.R. 1435; 11 H.L.C. 523; 35 L.J. Ch. 53.

(2) (1866) 36 L.J.Ch. 228; 15 L.T. 348; Seb. Dig., p. 159.

section is obviously based on the case *Perry v. Truefitt*,<sup>3</sup> in which Lord Langdale refused to grant an injunction on the ground of misrepresentation contained in the plaintiff's trade circulars and show cards as to the composition of the substance sold.

**Temporary or interlocutory injunctions.**—Temporary injunctions are granted under Order 39 of the Civil Procedure Code. Rule 1 says that where in any suit it is proved (a) "that any property in dispute in a suit is in danger of being wasted, damaged or alienated by any party to the suit, or wrongfully sold in execution of a decree, or (b) that the defendant threatens, or intends to remove or dispose of his property with a view to defraud his creditors, the court may by order grant a temporary injunction to restrain such act" until the disposal of the suit or until further orders. Rule 2 reads:—

"(1) In any suit for restraining the defendant from committing a breach of contract or other injury of any kind, whether compensation is claimed in the suit or not, the plaintiff may, at any time after the commencement of the suit, and either before or after judgment, apply to the court for a temporary injunction to restrain the defendant from committing the breach of contract or injury complained of, or any breach of contract or injury of a like kind arising out of the same contract or relating to the same property or right.

(2) The court may by order grant such injunction, on such terms as to the duration of the injunction, keeping an account, giving security, or otherwise, as the court thinks fit."

Clauses (3) and (4) of Rule 2 relate to breach of an injunction. Rules 3 to 5 deal with procedure and Rules 6 to 10 with interlocutory orders.<sup>4</sup>

(3) (1842) 6 Beav. 66; 49 E.R. 749.

(4) Clause 3 of Rule 2 says:—

"In case of disobedience or breach of any such terms the court granting an injunction may order the property of the person guilty of such disobedience or breach to be attached, and may also order such person to be detained in the civil prison for a term not exceeding six months, unless in the meantime the court directs his release."

Clause 4:—

"No attachment under this rule shall remain in force for more than one year, at the end of which time, if the disobedience or breach continues, the property attached may be sold, and out of the proceeds the court may award such compensation as it thinks fit, and shall pay the balance, if any to the party entitled thereto."

**Prima facie right to injunction must be shown.**—A few of the general principles governing the granting of temporary injunctions may be considered here.<sup>5</sup> It is clear from the above rules that a temporary injunction is merely of a provisional nature and does not conclude the rights of the parties in any way. The object of an interim injunction is to preserve the property under dispute in *status quo* during the pendency of the suit so that if the plaintiff is successful when the case is decided on its merits the defendant will have been prevented in the meantime from dealing with the property in such a way as to make the subsequent judgment ineffectual. Temporary injunctions will therefore be issued only in very clear cases, and the court's discretion in this matter will be exercised with very great caution.<sup>6</sup> The plaintiff must make out a *prima facie* case for the interim injunction by adducing evidence to show that he will in all probability succeed in the action.<sup>7</sup> This does not mean, however, that the court should examine in detail the facts of the case and anticipate or prejudice the verdict which might be pronounced after the hearing of the

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Rule 3 states—

“the court shall in all cases, except where it appears that the object of granting the injunction would be defeated by the delay, before granting an injunction, direct notice of the application for the same to be given to the opposite party.”

Rule 4 gives power to the court to discharge, vary, or set aside, any order for an injunction on application made by any party dissatisfied with such order.

Rule 5 states that “an injunction directed to a Corporation is binding not only on the Corporation itself, but also on the members and officers of the Corporation whose personal action it seeks to restrain.”

Rules 6 and 7 deal with the power of the court to order an interim sale and to pass an order for the detention, preservation or inspection of property, while Rule 8 states that an application for an order under the above two rules may be made during the pendency of the suit by either party after giving notice to the other.

(5) “Apart from the special circumstances which determine whether the Court should in its discretion grant an injunction before the hearing of the suit, the same general principles must equally apply to the granting of a temporary injunction as to a perpetual injunction, and those principles must, therefore, be sought in the Specific Relief Act itself.” Sarjant, C.J., in *Nusserwanji Merwanji v. Gordon*, (1881) 6 Bom. 266. See also *Subba Naidu v. Haji Badsha Sahib*, (1902) 26 Mad. 168; 13 M.L.J. 13.

(6) The court will grant an interlocutory injunction if it can see that there is a probability that plaintiff will succeed at the trial of the action, in order to keep things in *status quo*. *Warner v. Warner*, (1889) 5 T.L.R. 359 (Cotton, L.J.). The court will not interfere by interlocutory injunction except in strong cases, *Motley v. Downman*, (1837) 3 My. & Cr. 1; 40 E.R. 824.

(7) *Warner v. Warner*, (1889) 5 T.L.R. 359 (Cotton, L.J.); *Colman (J. & J.), Ltd. v. Farrow & Co.*, (1898) 15 R.P.C. 198.

suit.<sup>8</sup> If fraudulent intention on the part of the defendant is shown it will no doubt be easier to obtain an injunction.<sup>9</sup> Thus, in *International Plasmon, Ltd. v. Plasmonade, Ltd.*,<sup>10</sup> where it was proved that the defendants had deliberately attempted to steal the plaintiffs' trade name an interlocutory injunction was granted. But, where there is reasonable doubt about the plaintiff's legal right, or where the evidence adduced by the parties shows on the face of it that the case is not a fit one for a perpetual injunction, the court will refuse to grant a temporary injunction.<sup>11</sup> For, the effect of the injunction in such cases will be to cause a great injury to the defendant if the court finds ultimately that the defendant's claim to the mark is just and lawful. So, where a *prima facie* case of concurrent right is shown by the defendant,<sup>12</sup> or where the defendant has joint interests<sup>13</sup> with the plaintiffs, a temporary injunction will not be issued.

**Injury must be imminent.**—The claim to a temporary injunction is based on the ground that unless the defendant is restrained forthwith from committing the act complained of substantial or irreparable injury may result to the plaintiff before the suit is decided on its merits. The plaintiff must, therefore, make out a very strong case that there is very reasonable probability, though not amounting to an absolute certainty, that the defendant's act would materially injure his business and that such danger is imminent.<sup>14</sup> He must show that the refusal of the

(8) *Smidt (John) v. Reddaway & Co.*, 32 Cal. 401; 9 C.W.N. 281; *Upendra Nath Brahmachari v. Union Drug Co., Ltd.*, A.I.R. 1926 Cal. 837; 43 C.L.J. 405; *Danish Dairies Milk Export v. Murlidhar & Co.*, A.I.R. 1932 Sind 84; 26 S.L.R. 51.

(9) *Radde v. Norman*, (1872) L.R. 14 Eq. 348; *Colman (J. & J.), Ltd. v. Farrow & Co.*, (1898) 15 R.P.C. 198.

(10) (1905) 22 R.P.C. 543.

(11) *Purser v. Brain*, (1848) 17 L.J.Ch. 141. See *Upper Assam Tea Co. v. Herbert & Co.*, (1890) 7 B.P.C. 183; *Moseley & Sons, Ltd. v. Nathan & Co.*, 23 B.P.C. 345; *Fine Cotton Spinners and Doublers' Association, Ltd., and J. Cash & Sons, Ltd. v. Harwood Cash & Co., Ltd.*, (1907) 2 Ch. 184; 24 R.P.C. 533; *Peters, Ltd. v. Domestic Inventions Co.* (1908) 25 R.P.C. 387; *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R.P.C. 189.

(12) *General Reversionary Investment Co. v. General Reversionary Co., Ltd.*, Empire Digest, Vol. 43, p. 332; *Hayward Bros., Ltd. v. Peakall*, (1909) 26 R.P.C. 89 (Defendant's claim for concurrent user was not established and injunction was granted).

(13) *Adolph Frankau & Co., Ltd. v. Pflueger*, (1909) 26 R.P.C. 741.

(14) *Earl of Ripon v. Hobart*, 3 My. & K. 169; 40 E.R. 65; 3 L.J.Ch. 45; *Ramjas Agarwala v. Brajo Mohan Singh*, (1914) 19 C.W.N. 887;

temporary injunction would inevitably result in the violation of his right, and that the anticipated injury would not be adequately reparable by damages. But the injury need not be beyond the possibility of pecuniary compensation. A temporary injunction may be granted where it is shown that the anticipated injury would be very large or would be of such extent and frequent occurrence that it would be very difficult to obtain fair and reasonable redress. In extreme cases where it is clearly shown that the defendant is committing gross fraud and that he is likely to sell all the spurious goods if he is given notice of the motion, a temporary injunction may be granted *ex parte* till the motion comes before the court.<sup>15</sup>

**Balance of inconvenience.**—Where the plaintiff's claim for a temporary injunction is disputed the court will be guided by the balance of inconvenience caused to either party in the event of success. A temporary injunction will be granted if the court finds that, on the one hand, a great injury might result to the plaintiff by withholding the injunction, while, on the other hand, any injury which is likely to be caused to the defendant by the injunction can be easily compensated by damages in case he is ultimately successful in the suit. For instance, where the plaintiff's trade is considerable and the defendant's business is just commenced, small or negligible a temporary injunction may easily be granted.<sup>16</sup> So, in *Read v. Richardson*,<sup>17</sup> although the plaintiffs as well as the defendants had registered the trade mark in question, interlocutory injunction was granted by the Court of Appeal on the ground that, as the defendants had only recently started business while the plaintiffs' business was large, the refusal of a temporary injunction would cause great injury to the plaintiffs if their claim was upheld on trial. And in *Ralli v. Fleming*<sup>18</sup> where

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27 I.C. 244; *Attorney-General v. Manchester Corporation*, (1893) 2 Ch. 87; *Attorney-General v. Nottingham Corporation*, (1904) 1 Ch. 673.

(15) *Blacklock (Henry) & Co., Ltd. v. Bradshaw's Publishing Co.*, (1926) 43 R.P.C. 97.

(16) *Apollinaris Co. v. Herrfeldt*, (1887) 4 R.P.C. 478; *Thompson v. Müller*, (1896) 13 R.P.C. 35; *Aplin & Barrett v. Richards*, (1903) 20 R.P.C. 799; *Van Oppen & Co., Ltd. v. Leonard Van Oppen*, (1903) 20 R.P.C. 617; *Upendra Nath Brahmachari v. Union Drug Co., Ltd.*, A.I.R. 1926 Cal. 837; 43 C.L.J. 405; *Ebrahim Currim & Sons v. Abdulla Saheb*, A.I.R. 1934 Mad. 226; 65 M.L.J. 617; *Alaska Packers' Association v. Crooks & Co.*, (1899) 16 R.P.C. 503; *C. & A. Modes, Ltd. v. Central Purchasing Association, Ltd.*, (1931) 48 R.P.C. 163.

(17) 45 L.T. (N.S.) 54.

(18) (1898) 3 Cal. 417. See also *Ebrahim Currim & Sons v. Abdulla Saheb*, A.I.R. 1934 Mad. 226; 65 M.L.J. 617.



the defendants agreed to keep an account of their sales until the hearing and prayed for the dissolution of the interlocutory injunction the court declined to allow the prayer. Garth, C. J., observed: "In this particular case I do not think that their keeping an account of sales would be a sufficient protection to the plaintiffs, because if the defendants were allowed to use these marks in the market for several months in order to sell their cloth, they would become as well-known in the market as importers and sellers of the cloth as the plaintiffs; and so the very mischief which the injunction is intended to guard against would have been effected." Where a temporary injunction is granted the court may require the plaintiff to indemnify against any damage which the defendant may suffer on that account in the event of the legal right being determined in favour of the latter.<sup>19</sup>

A temporary injunction will not, however, be granted where the court is of opinion that the injunction will inflict great hardship on the defendant while no serious loss is likely to be suffered by the plaintiff, if the granting of the injunction is left over till the decree in the suit is passed. So, where the defendant's trade is large and where the harm done to his business is likely to be incalculable by the injunction if he succeeds in the suit the court may refuse to grant the interim injunction but may require the defendant to undertake to keep an account during the pendency of the trial. Thus, in *Yoshimi Boshaka Ka Sha, Ltd. v. Dwarkadas Fatehchand*,<sup>20</sup> the learned Judge observed: "If I were to issue a temporary injunction now I would practically be ruining their (defendants) trade, which cannot be compensated in the event of the suit failing. But, on the other hand, if the plaintiffs continue to sell their grey shirtings with their 'Asahi' trade mark they will suffer no such consequences. If their sales are adversely affected in consequence of this competition they can easily be compensated and therefore it will be sufficient if, while refusing the temporary injunction, I order the defendants to submit accounts of their sales in Court once every three months and also give security in the sum of Rs. 5,000 to make good any loss which the plaintiffs may be held entitled to recover both before and after suit in the event of their succeeding in the suit."

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(19) See, for instance, *Danish Dairies Milk Export v. Murlidhar & Co.*, A.I.R. 1932 Sind 84; 26 S.L.R. 51.

(20) 26 S.L.R. 335. See also *Harichand Anand & Co. v. Singer Manufacturing Co.*, A.I.R. 1933 Lah. 1046, where a similar order was passed.

The onus is thrown on the plaintiff to show that the inconvenience likely to be caused to him by the refusal of the temporary injunction outweighs the possible inconvenience to the defendant by the granting of the injunction, in case the latter ultimately succeeds in the action. Where the court is not satisfied that the infringement is likely to be recommenced, or where the possible injury is small, the court will not grant a temporary injunction.

**Delay fatal to temporary injunction.**—The essence of an application for interlocutory injunction is that it should be made with promptness. Improper delay, though not amounting to acquiescence, may often deprive a plaintiff of his right to an interlocutory injunction. Thus, in *Yoshimi Boshaka Ka Sha, Ltd. v. Dwarkadas Fatehchand*,<sup>21</sup> where there was a delay of over three years in filing the suit after the discovery of the alleged infringement an application for interlocutory injunction was rejected on the ground of delay. Interlocutory injunction was similarly refused in *Yost Typewriter Co., Ltd. v. Typewriter Exchange Co.*,<sup>22</sup> on the ground that the acts complained of had been going on for five years to the knowledge of the plaintiffs. But where the defendant's conduct is held to be a gross fraud on the public an interlocutory injunction may be granted in spite of a certain amount of delay.<sup>23</sup>

In *Unani Dawakhana v. Hamdard Dawakhana*<sup>24</sup> the plaintiff showed that he had served the defendants with notices in 1918 calling upon them to discontinue selling "Sharbat Ruh Afza" and that the appellant had so desisted but had resumed infringing the plaintiff's trade mark in 1923. It was contended that the plaintiff had lost the right to an injunction on account of delay in bringing the suit. But it was held that as the plaintiff had instituted the suit a few months after the defendants had resumed the manufacture and sale, at any rate, on a considerable scale, of the goods complained of, there was not such delay in filing the suit as to disentitle the plaintiff to relief.

(21) (1932) 26 S.L.R. 335. See observations of Cozens-Hardy, M. R., in *Sherwell v. Combined Incandescent Mantles Syndicate, Ltd.*, (1907) W.N. 211, cited in the above case.

(22) 19 R.P.C. 422. See also *Isaacson v. Thompson*, (1872) 41 L.J.Ch. 101; *Van Oppen & Co., Ltd. v. Van Oppen*, (1903) 20 R.P.C. 617; *Royal Warrant Holders' Association v. Slade & Co., Ltd.*, (1908) 25 R.P.C. 245.

(23) *Gillette Safety Razor Co. v. Diamond Edge, Ltd.*, (1926) 43 R.P.C. 310.

(24) A.I.R. 1930 Lah. 999.

Where the delay is short and satisfactorily explained an interlocutory injunction may be granted. Thus, in *Army and Navy Co-operative Society, Ltd. v. Army Navy and Civil Service Co-operative Society of South Africa, Ltd.*,<sup>25</sup> where the plaintiffs moved for an interlocutory injunction to restrain the defendants from carrying on business under that name, it was held that the delay of three months since the incorporation of the company was sufficiently explained and an interlocutory injunction was granted. Buckley, J., (later Lord Wrenbury) said: "The plaintiffs not being in a hurry, thought probably the thing would come to nothing, and did not take steps at that time; they did not want to rush into litigation." Similarly, in *Hayward Bros., Ltd. v. Peakall*,<sup>1</sup> where delay on the part of the plaintiffs was alleged as defence to the motion for an interlocutory injunction it was held that the delay was satisfactorily explained and the right of the plaintiffs to relief was not barred. And, in *C. & A. Modes, Ltd. v. Central Purchasing Association, Ltd.*,<sup>2</sup> Humphreys, J., observed that the plaintiffs were justified in waiting for three months to see whether the defendants' business was going to interfere with theirs and to obtain evidence of a few cases of actual deception.

**Duration of the temporary injunction.**—A temporary injunction may be granted until the disposal of the suit or until further orders of the court. In the latter case if the injunction is not dissolved pending the suit it will come to an end when the decree is passed. It has been held that once a suit has been dismissed, the court dismissing it cannot grant a further temporary injunction, as the suit is no longer pending before that court.<sup>3</sup> But if an appeal has been preferred against the decree the appellate court may at its discretion grant a fresh temporary injunction.<sup>4</sup>

**Form of injunction.**—Forms of injunctions in some typical passing-off actions are given in Appendix XIX. It will be seen

(25) (1902) 19 B.P.C. 574. See also *Kodak, Ltd. v. Thomas Illingworth & Co., Ltd.*, (1926) 43 B.P.C. 33.

(1) (1909) 26 B.P.C. 89.

(2) (1931) 48 B.P.C. at p. 165.

(3) *Shaikh Moheesooddeen v. Shaikh Ahmad Hossein*, (1870) 14 W.R. 384; *Gossain Money Pures v. Gour Pershad Singh*, (1884) 11 Cal. 146.

(4) *Gossain Money Pures v. Gour Pershad Singh*, (1884) 11 Cal. 146. Temporary injunction not granted in *Chandoo Bibi's Petition*, (1903) 26 All. 311.

that the injunction is generally to restrain the defendant from using the plaintiff's mark or a colourable imitation of the same on goods not of the plaintiff's manufacture, or from otherwise passing off his goods as the plaintiff's.<sup>5</sup> In the case of a descriptive mark which has acquired secondary signification the defendant will be restrained generally not from using the mark absolutely but only from using it in such manner as is calculated to deceive the public. In such cases the form of injunction granted by Lord Chancellor Cranworth in *Seixo v. Provezende* has been held to be the proper form.<sup>6</sup> The injunction in that case was to restrain the defendant from employing any marks or words so contrived as to represent or induce the belief that his goods are the goods of the plaintiff or otherwise using the plaintiff's mark *without clearly distinguishing the same* from the goods of the plaintiff. In very exceptional cases even where a mark is descriptive the court may in view of the special circumstances grant an injunction restraining the defendant absolutely from using the word or mark.<sup>7</sup> It is generally advantageous to the plaintiff to mention in the statement of claim the exact nature of the infringement and the form in which the injunction is prayed for. The court will not, however, lay down a course of conduct for a defendant.<sup>8</sup> Where the goods passed off are protected by an existing patent the injunction will be limited to the duration of the patent.<sup>9</sup>

(ii) *Delivery up of marked goods.*

Besides an injunction, a plaintiff who is successful in a passing-off action is entitled to a delivery up of possession of all the labels held to be calculated to deceive, and of the spuriously marked goods for erasure of the mark, and if erasure is impossible, for their destruction.

(5) *Seixo v. Provezende*, (1866) L.R. 1 Ch. 192.

(6) (1866) 1 Ch. 192; See *Reddaway v. Banham*, (1896) A.C. 199; 13 R.P.C. 218; *Montgomery v. Thompson*, (1891) A.C. 217; 8 R.P.C. 361.

(7) *Wotherspoon v. Currie*, (1872) 5 H.L. p. 523.

(8) *Kerfoot v. E. A. Cooper, Ltd.*, (1908) 25 R.P.C. 508, (Eve, J.); *C. & A. Modes, Ltd. v. Central Purchasing Association, Ltd.*, (1930) 48 R.P.C. at p. 165 (Humphreys, J.). "It is not for me sitting here as the judge of particular marks and tickets, to say whether the proposed alterations were or were not reasonable or to decide what exact alterations would be necessary to prevent all likelihood of deception." per Crouch, A. J. C., in *Macdonald & Co. v. Holland & Moss*, (1914) 10 S.L.R. 175; 41 I.C. 539.

(9) *Parker and Smith v. Satchwell & Co., Ltd.*, (1901) 18 R.P.C. 299; 45 Sol. Jo. 502.

**Erasure of the mark.**—Where an order for delivery up is made the court will, generally, restrict the order to the erasure of the offending mark on the goods to the satisfaction of the plaintiff. Thus, in *Dent v. Turpin*,<sup>10</sup> where the defendant had infringed the plaintiff's trade mark "Dent, London" on watches it was held that without averring special damage the plaintiff might sue for delivery up of the falsely marked articles for erasure. In *Slazenger & Sons v. Feltham & Co.*,<sup>11</sup> where the defendants had infringed the plaintiffs' trade mark, "The Demon," by selling racquets exactly like the plaintiffs' with the words "Demotic" stamped where the plaintiffs had stamped "The Demon," the Court of Appeal ordered that the racquets need not be destroyed, that the false mark "Demotic" should be satisfactorily erased in the presence of the plaintiffs or their agent, and that an affidavit should be filed by the defendants verifying the number of racquets in their possession on which the offending mark was stamped. And, in another case,<sup>12</sup> a deceptive stamp impressed on a cork was ordered by the court to be removed from the corks in actual use in bottles.

In *The Swadeshi Mills Co. v. Juggilal Kamalapat Cotton Spinning and Weaving Mills Co., Ltd.*<sup>13</sup> Mears, C.J., passed orders in the following terms:—"In view of the immense quantity of the goods in the possession of the defendants, which bear one or more of the infringing marks, and of the practical difficulties attendant upon requiring these goods to be delivered to an officer of this court we (with the consent of the counsel for the plaintiffs) order the defendants to remove or erase each and all of the said infringing marks from all cloths and individual garments in their possession. This work is to be completed by the 17th of July, 1926, on or before which date Mr. Kamalapat and his son Mr. Padampat are to make a joint affidavit stating that this has been done and expressing their willingness to give the plaintiffs or an officer of this court inspection of their goods at their premises should the plaintiffs so desire. If this is done, an order for the delivery of the goods for

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(10) (1861) 2 John & H. 139; 70 E.R. 1003.

(11) (1889) 6 R.P.C. 531; 5 T.L.R. 365.

(12) *Army & Navy Co-operative Society, Ltd. v. Army, Navy and Civil Service Co-operative Society of India, Ltd.*, (1891) 8 R.P.C. 426. In *Ponsardin v. Peto*, (1863) 55 E.R. 518; 33 Beav. 642, Romilly, M.R., held that the wine which was spuriously marked with the plaintiff's mark could on its being recorked be delivered to the applicant who had advanced money for the wine in ignorance of the spuriousness of the marks.

(13) (1926) 49 All. 92.

the delivery of the goods for the purpose of removal and erasure of the offending marks may be avoided. The defendants are to deliver within fourteen days to the Registrar of this court the remaining balance of 2,62,590 coloured lotus flower labels now in their possession."

**Delivery up of goods.**—The courts will not, therefore, order unnecessary destruction of goods.<sup>14</sup> But where the false marks cannot be removed in a satisfactory manner delivery up or destruction of the spurious goods will be ordered. In *Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd.*,<sup>15</sup> Neville, J., held that the defendants' use of the name 'Warwick' in connection with the sale of motor tyres would be calculated to mislead people to believe that such tyres were of the same make as the plaintiffs' well-known "Warwick" tyres for cycles and motor cycles. An injunction was granted with costs, and an order was passed for delivery-up or destruction of the spurious tyres and advertisements in the possession of the defendants. In *Dunlop Rubber Co., Ltd. v. A. A. Booth & Co., Ltd.*,<sup>16</sup> the plaintiffs who were manufacturers of "Dunlop" pneumatic tyres alleged that the defendants had imported for sale in England tyres made by the French Dunlop Co. Injunction to restrain infringement of trade marks was granted with an order for delivery up or destruction and an inquiry as to damages. The defendants' application to be allowed to send the infringing tyres to their original source as an alternative to delivery-up or destruction was refused by Tomlin, J. In *Bryant & May, Ltd. v. United Match Industries, Ltd.*,<sup>17</sup> an order was made for the destruction on oath of the labels held to infringe the plaintiffs' rights. And in *Vokes, Ltd. v. Evans and Marble Arch Motor Supplies, Ltd.*,<sup>18</sup> it was held by Farwell, J., that the successful plaintiffs were entitled to a delivery up on oath of the spurious articles in the defendants' possession. Dies, plates and other instruments used by the defendant for

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(14) In *Herbert Whitworth, Ltd. v. Jamnadas Nemichand* (1927) 52 Bom. 228; the court in making an order for delivery up of the infringing articles observed that "the expression 'infringing articles' applies only to so much of a piece as bears the mark or picture complained of. This would involve, I gather cutting about a yard at each end. It does not apply to the intervening 38 yards or thereabouts of each piece which has no mark on it." See also *Sirumal v. Emperor*, A.I.R. 1932 Sind 94; 26 S.L.R. 241.

(15) (1910) 27 R.P.C. 161; (1910) 1 Ch. 248. (Passing-off case).

(16) (1926) 43 R.P.C. 139.

(17) (1933) 50 R.P.C. 12.

(18) (1932) 49 R.P.C. 140.

counterfeiting the plaintiff's trade mark may also be forfeited or destroyed.<sup>19</sup>

**Delay.**—Although an injunction is granted an order for delivery-up may be refused on account of plaintiff's delay in taking action after becoming aware of the infringement.<sup>20</sup>

**Right questioned by Romer, J.**—The right to delivery up in passing-off actions has recently been questioned by Romer, J. In *Lissen, Ltd. v. Mutton*,<sup>21</sup> his Lordship made a distinction between a trade mark action and a passing-off action and said that in the latter case the plaintiff was not entitled to delivery up. The learned judge observed:—"I do not know of any common law right to an order for delivery up in a passing-off action. . . . The plaintiffs have no property in the goods in his (defendant's) possession merely because he has been passing them off as the Plaintiffs', and they have no property in his labels. They will have to be content with an injunction;" and added, "The habit is growing up in these passing-off cases to ask for delivery-up of the goods. I am perfectly sure it is wrong." The parties had, however, already come to terms and the defendant had delivered up to the plaintiffs the labels complained of. Romer, J., made an order for an injunction and an inquiry as to damages only and refused an order for delivery up.

It may be remarked, in this connection, that the right of property in an unregistered trade mark has been generally recognised under the common law, and that, as Lord Justice Romer pointed out in *Bow v. Hart*,<sup>22</sup> the Trade Marks Act does not "confer any new right of property on the owner of a trade mark;" the Act being only "a statutory recognition of the law which had been previously laid down by the Court of Chancery." Besides, in England an order for delivery up has been made in a number of passing-off cases.<sup>23</sup> In India, where, owing to the absence of

(19) Special penal provisions are contained in the Merchandise Marks Act. See Chapter XI.

(20) *County Chemical Co., Ltd. v. Frankenburg*, (1904) 21 E.P.C. 722; (delay of six months).

(21) (1929) 46 E.P.C. 10.

(22) (1905) 1 K.B. 592.

(23) *Dent v. Turpin*, (1861) 70 E.R. 1003; 30 L.J.Ch. 495; *Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd.*, (1910) 1 Ch. 248; 27 E.P.C. 161; *E. Middlemas and P. J. Wood (trading as Walters & Co.) v. Moliver & Co., Ltd.*, (1921) 38 E.P.C. 97; *Ideal Werke A. G. v. Willesdon and District Light Supply Co., Ltd.*, (1931) 48 E.P.C. 123;

statute law for registration of trade marks a trade mark owner can institute only an action for passing-off in case of infringement of his mark, the courts have recognised the plaintiff's right to a delivery up if he succeeds in the action.<sup>24</sup>

(iii) *Damages or Account of profits.*

**Alternative reliefs.**—The plaintiff is entitled to elect to take an account of profits or an enquiry as to damages.<sup>25</sup> These are alternative reliefs, and the plaintiff can claim only either of them. In *Lever v. Goodwin*<sup>1</sup> Lord Justice Cotton observed:—"It is well-known that both in trade mark cases and patent cases the plaintiff is entitled if he succeeds in getting an injunction, to take either of two forms of relief; he may either say, "Now I claim from you the damage I have sustained from your wrongful act;" or "I claim from you the profit which you have made by your wrongful act." So, in *Slazenger v. A. G. Spalding & Bros.*,<sup>2</sup> Neville, J., observed: "I think that nowadays there is no distinction between an account of profits and inquiry as to damages. Where the right to compensation exists, I think it rests with the plaintiff to elect whether he will take one form of relief or take another form of relief." And, in a recent case,<sup>3</sup> Farwell, J., observed:—"Where a plaintiff is successful in an action for infringement of trade mark or in infringement of a patent or in a passing-off action, he is entitled to elect whether he will take an enquiry as to damages or whether he will take an account of profits. If he takes an account of profits, there is cast upon the defendant the obligation of showing what profits, if any, he has made. It may be that the defendant is able

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*Vokes, Ltd. v. Evans and Marble Arch Motor Supplies, Ltd.*, (1932) 49 R.P.C. 140.

(24) See for instance the following cases where an order for delivery up was passed:—*The Swadeshi Mills Co. v. Juggilal Kamalapat Cotton Spinning and Weaving Mills, Co., Ltd.*, (1926) 49 All. 92; *The Swedish Match Co. v. Adamjee Hajee Dawood & Co., Ltd.*, (1926) 4 Rang. 381; *Herbert Whitworth, Ltd. v. Jamnadas Nemichand Mehta*, (1927) 52 Bom. 228.

(25) *Weingarten Bros. v. Charles Bayer & Co.*, (1905) 92 L.T. 511; 22 R.P.C. 341; *Sallay Mahomed Hajee Sulaiman v. S. B. Neogi & Co.*, (1931) 10 Rang. 85; A.I.R. 1932 Rang. 56; *The Manockji Petit Manufacturing Co., Ltd. v. The Mahalaxmi Spinning and Weaving Co., Ltd.*, (1885) 10 Bom. 617. Where the plaintiff is one of the joint proprietors of the mark he is entitled to his share of profits, *Dent v. Turpin*, (1861) 30 L.J.Ch. 495; 70 E.R. 1003.

(1) (1887) 36 Ch.D. 1; 4 R.P.C. 492.

(2) (1910) 1 Ch. 257; 27 R.P.C. 20.

(3) *B. E. Draper (trading as Hubert H. P. Trist & Co.) v. Hubert H. P. Trist and Tristbestos Brake Linings, Ltd.*, (1936) 53 R.P.C. at p. 69.



to show that he has in fact made no profit out of what was an illegal act and, if so, the plaintiff has to suffer for it by recovering nothing under the inquiry and possibly having to pay the costs of the enquiry. On the other hand, the plaintiff can elect, if he pleases, to take an inquiry as to damages, that is, an inquiry as to the damage which the plaintiff has suffered by reason of the wrongful acts of the defendant, and it is in electing to take such an inquiry as that, for the plaintiff to show that he has suffered some damage." A plaintiff who originally claims an account of profits may give up this claim subsequently at the trial and may ask for damages instead.<sup>4</sup>

**Nominal damages given where infringement is proved.**—"If a person sells his goods with the intention of deceiving purchasers, and of inducing them to believe his goods as the goods of another, this is actionable, and entitles the latter to recover nominal damages, even though no special damage is proved."<sup>5</sup> This principle was established as early as 1833 in *Blofeld v. Payne*.<sup>6</sup> The defendant had sold hones which were not of the plaintiff's manufacture in envelopes similar to those of the plaintiff. Lord Denman, C.J., told the jury at the trial that "even if the defendant's hones were not inferior, the plaintiff was entitled to some damages, inasmuch as his right had been invaded by fraudulent act of the defendant." The jury found a verdict for the plaintiff with a farthing damages although they found that the defendant's hones were not inferior to the plaintiff's. This verdict was upheld by the court of King's Bench, Littledale, J., observing: "The act of the defendant was a fraud against the plaintiff, and if it occasioned him no specific damage, it was still to a certain extent an injury to his right." Where there is no allegation of special damage the plaintiff will be entitled to only nominal damages. For instance, in *Morison v.*

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(4) *Juggilal Kamalapat v. The Swadeshi Mills, Co., Ltd.*, (1928) 56 I.A. 1; 51 All. 182; 46 R.P.C. 74.

(5) *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q.B. 639; 9 R.P.C., at p. 508. (Lopes, L.J.).

(6) (1833) 4 B. & Ad. 410; 110 E.R. 509; 2 L.J.K.B. 68. Applied:—*Dent v. Turpin*, (1861) 70 E.R. 1003; 30 L.J.Ch. 495; *Leather Cloth Co. v. Hirschfeld*, (1865) 1 Eq. 299; Referred:—*Crawshay v. Thompson*, (1842) 4 Man. & G. 357; 134 E.R. 146; *Burgess v. Burgess*, (1853) 3 DeG. M. & G. 896; 43 E.R. 351; *Dixon v. Fawcus*, (1861) 121 E.R. 544; 30 L.J.Q.B. 137; 3 E. & E. 537; *Singer Manufacturing Co. v. Loog*, (1882) 8 App. Cas. 15; *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q.B. 639; 9 R.P.C. 503; *Spalding & Bros. v. Gamage, Ltd.*, (1913) 30 R.P.C. 388; (1914) 110 L.T. 530; 31 R.P.C. 125; (1915) 32 R.P.C. 273; 84 L.J. Ch. 449.

*Salmon*<sup>7</sup> the plaintiff was given one farthing damages and in *Rodgers v. Nowill*<sup>8</sup> a verdict was found for the plaintiff with forty shillings damages. So also, in *Pneumatic Rubber Stamp Co. v. Lindner*<sup>9</sup> forty shillings were awarded as damages, and in *Cusenier Fils & Co. v. Gaiety Bars and Restaurant Co., Ltd.*,<sup>10</sup> where the defendants were held to have passed off other liqueur as of the plaintiffs, injunction was ordered with costs and 20 shillings as damages.

The same law prevails in the Indian courts. In *Abdul Salam v. Hamidullah*<sup>11</sup> the court observed that for damages to be recovered for infringement of a trade mark it was not necessary that special damages should be proved, and that it was sufficient to show that the plaintiff's right had been invaded, in which case, some damage, even if only nominal, would be given.

**Account of profits.**—Where an account of the profits is ordered, the whole profit made by the defendant by the sale of the spuriously marked goods would be awarded as damages. It is immaterial that if the infringement had not taken place all the profits made by the defendant from the spuriously marked goods might not have gone to the plaintiffs. The defendant cannot plead that part of the profits was due to the intrinsic value of the goods sold by him and that only the remaining portion was due to the use of the spurious mark. As was observed by an American Judge, "Every consideration of reason, justice, and sound policy demands that one who fraudulently uses the trade mark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trade mark on the plea that it is impossible to determine how much of the profit is due to the trade mark, and how much to the intrinsic value of the commodity. The fact that it is impossible to apportion the profit renders it just that he should lose the whole."<sup>12</sup>

(7) (1841) 10 L.J.C.P. 91.

(8) (1847) 17 L.J.C.P. 52; 136 E.R. 816; 5 C.B. 109.

(9) (1898) 15 R.P.C. 525. See also *Munday v. Carey*, (1905) 22 R.P.C. 273.

(10) (1902) 19 R.P.C. 357. See *Lyons & Co., Ltd. v. Lyons*, (1932) 49 R.P.C. 188; where £5 damages were awarded.

(11) (1912) 15 I.C. 116; 166 P.W.R. (1912). See also *Noor Mohamed Sait Co. v. Abdul Kareem & Co.*, (1933) 57 Mad. 600. (Rs. 50 awarded as damages although no actual instance of confusion was proved).

(12) Per Crocket, J., in *Graham v. Plate*, Seb. Dig., p. 208.

In *Lever v. Goodwin*<sup>13</sup> it was contended on appeal that the account of profits ordered by Mr. Justice Chitty was wrong in form and that the account ought to be confined to profits on sales to person who actually bought the defendant's soap believing it to be the plaintiffs'. But the Court of Appeal refused to accept this argument. Cotton, L. J., said "In my opinion that is mistaking the whole gist of this action. The defendants, as I understand, do not sell anything to retail purchasers; what they sell they sell to middlemen, that is to say to purchasers from them as wholesale merchants, and who are going to sell it retail to persons who come and buy one or two or any number of these packets; and the complaint against them is this: "you have dressed up your soap in such a dress that these middlemen to whom you sell it are enabled by having that deceptive dress upon it to sell it to the ultimate purchasers as the soap of the plaintiffs when it is your soap." In my opinion the whole gist of the complaint against them is, "You have sold a weapon calculated to be used fraudulently by the middlemen;" and the profit for which they must account for is the profit which they have made by the sale of soap in that fraudulent dress to the middlemen. It is immaterial how the latter deal with it. If they find it for their benefit not to use it fraudulently, but to sell the soap to purchasers from them as Goodwin's soap that cannot affect the question whether the sale by the defendants to those middlemen of this soap in a fraudulent dress was a wrongful act. It still remains a wrongful act because it puts into their hands the means of committing a fraud on the plaintiffs by selling the soap of the defendants as the soap of the plaintiffs. In my opinion, therefore, the account of profits is right as it stands and there ought to be no alteration in that respect."

Where a decree for account is made the plaintiff is entitled to a discovery of the names and addresses of persons to whom the defendant had sold the spurious goods.<sup>14</sup>

**Not allowed in case of short user and small sales.**—An account of profits or an inquiry into damages will not be generally allowed where the alleged use of the false mark is only for a short period and the sale of the spurious goods is small and negligible. As Lord Hanworth, M.R., observed in a recent case,<sup>15</sup> "The court

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(13) (1887) 36 Ch.D. 1; 4 R.P.C. 492.

(14) *Leather Cloth Co., Ltd. v. Hirschfeld*, (1863) 11 W.R. 933; (1865) L.R. 1 Eq. 299.

(15) *Samuelson v. Producers Distributing Co., Ltd.*, (1932) 1 Ch. 201; 48 R.P.C. at p. 589.

ought not to order an inquiry as to damages unless it is satisfied that there is some question of sufficient importance to justify the time of the court and the expenditure on the part of the parties which would result." In *McAndrew v. Bassett*<sup>16</sup> an injunction was granted restraining the defendant from selling liquorice stamped with the plaintiff's mark "Anatolia" but it was held that the case was not one in which an account need be directed. In *Shipwright v. Clements*<sup>17</sup> the defendant after assigning his partnership rights in perfumery business to the plaintiff subsequently represented that the old business had been removed to his new place of business. Injunction was granted, but owing to the smallness of the amount, no account was given. In *Rose v. Loftus*<sup>18</sup> the defendant, a manufacturer of lime juice, filled on one occasion at the request of the customer, some of the plaintiff's bottles embossed with the plaintiff's trade mark that had been brought to him by the customer. On the defendant undertaking not to repeat the act, the court did not order costs or an account of profits. In *Sanitas Co., Ltd. v. Condy*,<sup>19</sup> Kekewich, J., refused to order damages or an account of profits on the ground that the evidence of sale was insufficient to make it worthwhile to order either of these reliefs. In *Rutter & Co. v. Smith*<sup>20</sup> the plaintiffs could prove only one case of passing-off in which a person who asked for an ounce of the plaintiffs' "Mitcham" tobacco had been served with another tobacco by the defendant's manager. The court held that the case was too trivial for damages. In *Boord and Son v. Huddart*<sup>21</sup> inquiry as to damages was refused on the ground that the defendant's sale had been small. In *Fram Manufacturing Co., Ltd. v. Eric Morton & Co.*,<sup>22</sup> damages were not allowed though an injunction was granted. In *Wakefield & Co., Ltd. v. Purser*<sup>23</sup> the

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(16) (1864) 33 L.J.Ch. 561; 4 De G.J. & Sm. 380; 46 F.R. 965; (The plaintiff had used the mark only for six weeks).

(17) (1871) 19 W.R. 599; Seb. Dig., p. 210.

(18) (1878) 47 L.J.Ch. 576; 38 L.T. 409.

(19) (1887) 4 R.P.C. 530; 56 L.T. 621; See also *Crosfield (Joseph) & Sons v. Caton*, (1912) 29 R.P.C. 47.

(20) (1901) 18 R.P.C. 49. See also *John Knight & Sons, Ltd. v. Crisp & Co., Ltd.*, 21 R.P.C. 670, where no damage was awarded as there was only one instance of passing-off and there was no intention to repeat the act; *Kinnell & Co., Ltd. v. Ballantine & Sons*, (1909) 26 R.P.C. 12 and 27 R.P.C. 185.

(21) (1904) 21 R.P.C. 149; 89 L.T. 718.

(22) (1923) 40 R.P.C. 33. (See also *Societe Francaise Radio-Electrique v. West Central Wireless Supplies*, (1928) 45 R.P.C. 276.

(23) (1934) 51 R.P.C. 167.

plaintiffs alleged that in response to two trap orders for their Castrol XL the defendants' employee had supplied an oil which was not "Castrol XL". Although the court held that an offence had been committed no damages were allowed, as the damages said to be suffered by the plaintiffs were trifling.

The same rule is followed in India. In *Karam Elahi & Co. v. Abdul Aziz*<sup>24</sup> the court held that as no special damage was proved a decree for compensation should be refused, although an injunction was granted. And in *Taylor v. Virasami Chetty*<sup>25</sup> the claim for damages was not pressed as the defendants had not effected any sales.

**Delay.**—The court may refuse to order an account of profits or damages in cases where there has been undue delay by the plaintiff in taking legal action after the knowledge of the infringement. In *Harrison v. Taylor*<sup>1</sup> Vice-Chancellor Wood granted an injunction but held that no account of profits before the commencement of the suit could be given, on account of the plaintiff's delay of nearly a year. In *Beard v. Turner*<sup>2</sup> where the plaintiffs complained that the defendants were selling needles with a label bearing a general resemblance to the plaintiffs' the same Vice-Chancellor held that the injunction asked for could not be granted, and that even if the relief could have been granted, the plaintiffs having neglected to take proceedings for two years after they became aware of what the defendant was doing, could have no account or costs by reason of that delay. And, in *Reddaway & Co., Ltd. v. Robert Stevenson and Bros., Ltd.*,<sup>3</sup> damages were refused as the plaintiffs had neglected to sue for three and a half years after becoming aware of the infringement.

**Abandonment.**—Delay may often amount to abandonment. Where the infringements are numerous and the owner of the mark neglects to take any action the mark may become *publici juris*. The plaintiff will not be entitled to damages or an account of profits where the mark is abandoned or has become *publici juris*. Where the defendant raises the plea that the plaintiff had abandoned

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(24) (1909) 4 Ind. Cas. 963; 127 P.L.R. 1909.

(25) (1882) 6 Mad. 108.

(1) (1865) 12 L.T.N.S. 339.

(2) (1865) 13 L.T.N.S. 746.

(3) (1903) 20 B.P.C. 276.

the trade mark or that the mark has become common to the trade, the onus of proof is on the defendant to establish his contention.\*

**Acquiescence.**—Where there is satisfactory evidence of acquiescence neither an account of profits nor damages will be allowed.<sup>5</sup> The owner of a trade mark, after becoming aware of the infringement of his mark by the defendant, cannot deliberately defer taking legal action and allow the sale of the spurious goods without hindrance with the expectation that a larger profit may thus be eventually obtained from the defendant. In *Ford v. Foster*<sup>6</sup> the court held that the plaintiff, not having been active in defending his rights, and the defendant's business being much larger than his, it was impossible to calculate the sales lost to the plaintiff by those effected by the defendants, and that the account should be limited to profits earned from the commencement of the suit.

**Account of profits allowed only after the defendant becomes aware of the plaintiff's title to the mark.**—In *Cartier v. Carlile*<sup>7</sup> it was held that where an injunction was granted, an account of profits should also be allowed, notwithstanding that the defendant was ignorant of the rights, and even of the existence, of the plaintiff. Romilly, M. R., said: "I am of opinion that the liability to account for the profits is incident to the injunction, and that the fact of the defendant not knowing to whom the trade mark he copies belongs, does not in the slightest degree affect the right of the owner to an injunction and to an account of the profits, as soon as he ascertains that it is imitated and used." But in *Moët v. Couston*,<sup>8</sup> the same Master of the Rolls refused to order an account of profits and costs, although he granted an injunction. The defendants had in that case purchased and resold in England a quantity of the plaintiffs' Champagne marked as "Moët's." The plaintiffs filed a suit for injunction and an account whereupon the defendants offered to submit to an injunction, each party paying its own costs. Romilly, M. R., said: "If a man buys goods from a third party, believing them to be genuine, while in fact they are spurious, it is not until he has been told that they are so

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(4) *Noor Ilahi-Maqbul Ilahi v. Wood & Co.*, (1927) 9 Lah. 487; A.I.R. 1928 Lah. 924.

(5) *Hogg v. Maxwell* (1867) 2 Ch. Appeal 307, 316.

(6) (1872) L.R. 7 Ch. 611, 616; 41 L.J.Ch. 682; Seb. Dig., p. 228.

(7) (1862) 31 Beav. 292; 54 E.R. 1151.

(8) (1864) 33 Beav. 578; 55 E.R. 493.

that he can be considered to be guilty of any fraud or to be liable to render any account." *Cartier v. Carlile*<sup>9</sup> was soon overruled by *Edelsten v. Edelsten*.<sup>10</sup> In that case Lord Chancellor Westbury held that, although the plaintiff was entitled to an injunction, an account of the profits would only be given in respect of any user by the defendant after he had become aware of the plaintiff's title. *Edelsten v. Edelsten* was followed and held to be good law in *Lever v. Goodwin*<sup>11</sup> and in *Slazenger v. Spalding & Bros.*<sup>12</sup> In the latter case the defendants offered for sale golf balls with a black cross similar to the plaintiffs' registered trade mark, whereupon the plaintiffs started an action for infringement. The defendants immediately offered to submit to an injunction with costs and pay £10 as nominal damages. This offer was refused by the plaintiffs who claimed that they were entitled to an account. It was shown by the defendants that they had acted *bona fide*, and that very few balls were marked and sold with a cross, and that immediately after becoming aware of the plaintiffs' ownership of the mark they had taken steps to remove the black cross from all balls in stock, to obliterate the reference in their catalogue to balls so marked, and to stop the further sale of them. It was held that the plaintiffs had no right to compensation either in the form of an inquiry as to damages or in the form of an account of profits. Neville, J., made the following observation. "Now *Edelsten v. Edelsten* seems to have survived as an authority in text books. . . . The precise point appears to have been considered by Sir George Jessel in the year 1880, although unfortunately there is but a short note of the decision in the Solicitor's Journal,<sup>13</sup> but that note is quite conclusive on the point. There was an action brought upon a registered trade mark, and the question submitted to his Lordship there was, whether in the case of an innocent infringement, where a perpetual injunction was granted, a right to an account went with it. . . . The question is whether any right to compensation exists. If *Edelsten v. Edelsten* applied, it does not. . . . Having

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(9) (1862) 31 Beav. 292; 54 E.R. 1151.

(10) (1863) 1 De G.J. & S. 185; 46 E.R. 72.

(11) (1887) 4 R.P.C. 492; 36 Ch.D. 1.

(12) (1910) 1 Ch. 257; 27 R.P.C. 20. Cf. *Henry Heath Ltd. v. Frederick Gorringe, Ltd.*, (1924) 41 R.P.C. 457, where notwithstanding the defendants' plea of ignorance of the plaintiffs' title to the registered mark Eve, J., said: "A legal right has been infringed, and *prima facie* the plaintiffs are entitled to damages, which, of course, the plaintiffs take at their own risk as to costs."

(13) *Ellen v. Slack*, (1880) 24 Sol.J. 290..

regard to the decision of Sir George Jessel, and what seems to have been the practice up to the present time, I think that *Edelsten v. Edelsten* is still applicable, and that in a case where the infringement of a trade mark is made without knowledge of the existence of the plaintiff's trade marks, there is not a right to compensation, but only a right to an injunction."

**Damages not allowed in case of innocent infringement.—**

The same rule applies to an inquiry as to damages. Since *Edelsten v. Edelsten* it is settled law that an order for inquiry as to damages will be made only where there is fraudulent passing-off.<sup>14</sup> A defendant who was ignorant of the plaintiff's title to the mark at the time of infringement and ceases to use the mark immediately after he becomes aware of the plaintiff's exclusive ownership is not liable for the actual damage suffered by the plaintiff. In such cases only an injunction and nominal damages may be ordered. So, in *Kinnell & Co., Ltd. v. Ballantine & Sons*<sup>15</sup> the decision of the lower court awarding £50 damages was reversed on appeal and it was held that the plaintiffs were not entitled to any damages as no case of actual deception was proved. In that case the defendants had issued price lists on the front page of which the words 'Horse Shoe boilers' appeared; on the plaintiffs' objection the defendants deleted these words in the price list but refused to pay damages. It was shown that the words "Horse shoe" had acquired secondary signification in connection with the plaintiffs' boilers. An inquiry as to damages was refused also in *Vokes, Ltd. v. Evans and Marble Arch Motor Supplies, Ltd.*<sup>16</sup> on the ground that the defendants were innocent infringers. Farwell, J., said: "In my judgment they (plaintiffs) are not entitled to any damages, and for this reason, that being satisfied, as I am, that the defendants were perfectly innocent up to 30th of April 1931, there is no evidence before me whatever to show that either of the defendants have had any dealings at all with the particular articles since that date, and therefore I do not think it would be right for me to grant an inquiry as to damages."

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(14) See *Iron-Ox Remedy Co., Ltd. v. Leeds Industrial Co-operative Society Ltd.*, (1907) 24 R.P.C. 434.

(15) (1909) 26 R.P.C. 12; 27 R.P.C. 185.

(16) (1932) 49 R.P.C. 140 (Passing-off case). See also *Champagne Heidsieck et cie v. Scotto & Bishop*, (1926) 43 R.P.C. 101, where an inquiry as to damages was granted against the fraudulent infringer but not against the innocent one.



On the other hand, in *Bechstein v. Barker and Barker*<sup>17</sup> where the plaintiffs complained of certain advertisements by the defendants offering "Bechstein" pianos for sale which mark had been registered by the plaintiffs, an inquiry as to damages was directed, as it was shown that the defendants had dishonestly attempted to pass off pianos not of the plaintiffs' manufacture as of their manufacture.

**Special damages to be shown by the plaintiff.**—Where the plaintiff elects to claim an inquiry as to damages the onus lies on him to prove that he had suffered special damage by the defendant's conduct.<sup>18</sup> If the plaintiff fails to show evidence of special injury to his trade a decree for compensation may be refused, although the defendant may be restrained from further infringement of the mark.<sup>19</sup> It is not sufficient to show that there had been decrease in the volume of the plaintiff's business. This may be due to other causes. So, Lush, J., said: "It does not follow, because there has been a falling-off of business, that the damage is attributable to the infringement, and unless the Plaintiffs can prove that the manufacture and sale of articles bearing the plaintiffs' mark caused the damage they cannot recover damages or ask for an enquiry or an account."<sup>20</sup> In the *Leather Cloth Co. v. Hirschfeld*<sup>21</sup> the plaintiffs obtained an injunction to restrain the infringement of their trade mark and an inquiry as to damages, but failed to prove special damage. They, however, claimed the amount of profits which they would have made if they had sold all the goods which the defendant had sold under their mark. In

(17) (1910) 27 R.P.C. 484.

(18) *Leather Cloth Co. v. Hirschfeld*, (1865) L.R., 1 Eq. 299. "I cannot order an inquiry as to damages unless there is some evidence of damage." Farwell, J., in *Vokes, Ltd. v. Evans and Marble Arch Motor Supplies, Ltd.*, (1932) 49 R.P.C. at p. 144.

(19) *Karam Elahi & Co. v. Abdul Aziz*, (1909) 4 Ind. Cas. 963; 127 P.L.R. 1909.

(20) *Fram Manufacturing Co., Ltd. v. Erio Morton & Co.*, (1923) 40 R.P.C. at p. 37. In the recent case of *Radio Rentals, Ltd. v. Rentals, Ltd.*, (1934) 51 R.P.C. 407, where a small damage was shown, Clauson, J. awarded only 30 guineas as against the plaintiffs' claim of £200. See also *Samuelson v. Producers Distributing Co., Ltd.*, (1932) 1 Ch. 201; 48 R.P.C. 580 where the Court of Appeal held that the plaintiff had not established that he had suffered damage beyond the £5 paid into Court by the defendants.

(21) (1865) L.R. 1 Eq. 299.

rejecting this claim Wood, V.C., said that the burden lay on the plaintiffs to prove special damage by loss of custom or otherwise, and that it could not be assumed that the same quantity would have been bought of the better goods at the higher price as had been bought of the inferior goods at the lower price, and that it could not, therefore, be said in the case in question that any special damage had been suffered.

The above case was followed in *Alexander & Co. v. Henry & Co.*<sup>22</sup> Referring to Vice-Chancellor Wood's decision in the *Leather Cloth Co. v. Hirschfield*, Kekewich, J., said:—"You must not jump to the conclusion that because an infringer whether of a patent or any other infringer, has sold a certain number of articles, if he had not intervened, therefore, the manufacturer would have sold the same number of articles. . . . But if you can find a good reason, such as I have suggested in the case of the patentee—a great demand, particularly if it is an unsatisfied demand, and if you can find any other good reason for your conclusion—a reason which would satisfy ordinary persons of experience—then you do not presume, but you conclude that the sale of the infringer has kept out of the market the same number, or a similar number, of articles which would otherwise have been sold by the original manufacturer. It is a mere question in each case whether the evidence justifies the conclusion or not." It is therefore only under very exceptional circumstances that a plaintiff in a trade mark case may claim that the sales made by the defendant would, but for the infringement have been effected by the plaintiff himself. Thus, in the case cited above,<sup>23</sup> the Official Referee appointed to inquire into the actual damage reported that if the defendants "had not sold such thread, plaintiffs would have sold an equal quantity of their own thread to meet the demand in Mexico for their own thread" and took this factor into consideration in assessing damages.

**Account of profits refused, but damages allowed.**—In the case of *Van Zeller v. Mason, Cattley & Co.*,<sup>24</sup> the plaintiff was successful in a passing-off action and was allowed an injunction and an inquiry as to damages. But the court held that the

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(22) (1895) 12 B.P.C. 360. See also *The Manockji Petit Manufacturing Co., Ltd. v. The Mahalaxmi Spinning and Weaving Co., Ltd.*, (1885) 10 Bom. 617.

(23) *Alexander & Co. v. Henry & Co.*, (1895) 12 B.P.C. 360.

(24) (1908) 25 B.P.C. 37.

plaintiff was not entitled to an account of profits. The facts of that case were as follows:—The plaintiff was the proprietor of a well-known vineyard in Portugal known as the Quinta de Roriz. Originally the vineyard and a wine shipping business (C. N. Kopke & Co.,) were in the same hands, but later there was a severance of the ownership. The firm of Kopke & Co. continued to be the sole purchasers of the whole produce of the vineyard and were selling the wine under the brand “Kopke Roriz.” The business of this firm passed on to the defendant firm who continued for some time to take the produce of the Quinta de Roriz. They then ceased to take the produce of this vineyard and began to sell large quantities of other wines under the mark “Kopke Roriz.” An action for passing off was successful, and an injunction was granted. On the question of compensation, Joyce, J., said: “I think they are entitled, not to an account of profits, but to an inquiry as to damages as in the case of *Weingarten Bros. v. Charles Bayer & Co.*,”<sup>25</sup> and added, “I do not think it would be right that you should have all the profits they have made by the wine that has been sold under this title. You are entitled to any inquiry as to damages.”

**Plaintiff entitled to all damages flowing directly from the defendant's wrongful act.**—The measure of damages shall not be restricted to the decline in sales actually suffered by the plaintiff but shall include all loss sustained by the plaintiff as a direct consequence of the misrepresentation by the defendants. In *A. G. Spalding & Bros. v. A. W. Gamage, Ltd.*,<sup>1</sup> Lord Justice Eady laid down the principles on which damages ought to be assessed in the following passage: “The defendants are liable, in my opinion, for all loss actually sustained by the plaintiffs, which is the natural and direct consequence of the unlawful acts of the defendants; this will include any loss of trade actually suffered by the plaintiffs, either directly from the acts complained of, or properly attributable to injury to the plaintiffs' reputation, business, goodwill and trade and business connections caused by the acts complained of; in other words, such damages as flow directly, and in the usual course of things, from the wrongful acts, and excluding any speculative and unproven damage. See *United Horse Shoe and Nail Co. v. Stewart*, (L.R. 13 App. Cas. 401),

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(25) (1905) 22 B.P.C. 341; 92 L.T. 511.

(1) (1918) 35, B.P.C. 101.

*The Argentino* (L.R. 13, P.D. 191); *Pneumatic Tyre Co., Ltd. v. Puncture Proof Pneumatic Tyre Co., Ltd.*, (16, R.P.C. 209).''

**Assessing damages.**—The loss of profit forms generally the substantial ground of the claim for compensation. Instead of diminution of profits the claim may occasionally take the form of enhancement of loss. In the latter case the plaintiff might not have been making any profit or might be working at a loss and the defendant's wrongful use of his trade mark might result in increasing the loss.<sup>2</sup> The diminution in profits (or enhancement of loss) may arise in the following ways:—(1) decrease in the amount of goods sold by the plaintiff, (2) reduction in prices of the goods forced on the plaintiff by the defendant's act, and (3) injury to the plaintiff's business reputation. Of these, the injury done to the plaintiff by diminution in sales resulting in decrease in estimated profits is the most important. Cases, may, however, arise where the other two factors may assume importance. In dealing with the assessment of damages the element of uncertain speculation and special profits must be excluded,<sup>3</sup> and the damage must be shown to be the reasonable and natural result of the act complained of.

**Reduction in prices of the plaintiff's goods.**—In cases of infringement it generally happens that the defendant is able to sell the spurious goods at a price which is often considerably lower than the plaintiff's. This tends directly to affect the sale of the plaintiff's goods and the plaintiff may be forced to reduce the price of his goods in order that he may successfully compete with the infringer. It is possible that notwithstanding any increase in the sales which may thus result, the plaintiff may suffer a net loss. Such losses can be directly traced to the infringer's acts, and are recoverable from the infringer as damages. But the reduction of prices by the plaintiff may be due to other causes. The fact that a trader reduces the price of his goods does not necessarily show that, notwithstanding the infringement of his mark in the market, the reduction of prices is forced on him by the infringer.<sup>4</sup> The plaintiff may have been influenced by many reasons such as ordinary rivalry of trade. "And to jump to the conclusion that, because

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(2) *The Manockji Petit Manufacturing Co., Ltd. v. The Mahalazmi Spinning and Weaving Co., Ltd.*, (1885) 10 Bom. 617.

(3) *Argentino*, The L.R., 13 P.D. 191.

(4) *United Horse Shoe and Nail Co. v. Stewart & Co.*, (1888) 5 R.P.C. 260; 13 A.C. 401.

a manufacturer has thought fit to reduce his prices, therefore, the reduction, that is to say, the difference between the original price and the reduced price, is an injury caused to him by the infringer to be measured by that difference in money, is really coming to a conclusion without premises, ignoring possible and even probable facts which might influence the result.”<sup>5</sup> The plaintiff must, therefore, establish that the fall in price is due not simply to the introduction of the defendant’s goods in the market, but to the introduction of the goods under false colours.<sup>6</sup> Only where the facts of the case unmistakably indicate that the reduction in price was not the result of honest competition but the natural consequence of the infringement of the plaintiff’s mark will the infringer be liable to the loss suffered on this account by the plaintiff.

In *Alexander & Co. v. Henry & Co.*,<sup>7</sup> the court accepted the finding of the Official Referee that in order to prevent themselves from being driven out of the market as a result of the infringement the plaintiffs had to reduce their price and ordered damages accordingly. “It was not simply what was, or at any rate might have been (as was pointed out by Lord Macnaghten in the Horse Shoe Nail case), a question of honest competition, where a man, instead of standing firm, might alter his prices from time to time to meet his rivals in trade. These plaintiffs were, according to the conclusion of the Referee, which seems to me to be a reasonable one, forced to reduce their prices because they were dealing with dishonest competitors, with whom they had no reasonable chance in the open market; and, ruined in this way, they made a desperate attempt; and that desperate attempt seems to me to have been, whether wise or unwise, the natural consequence of this dishonesty of those with whom they were engaged.”

In *The Manockji Petit Manufacturing Co., Ltd. v. The Mahalaxmi Spinning and Weaving Co., Ltd.*,<sup>8</sup> the plaintiffs alleged that in consequence of the sale by the defendants of yarn bearing marks similar to those upon their goods the plaintiffs were forced to reduce their selling price, that the depreciation was beyond the amount attributable to the natural fall of market prices and that

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(5) Per Kekewich, J., in *Alexander & Co., v. Henry & Co.*, (1895) 12 R.P.C. at p. 367.

(6) *The Manockji Petit Manufacturing Co., Ltd. v. The Mahalaxmi Spinning and Weaving Co., Ltd.*, (1885) 10 Bom. 617.

(7) (1895) 12 R.P.C. 367.

(8) (1885) 10 Bom. 617.

such extra depreciation was the natural and reasonable result of the defendants' wrongful action. It was shown that the plaintiffs' mills were not working at a profit and would have made no profit if their yarn had fetched the fair market price ruling at that time. It was held that the extra fall in the prices of the plaintiffs' yarn was attributable to the introduction of the spurious goods by the defendants and a sum of Rs. 4,110 was allowed as damages.

**Damage to reputation.**—It is well established “that a Court of Equity will protect the business reputation enjoyed by any person or corporation against tangible risk or probability of injury just as it will protect any other property of such person or corporation against any such risk or probability.”<sup>9</sup> The question of damage to reputation was raised in the very first trade mark case where relief was given by the Common Law Court. In *Sykes v. Sykes*<sup>10</sup> the declaration alleged that “plaintiff enjoyed great reputation with the public on account of the good quality of such articles, . . . . . that the defendant did wrongfully, knowing (*sic*) and fraudulently . . . . . make a great quantity of shot belts . . . . . and did knowingly and deceitfully sell . . . . . the said articles so made . . . . . whereby plaintiff was prevented from selling a great quantity of shot belts and powder flasks, etc., and greatly injured in reputation, the articles so manufactured and sold by the defendant being generally inferior to those manufactured by the plaintiff.” In *Alexander & Co. v. Henry & Co.*,<sup>11</sup> the question arose whether damages can be awarded for the loss of business reputation suffered by the plaintiffs directly as a consequence of the infringement. The plaintiffs who carried on extensive business as sewing cotton and thread manufacturers at Glasgow were selling their ball thread in foreign markets including Mexico. The defendants commenced selling similar thread balls but of inferior quality with tickets bearing the name and mark which were a fraudulent imitation of the plaintiffs'. The court held that there was passing-off and accordingly granted an injunction. In assessing the damages the Official Referee took into consideration the injury done to the plaintiffs' business reputation at Mexico apart from other losses caused by the defendants' unlawful conduct.

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(9) *Per* Lawrence, J., in *Society of Motor Manufacturers and Traders, Ltd. v. Motor Manufacturers' and Traders' Mutual Insurance Co., Ltd.*, (1925) Ch. 675; 42 R.P.C. at p. 314.

(10) (1824) 3 B. & C. 541; 107 E.R. 834; 3 L.J.K.B. 46.

(11) (1895) 12 R.P.C. 360.

According to him "the defendants by the use of the infringing tickets and the sales under them, injured the reputation in Mexico of the plaintiffs and the plaintiffs' genuine thread, and in consequence of such injury so caused, the defendants were able to sell under a ticket known as the Marsland ticket, thread made by them, and to compete effectively in Mexico with the plaintiffs. Until the injury to the plaintiffs' reputation caused by the use of the infringing tickets, Wallers had not been able to compete effectively with the plaintiffs in Mexico, and, but for such injury to the plaintiffs' reputation, they would not have been able to compete effectively with the plaintiffs in Mexico." The finding was accepted by Kekewich, J., and the plaintiffs were awarded a sum of £5,000 as damages.

In the above case the reputation which the plaintiffs' goods enjoyed in the market was affected by the fact that the spurious goods which replaced the plaintiffs' goods were definitely inferior in quality. Where, the spurious goods are similar or superior in quality to the plaintiffs' goods the question of injury to reputation will not, generally, arise.<sup>12</sup> There may, however, be exceptional circumstances where, notwithstanding the fact that the defendant's spurious goods are of the same quality as the plaintiff's, injury may be caused to the business reputation of the latter directly as a consequence of the defendant's wrongful action. For instance, the infringement may be such as to bring about in the minds of retail merchants a loss of confidence in the honesty of the plaintiff, and thus a probable loss of customers. In *Spalding & Bros. v. Gamage, Ltd.*,<sup>13</sup> the circumstances were of this nature. The plaintiffs manufactured a new kind of balls from rubberised canvas which they called 'orb.' As these balls were found to be very unsatisfactory in use, they subsequently sold all their stock to a firm of waste-rubber merchants and manufactured another kind of ball which they called "Improved orb." The defendants purchased the discarded balls from the waste-rubber merchants, and advertised them under the name "Improved orb" for sale at less than half the price of the original article. The words "Improved orb" were later withdrawn and substituted by the word "orb." An enquiry as to damages being ordered, the plaintiffs claimed damages in respect of their loss of profit on sales of

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(12) See, for instance, *Sallay Mahomed Hajee Sulaiman v. Neogi & Co.*, (1931) 10 Rang. 85; A.I.R. 1932 Rang. 56.

(13) (1918) 35 R.P.C. 101.

their "Improved orb" balls and for injury to their reputation, occasioned by the advertisement. It was held by the court of appeal that the defendants were liable to all damages which were the direct result of the defendants' advertisements, and that the plaintiffs were entitled to some damages for the injury done to their reputation by those advertisements. Referring to the defendants' advertisements Bankes, L. J., said: "It is, I think, clear that persons who had dealings with the plaintiffs did read those advertisements as indicating that the plaintiffs were not dealing fairly with their customers. An impression of this kind, if generally accepted, would be likely, under some circumstances, to cause very considerable damage to a trader and damage which it would be difficult to trace or to prove." It was held that the cost of issuing counter-advertisement by the plaintiffs was not the proper basis for the assessment of damages and the damage was assessed at £250.

**Computation of damages.**—Damages can rarely be made the subject of exact mathematical calculation. In most cases it is, and must be a matter of opinion. In *Thomson & Co. v. Dailly*<sup>14</sup> Lord Justice Clerk said: "It is perfectly true that it is not easy to make a safe calculation of the exact damage, but that is just what occurs in a great many cases. It must be estimated in a reasonable way. If it cannot be estimated with exactitude, one must form one's opinion as a juryman would of the damage due upon the whole circumstances of the case, and make the best reasonable estimate that one can."

An important rule in assessing damages has been laid down recently by the Privy Council in *Juggilal Kamalapat v. The Swadeshi Mills Co., Ltd.*<sup>15</sup> The plaintiffs who were dealers in Indian cloth succeeded in a passing-off action against the defendants and obtained an injunction in respect of their trade marks. They originally claimed for an account of profits but at the trial they elected to

(14) (1897) 24 Rettie, Sess. Cas. 4th Series at p. 1181 followed in *Ledger Sons & Co. v. James Munroe & Son, Ltd.*, (1916) 33 R.P.C. 53.

(15) (1928) 56 I.A. 1; 51 All. 182; 46 R.P.C. 74. That the result of an enquiry as to the profits made by the defendant by the unlawful use of the mark should be the basis for assessing damages was the view taken in the earlier case *Madhavji Dharamsey Manufacturing Co., Ltd. v. Central India Spinning, Weaving and Manufacturing Co., Ltd.*, (1916) 41 Bom. 49; this view is no longer correct in view of the decision of the Privy Council in *Juggilal Kamalapat v. The Swadeshi Mills Co., Ltd.*, (1928) 56 I.A. 1; 51 All. 182, cited above.



claim damages instead. The plaintiffs assessed their damages at Rs. 25,000. Judgment was given to the plaintiffs. As regards the assessment of damages the court observed: "This question is not free from difficulty. The text books indicate that while in England the profits derived from the sale by the defendant of imitated goods have been taken to be the measure of damages to which the plaintiff is entitled, in America the plaintiff has been awarded the profits which he would have realized if he had sold the quantity of goods shown to have been sold by the defendant. We are of opinion that the profits made by the defendant cannot always be a true criterion of damages awardable to a plaintiff. Unless a rival trader commences his career, as did the defendant, by appropriating the trade marks of other firms, there must always be an initial period during which the goods have to acquire by their own merit, by advertisement and "drive" a footing in the market. Goodwill has also to be built up. Time and money too are lost through lack of experience." On these considerations the learned judges proceeded to estimate the measure of damages in the following manner. They found that the sale account of the defendants' goods which had the pirated mark was Rs. 32,00,828. It was then assumed that of that Rs. 32,00,828 worth of goods, the defendants would have sold 40 per cent., if they had merely trusted to their own cloth without the addition of a misleading mark, but 60 per cent. of it should be held to be due to the misleading mark. On this basis profit was calculated at 9 per cent. of the estimated sales and a judgment for this sum (Rs. 1,72,800) was given. On appeal to the Privy Council it was held that the assumption made by the Allahabad High Court in deducing the estimated sale of the plaintiffs' goods was far too speculative and that there was no justification for a decree founded on this calculation. According to their Lordships there was no cut and dried rule which could be laid down by a court of law for the estimation of damages in a case like this, but in their opinion on the figures given, the safer basis on which to work were those which showed the falling-off in the plaintiffs' trade consequent on the introduction of the pirated mark in the market. Their Lordships said: "If it is assumed that the whole of the falling-off was due to the use of the pirated mark, that would bring out a figure of about Rs. 10,00,000 loss of trade, and taking 9 per cent. profit on that amount it gives a figure which, put into pounds sterling, would come out at a sum of £4,500. That, however, does not give anything for a possible increase of trade and their Lordships think that on a rough calculation £500 may be added for that, making

£5,000 but as the decree must be in rupees it is equivalent to Rs. 67,000. Their Lordships therefore think that that is in this case the proper figure of damages."<sup>16</sup>

The above ruling was followed in *Sallay Mahomed v. Neogi & Co.*<sup>17</sup> The plaintiffs succeeded in a passing-off action and asked for an account of the profits. But as the defendants had withdrawn from the suit and as an accurate account of the profits would not be possible under the circumstances, the court decided to award damages instead. The learned trial Judge then proceeded to consider the evidence adduced for the purpose of proving the profits made by the defendants by importing and selling the goods wrongly bearing the plaintiffs' mark, and awarded damages upon that basis. On appeal, it was held that the assessment of damages was wrong. Page, C. J., said that it was open to the plaintiffs either to claim an account and prove for this purpose the profits which the defendants had made by the passing-off of their goods for the plaintiffs', or to claim the damages which the plaintiffs had actually suffered by reason of such passing-off. In his opinion the computation in the two cases was different. An estimate of damages based upon the amount of profits that the defendants had made would not be in accordance with law. "The proper way to approach the question as to how much damage the plaintiffs had suffered by reason of the infringement of their mark by the defendants is to ascertain what profit the plaintiffs would have made if the offending articles had not been put upon the Rangoon market, and the best evidence in support of such a claim is evidence of any loss of trade that the plaintiffs had suffered during the period in which the defendants were importing goods with the "Hans" mark on them." It appeared, however, from the facts of that case, that so far from there being a diminution in their sales after the period of infringement the plaintiffs' sales had actually increased during that period.<sup>18</sup> Nor was there any injury to

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(16) There is obviously a numerical error in this calculation. On the basis of computation adopted by their Lordships, 9 per cent. of Rs. 10,00,000 (estimated loss of trade) is Rs. 90,000; adding the extra £500 (equal to Rs. 6,700) for the possible increase of trade the total figure for damages would amount to Rs. 96,700, and not Rs. 67,000 as stated in the judgment of their Lordships.

(17) (1931) A.I.R. 1932 Rang. 56; 10 Rang. 85.

(18) See also *Ledger Sons & Co. v. James Munroe & Son, Ltd.*, (1916) 33 R.P.C. 53, where £100 damages were awarded although there was no material falling-off in the plaintiffs' business due to the defendants' passing-off.

reputation as it was conceded that the defendants' goods were equal in quality to the goods put by the plaintiffs in the market. The court observed: "Nevertheless we are disposed to think that there must have been some loss accruing to the plaintiffs by reason of the importation by the defendants of the 'atta' bearing the 'Hans' mark." A sum of Rs. 1,250 as damages to the plaintiffs was considered to be a fair amount in the circumstances and the decree of the trial court was varied accordingly.

The above cases illustrate some of the difficulties met with in computing damages in trade mark cases. The general rule may be stated as follows: "The damage should be computed on the basis of figures for the estimated falling-off in the plaintiff's trade and not on the basis of figures showing the profits made by the defendant, as the probable loss of the plaintiff need not necessarily be the same figure as that of the profit made by the defendant by the sale of the goods complained of." Where the plaintiff's sales do not show any diminution by the defendant's infringement of his mark, damages may still be awarded by making allowance for a probable increase in the sale of the plaintiff's goods if the spurious goods had not been sold and for the injury which may have been caused to the plaintiff's reputation by the defendant's passing-off. But when we come to the actual question of what figure should be fixed for the damages, "the question is not easy because the matter is very much in the dark."<sup>19</sup> The court has to decide a matter which is problematical and so has to use its discretion. We thus get the interesting situation that in a case where the plaintiffs themselves assessed their damages at Rs. 25,000 the Allahabad High Court awarded Rs. 1,72,000 and the Privy Council reduced it to Rs. 67,000.<sup>20</sup>

#### (iv) *Costs.*

The rules for awarding costs are laid down in the Civil Procedure Code. Sec. 35 provides that the costs of suits shall be in the discretion of the court. But the discretion is a judicial discretion and must be exercised on fixed principles. The general rule is that costs shall follow the event unless the Judge or the court, for good cause, orders otherwise. Where a plaintiff succeeds in a passing-off action, and in no way misconducts himself he is

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(19) *Per Privy Council in Juggilal Kamalapat v. The Swadeshi Mills, Co., Ltd.*, (1928) 56 I.A. 1; 51 All. 182; A.I.R. 1929 P.C. 11; 46 R.P.C. 74.

(20) *Ibid.*

entitled to the costs of the action. It is immaterial that there was no evidence of actual deception, or that the defendant had acted innocently and in ignorance of the plaintiff's rights,<sup>21</sup> or that the suit had been filed without previous intimation being given to the defendant.<sup>22</sup> But an exception will be made where the party successful in the action has established his object by means of an unnecessary and unreasonable litigation.<sup>23</sup> "If the defendant had offered the plaintiffs all they were entitled to," said Romilly, M.R., "and after that the plaintiffs had proceeded in the suit, I most certainly should not have given the plaintiffs a penny of the costs incurred after that period, indeed I should have endeavoured to make them pay them."<sup>24</sup>

In order to escape paying costs of the action the infringer must make a complete submission. These include in the case of an innocent infringer<sup>25</sup> an undertaking to refrain from such passing off, not to sell the spurious goods in his possession without removing the objectionable marks, to give requisite information to enable the plaintiff to stop further infringements and to pay costs of the proceedings up to the time of offer.<sup>1</sup> In a case where the defendant refused to publish an apology while giving the undertaking

(21) *Burgess v. Hills*, (1858) 26 Beav. 244; 53 E.R. 891; *The Collins Co. v. Walker*, (1859) 7 W.R. 222; *Edelsten v. Edelsten*, (1863) 46 E.R. 72; 1 De G. J. & Sm. 185; *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, (1877) 26 W.R. 70; Seb. Dig., p. 351; *Chubb v. Griffiths*, (1865) 55 E.R. 843; 35 Beav. 127; Seb. Dig., p. 150 (defendant an infant acting in ignorance of plaintiff's rights).

(22) *Pierce v. Franks*, (1846) 15 L.J.Ch. 122; *Burgess v. Hately*, (1858) 53 E.R. 894; 26 Beav. 249; *Field v. Lewis*, Seb. Dig., p. 167; *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, (1877) 26 W.R. 70; Seb. Dig., p. 351; *Upmann v. Forester*, (1883) 24 Ch.D. 231.

(23) *Millington v. Fox*, (1838) 40 E.R. 956; 3 My. & Cr. 338; *Colburn v. Simms*, (1843) 2 Hare 543; 67 E.R. 224; *Pierce v. Franks*, (1846) 15 L.J.Ch. 122; *Moet v. Couston*, (1864) 33 Beav. 578; 55 E.R. 493; *Moet v. Pickering*, (1878) 6 Ch.D. 770; 8 Ch.D. 372; *Barnett v. Leuchars*, (1865) 13 L.T. 495; Seb. Dig., p. 149; *Hudson v. Bennett*, (1866) 14 L.T.N.S. 698; Seb. Dig., p. 154; *Upmann v. Elkan*, (1871) 7 Ch. App. 130; 40 L.J.Ch. 475; 41 L.J.Ch. 246; *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, (1912) 106 L.T. 472; 29 R.P.C. 33 and 225.

(24) *Burgess v. Hills*, (1858) 53 E.R. 891; 26 Beav. 244; Seb. Dig., p. 95.

(25) In case of fraud costs of the action may be allowed if the plaintiff proceeds to trial notwithstanding the defendant's complete offer to submit. *Jameson & Son, Ltd. v. Clarke*, (1902) 19 R.P.C. 255 (defendant's goods passed off as plaintiffs' goods of a superior class by fraudulent imitation of one of their labels).

(1) Costs of the suit allowed where the defendant had offered to submit

and the plaintiff proceeded with the case an injunction was granted without costs.<sup>2</sup> But in *Kodak, Ltd. v. Thomas Illingworth & Co., Ltd.*,<sup>3</sup> where the defendants gave an undertaking and damages but declined to give an apology for publication, and the offer was not accepted, Mr. Justice Tomlin held that the plaintiffs were entitled to an injunction with costs of the action.

Costs may be refused to a successful plaintiff because he had claimed too much. So, in a case where the plaintiff who was entitled only to an injunction had claimed an account of profits to which he was not entitled, an injunction was granted but without costs.<sup>4</sup> When a plaintiff succeeds on part of his claim but fails on the most important and expensive issues of the case he may be made to pay to the defendant the whole costs of the suit. But, if the plaintiff substantially succeeds, he is entitled to his costs, though he may not obtain the relief in the exact form in which he asked for. And, if a plaintiff is only partially successful and is held not entitled to all the reliefs asked for, an apportionment of the costs

to an injunction but declined to pay costs up to the time of offer:—*Burgess v. Hately*, (1858) 20 Beav. 249; 53 E.R. 894; *Burgess v. Hills*, (1858) 53 E.R. 891; 26 Beav. 244; *The Collins Co. v. Walker*, (1859) 7 W.R. 222; *McAndrew v. Bassett*, (1864) 46 E.R. 965; 4 De G. J. & S. 380; *Upmann v. Elkan*, (1871) 7 Ch. App. 130; 40 L.J.Ch. 475; 41 L.J.Ch. 246; *Royal Warrant Holders Association v. Kitson, Ltd.*, (1909) 26 R.P.C. 157.

(2) *Hudson v. Bennett*, (1866) 14 L.T. (N.S.) 698. Cf. *Tonge v. Ward*, (1869) 21 L.T. (N.S.) 480, where the defendant's manager without the knowledge of the defendant had affixed the plaintiffs' labels to goods of a third party. The defendant offered to give an undertaking refraining from further infringements and to pay a certain sum but refused to make a public admission that he had used the plaintiff's tickets in order to defraud him. Injunction with costs and an enquiry as to damages were allowed.

(3) (1925) 43 R.P.C. 33, (Plaintiffs proved that several instances of passing-off by the defendants had occurred at the Wembley exhibition). See also *Henry Clay and Bock & Co., Ltd. v. Godfrey Phillips, Ltd.*, (1910) 27 R.P.C. 508. (Defendants' offer to submit subject to a condition as to advertising of the judgment not accepted by plaintiffs. Held that plaintiffs were not bound to accept the condition, and injunction and other reliefs were granted with costs).

(4) *Moet v. Couston*, (1864) 33 Beav. 578; 55 E.R. 493; *Compagnie Laferme v. Hendrickx*, Seb. Dig., p. 304; *Hipkins & Son v. Plant*, (1898) 15 R.P.C. 294; *Magnolia Metal Co. v. Atlas Metal Co.*, (1897) 2 Ch. 371; 14 R.P.C. 389 (Defendants offered an undertaking to refrain from passing off on the second day of the trial but the plaintiffs proceeded with the case. As the plaintiffs were entitled only to an injunction they were given costs up to the second day and were ordered to pay the subsequent costs); *Montgomerie & Co., Ltd. v. Young Brothers*, (1903) 20 R.P.C. 781 (Charge of personal fraud against defendants not established). See also *Calico Printers Association, Ltd. v. Mukerjee*, A.I.R. 1936 Cal. 493.

may be made.<sup>5</sup> So, where both parties advance claims far in excess of their legal rights each party will be made to bear its own costs.

A successful defendant may not be awarded the costs of the action in case of lack of *bona fides* on his part.<sup>6</sup> If a trader imitates another's trade mark and sails so near the wind as just to escape an injunction the court will not give him the costs of the action.<sup>7</sup> A successful defendant cannot be deprived of the costs of the proceedings if the misrepresentation complained of is not connected with the issue between himself and the plaintiff.<sup>8</sup> Where a defendant had made an unfounded charge of fraud, he may not be given the costs of the action, even though he may be successful.<sup>9</sup>

Costs may be refused to a successful plaintiff on account of delay in taking legal proceedings,<sup>10</sup> or on the ground that there had

(5) *Hipkins & Son v. Plant*, (1898) 15 R.P.C. 294 (defendant given costs of the action so far as it asked for damages or account, and plaintiffs the costs of the action so far as it sought relief by way of injunction, such costs to be set off); *Townsend v. Jarman*, (1900) 2 Ch. 698; 17 R.P.C. 649 (Plaintiff failing on one issue, but otherwise successful, ordered to pay costs of such issue, with set off), *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R.P.C. 386; *Findlater, Mackie, Todd & Co. v. (Henry) Newman & Co.*, (1902) 19 R.P.C. 235.

(6) *Ainsworth v. Walmesley*, (1866) 1 Eq. 518; 35 L.J.Ch. 352; *Bass v. Dawber*, (1869) 19 L.T. (N.S.) 626; *Edgington v. Edgington*, (1864) 10 L.T.N.S. 299; Seb. Dig., p. 138; *The Leather Cloth Co. v. Lorsche*, (1869) 9 Eq. 345; 39 L.J.Ch. 86; *Rodgers v. Rodgers*, (1874) 31 L.T.N.S. 285; *Estcourt v. The Estcourt Hop Essence Co.*, (1875) 10 Ch. App. 276; 44 L.J.Ch. 223; *Robineau v. Charbonnel*, (1876) W.N. 160; Seb. Dig., p. 297, *Wylam v. Clarke*, (1876) W.N. 68; Seb. Dig., p. 292; *The Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*, (1865) 11 E.R. 1435; 11 H.L.C. 523; *Thorneloe v. Hill*, (1894) 1 Ch. 569; 11 R.P.C. 61; *Meaby & Co., Ltd. v. Triticine, Ltd.*, (Passing-off action dismissed without costs, the defendants having kept back material matters) (1898) 15 R.P.C. 1; *Warsop & Sons, Ltd., v. Warsop*, (wrongful use by defendant of the word 'registered') (1904) 21 R.P.C. 481.

(7) *Bass v. Dawber*, (1869) 19 L.T. (N.S.) 626; *Lambert & Butler, Ltd. v. Goodbody*, (1902) 18 T.L.R. 394; 19 R.P.C. 377, *Lever Brothers, Ltd. v. Beddingfield*, (1898) 80 L.T. 100; 16 R.P.C. 3 (defendant having provoked the litigation).

(8) *King & Co., Ltd. v. Gillard & Co., Ltd.*, (1905) 2 Ch. 7; 21 R.P.C. 589; 22 R.P.C. 327 (False statement by the defendant that his goods had obtained certain medals and awards).

(9) *Hargreaves v. Freeman*, (1891) 3 Ch. 99; 8 R.P.C. 237.

(10) *Beard v. Turner*, (1866) 13 L.T. 746; Seb. Dig., p. 147; *Talbot's Tm. case*, (1894) 63 L.J.Ch. 264; 11 R.P.C. 77 (Application to expunge trade mark).

been only isolated and trivial instances of passing off,<sup>11</sup> or on the ground of misrepresentation.<sup>12</sup> In such cases the plaintiff may be, sometimes, ordered to pay the costs of the action. Separate orders as to costs may be made where one of the defendants had infringed the mark innocently.<sup>13</sup> Costs may not be awarded in full where the plaintiff's case has been overlaid with multiplication of evidence or evidence that is of no value for the case.<sup>14</sup>

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(11) *John Knight and Sons, Ltd. v. Crisp & Co., Ltd.*, (1904) 21 R.P.C. 670; *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, (1912) 106 L.T. 472; 29 R.P.C. 33 & 225 (Passing-off by inadvertance and undertaking offered); *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R.P.C. 218; *Rose v. Loftus*, (1878) 47 L.J.Ch. 576; *Leahy, Kelly & Leahy v. Glover*, (1893) 10 R.P.C. 141 (single act by servant, since discharged; plaintiff ordered to pay costs); *Burberrys v. Watkinson*, (1906) 23 R.P.C. 141 (single instance, action dismissed without costs).

(12) *Morgan v. McAdam*, (1866) 36 L.J.Ch. 228 (misrepresentation that the goods were covered by patent); *Newman v. Pinto*, (1887) 57 L.T. 31; 4 R.P.C. 508. (Plaintiff carrying on fraudulent trade; action dismissed without costs.)

(13) *Champagne Heidsieck et cie v. Scotto & Bishop*, (1926) 43 R.P.C. 101.

(14) See observations of Kekewich, J., in *Sazlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; 14 R.P.C. 645; See also *Daimler Motor Co., (1904), Ltd. v. London Daimler Co., Ltd.*, (1907) 24 R.P.C. 379 (only half the costs of the evidence allowed).

## CHAPTER VIII.

### DEFENCES.

The various forms of defence in a passing-off action have already been indicated in Chapter VI. It may, however, be convenient to group together in this Chapter these, and other special forms of defence that may be set up in passing-off cases. They may be classified as follows:—

- (1) that the plaintiff has no exclusive title to the mark;
- (2) that the plaintiff's title is qualified by the defendant's right to concurrent user;
- (3) that the trade mark in question is not valid;
- (4) that the plaintiff has not established any passing-off by the defendant;
- (5) that the plaintiff is not entitled to relief on account of some personal estoppels, acquiescence, delay or use of deceptive marks.

**Denial of plaintiff's title.**—In order to succeed in an action for passing-off the plaintiff must first establish his exclusive title to the mark in question. Where the plaintiff claims the right to the mark by assignment or purchase, the assignment or sale must be valid. The essential requirements to constitute a valid transfer of a trade mark have already been pointed out in Chapter V. Unless the court is satisfied about the plaintiff's title to the mark it may not proceed further in the matter. The very first defence which is likely to be set up in passing-off actions will, therefore, be to question the plaintiff's title unless the defendant is satisfied that the plaintiff's title, cannot be safely attacked. In the absence of a Registration Act the plaintiff will have to establish his title by adducing evidence of prior exclusive user, which, as already pointed out, is often a matter of great difficulty in India.<sup>1</sup>

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(1) This difficulty is responsible for several vexatious suits in India. See Chapter II, where this question is discussed.



**Concurrent user.**—In exceptional cases it is possible that the goods of the plaintiff as well as of the defendant are known under the same name in the market. In such cases of honest concurrent user the defendant has an equal right with the plaintiff to sell his goods under the mark or name in question, and the plaintiff cannot then successfully sue the defendant for passing-off.<sup>2</sup> The reason is obvious. As Kekewich, J., said:—"In order to constitute an actionable wrong—a wrong where a plaintiff complains of something being done—you must find a duty on the part of the defendant towards the plaintiff to abstain from doing that which is complained of. That seems to me to be undoubted law."<sup>3</sup> And, where the defendant proves that he had been honestly using the mark concurrently with the plaintiff there cannot be any legal duty on the defendant's part to abstain from using the mark in connection with his goods, and the plaintiff has therefore no ground of action.

**Volume of defendant's business immaterial.**—The right to concurrent use is not affected by the relative volumes of business of the plaintiff and the defendant. The right of the defendant will be recognised although his trade may be small compared with the plaintiff's. Again, a plaintiff cannot complain if his own extensive advertisement resulted in bringing more custom to the defendant having the right of concurrent user. This point was fully discussed in the well-known Dolly blue case<sup>4</sup> The defendant company bought the business of Edge whose blue was known among the retailers as "Dolly blue." The plaintiffs who had been selling "Dolly blue" brought an action for passing-off. It was shown that the plaintiffs as well as the defendants had the right of concurrent user in the words "Dolly blue" and that when the plaintiffs commenced business the defendant had warned them that their blue was already known

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(2) See for instance *Claudius Ash, Sons & Co., Ltd. v. Invieta Manufacturing Co., Ltd.*, (1912) 28 R.P.C. 597; 29 R.P.C. 465; where the defendants' claim to the right of concurrent user of the trade name, "G. Stent" was successful; *Godfrey Phillips & Sons v. Thos. Ogden & Co., Ltd.*, (1895) 12 R.P.C. 325.

(3) *Findlater, Mackie, Todd & Co. v. Henry Newman & Co.*, (1902) 19 R.P.C. at p. 241.

(4) *Edge & Sons, Ltd. v. Gallon & Son*, (1899) 16 R.P.C. 509; (1900) 17 R.P.C. 557. See also *Godfrey Phillips and Sons. v. Thos. Ogden & Co., Ltd.*, (1895) 12 R.P.C. 325; *Goddard v. Hyam and Goddard*, (1918) 35 R.P.C. 21; *Goddard v. The Watford Co-operative Society, Ltd.*, (1924) 41 R.P.C. 218.

in the market as "Dolly blue." Injunction was refused by the Court of Appeal and this decision was affirmed by the House of Lords. It was held that if the effect of the plaintiffs' large advertisements had been to increase the sale of the goods of the defendant who was a concurrent user the former could not complain of that. Lord Halsbury said: "Although Edge, may, perhaps, and I think very likely has had, the larger use of this word, and although Edge's advertisements probably have produced a larger sale not only of his own blue but also of Ripley's blue, yet the final conclusion in my mind is that there has been such efficient user of the name as applicable to Ripley's as well as to Edge's that it is fatal to the claim of Edge to maintain a right to the exclusive use of the word."

**Use must be sufficient.**—But the concurrent user must be sufficient to justify the court to protect the defendant from being forced to give up his right in the mark. If the alleged concurrent user had been merely trivial or spasmodic, or had been abandoned, the defendant's claim will not be recognised. *Daniel and Arter v. Whitehouse and Britton*<sup>5</sup> is an illustrative case. The plaintiffs were selling forks and spoons made of a special alloy under the fancy name "Brazilian Silver," and their trade became very large and important. The first defendant Whitehouse commenced at about the same time as the plaintiffs to sell the same class of goods under the above trade name. At first his trade was substantial but after a few years it began to dwindle until it rapidly came down to one or two sales a year and finally ceased altogether for at least one year. Whitehouse then began to sell his goods under the trade name "Brazilian Silver" to Britton whereupon the plaintiffs brought an action for passing-off. In granting an injunction Mr. Justice Barnes said: "It seems to me that if a trade drops out of the use of a party, as it has done in this case out of the defendants' use, and while that state of things prevail another gains the reputation in the trade for goods made under the particular name, and his name is associated with the mark and the mark associated with his name, so that all who deal in the goods consider that when they see the mark they see goods made by the plaintiff, then the original position of the competitor using the same mark has practically disappeared."

The court would require clear and unambiguous proof of the defendant's honest concurrent user in the same market. In *Moolji*

*Sicca & Co. v. Ramjan Ali*<sup>6</sup> the defendants' alleged claim for the right of concurrent user could not be proved, and injunction was accordingly granted. Page, J., said: "The defendant no doubt has sold large quantities of biris since 1919 with the labels Exhibit 10 and Exhibit 11 and he claims a concurrent right to use those labels with the plaintiff's right to use Exhibit T. I adopt the language of Lord Justice James. 'It has been said that one murder makes a villain, and millions a hero;' but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasions of his neighbour's rights is to convert his piracy into a lawful trade. That ground of defence, therefore, in my judgment, fails: *Ford v. Foster*, (1872) 7 Ch. 625.' In no event, however, could the defendant have a concurrent right to use Exhibits 10 and 11 for it is conceded that in order to establish a concurrent right it was essential for the defendant to prove prior user."

**Right must vest in defendant.**—The right to honest concurrent user must be that of the defendant and not that of a third party. In the latter case the defence could only take the form that the mark had become *publici juris* or common to the trade and that the plaintiff could not consequently seek to restrain the defendant from using the mark. The plaintiff might then reply that the limitation on his exclusive title is only that of concurrent user.<sup>7</sup> But, where the existence of concurrent user is proved it will generally be difficult for the plaintiff to establish that the use of his mark by other persons will be calculated to deceive. For, as Vaughan Williams, L. J., said: "The moment it is admitted that the goods of more traders than one are denoted by the same name, you have gone a long way towards disposing of the assertion that the particular name is understood in the trade to denote the goods of the plaintiff, and you have gone a long way to negative the suggested case of deception charged against the defendant by reason of his user of this name."<sup>8</sup>

**Partnership and personal name.**—The right to concurrent user may arise when on dissolution of partnership the goodwill of a business is divided.

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(6) A.I.R. 1930 Cal. 678.

(7) *Dent v. Turpin*, (1861) 2 John & W. 139; 70 E.R. 1003; 30 L.J.Ch. 495.

(8) *Jamieson & Co. v. Jamieson*, (1898) 14 T.L.R. 160; 15 R.P.C. at p. 193.

The circumstances under which a partner may use the trade name or mark of the old business along with the other partners on dissolution of partnership<sup>9</sup> and those under which a person may honestly use his own name for trade,<sup>10</sup> notwithstanding the existence of other businesses under the same name have already been discussed in Chapters V and VI.

**The plaintiff's mark is not a valid trade mark.**—The validity of the plaintiff's mark would often be the most useful point of attack for the defendant. The elements that are necessary to constitute a valid trade mark have already been discussed in detail in Chapters IV and VI. Where the mark is neither inherently distinctive nor has acquired a secondary signification the plaintiff will not be entitled to its exclusive use. Again, a mark which was originally distinctive might have lost its distinctiveness and become *publici juris*.<sup>11</sup> Such marks are common to the trade and cannot be exclusively claimed by any person. Or, a word may be purely descriptive, geographical or laudatory or the infringement may be limited to matter common to the trade.<sup>12</sup> The plaintiff's claim that his mark is a valid one may thus be disputed by the defendant under one or more of these grounds.

**The defendant's act does not amount to passing-off.**—The various requirements to constitute an action for passing-off have already been discussed at length in Chapter VI. It has been pointed out that the court will not interfere unless the defendant's mark is calculated to deceive. A mere trade puff, for instance, is not actionable. How far the element of fraud is essential in a passing-off action has been dealt with in detail in that Chapter. Although no definite test could be laid down as to whether a particular mark is a colourable imitation of another, certain general considerations which are likely to influence the court in deciding this question have been mentioned. Again, it was pointed out that while a person has a *prima facie* right to use his name for trade purposes certain restrictions may be put on him in exercising

(9) See Chapters V, VI and IX.

(10) See Chapter VI.

(11) *Wolff v. Nopitsch*, (1900) 17 R.P.C. 321; 18 R.P.C. 27 (action for passing-off dismissed); *National Starch Manufacturing Co. v. Munn's Patent Malsena and Starch Co.*, (1894) A.C. 275; 11 R.P.C. 281; *Woodward, Ltd. v. Boulton Macro, Ltd.*, (1915) 85 L.J.Ch. 27; 32 R.P.C. 173 (action for passing-off dismissed but action for infringement of trade mark allowed as the mark was distinctive at the time of registration).

(12) See Chapters IV and VI.

this right. The circumstances under which such restrictions are likely to be put were also dealt with. It was also mentioned that relief may be refused where there have been only isolated acts of passing-off.<sup>13</sup> These and other topics discussed in some of the foregoing Chapters afford the defendant a number of important and useful grounds of defence.

**Master and servant.**—An employer is generally liable for the acts of his servant.<sup>14</sup> Injunction may be granted even in cases where the servants had acted contrary to the instructions of the master. But where there had not been any actual fraud and the passing-off had been accidental or inadvertent on the part of a careless shopman, the employer having since taken all reasonable precautions to avoid recurrence of such passing-off, an injunction may be refused.<sup>15</sup>

#### Other defences.

**Estoppel by conduct.**—The rule as to estoppel by conduct may be stated as follows: Where a plaintiff finds that in a matter concerning his rights the defendant has been acting, acts, or is likely to act in a manner, that as a reasonable man he would not do if he were cognizant of the real facts, there is a duty cast on the plaintiff to apprise the defendant of the real facts and take early effective steps to prevent such infringement of the plaintiff's rights. If the plaintiff, however, fails to take such immediate action but stands by and acts in a manner which is calculated to lead the defendant to believe that he is not in any manner violating the rights of the plaintiff the Court of Equity will not interfere if the plaintiff complains later of the defendant's act. The doctrine of estoppel by conduct is thus based on the well-known equity maxims that he who comes to equity must do equity and must come with clean hands. It may be pointed out that in these cases if the plaintiff has a right to the exclusive use of the mark the court does not

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(13) See Chapter VII. *Rutter & Co. v. Smith*, (1901) 18 R.P.C. 49; *Burberrys v. Watkinson*, (1906) 23 R.P.C. 141; *Armstrong Oilier Co., Ltd. v. Patent Axlebox and Foundry Co., Ltd.*, (1910) 27 R.P.C. 362; *Knight (John) & Sons, Ltd. v. Crisp & Co., Ltd.*, (1904) 21 R.P.C. 670.

(14) *Coppen v. Moore*, (1898) 2 Q.B. 300, 306; *Grierson, Oldham & Co., Ltd. v. Birmingham Hotel & Restaurant Co., Ltd.*, (1901) 18 R.P.C. 158; *Cusenier Fils & Co. v. Gaiety Bars, & Co., Ltd.*, (1902) 19 R.P.C. 357; *Havana Cigar & Tobacco Factories, Ltd. v. Tiffin*, (1905) *Ld.*, (1906) 26 R.P.C. 473; *Bovril, Ltd. v. Bodega Co., Ltd.*, (1916) 33 R.P.C. 153.

(15) *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, (1912) 106 L.T. 472; 29 R.P.C. 33, 235; See also *Kodak, Ltd. v. Grenville*, (1908) 25 R.P.C. 416.

cease to recognise such general rights, but the estoppel will operate against the specified person to the extent to which the plaintiff had acquiesced, either expressly or impliedly.

**Test of acquiescence.**—In order to prove acquiescence it is essential to show that the plaintiff was aware of the violation of his rights and that the defendant was deluded by the plaintiff's act into thinking that the infringement was assented to by the plaintiff. "There can only be acquiescence" declared Malins, V. C. "where there is knowledge. This court never binds parties where there is no knowledge."<sup>16</sup> And, Bowen, L. J., said: "In order to make out such acquiescence it is necessary for them to establish that the plaintiff stood by and knowingly allowed the defendants to proceed and to expend money in ignorance of the fact that he had rights and that he meant to assert such rights."<sup>17</sup> The onus of proof lies on the defendant alleging acquiescence. Mere knowledge of the infringement and delay in taking legal action after the knowledge had come to the plaintiff are not by themselves enough. It must be shown further that the plaintiff's conduct was extremely unfair, "conduct which would shock a man's conscience."

The test of acquiescence was laid down in *Willmott v. Barber*<sup>18</sup> by Fry, J., in the following passage: "In the first place the plaintiff must have made a mistake as to his legal rights. Secondly, the plaintiff must have expended some money or must have done some act on the faith of his mistaken belief. Thirdly, the defendant, the possessor of the legal right, must know of the existence of his own right which is inconsistent with the right claimed by the plaintiff. If he does not know of it, he is in the same position as the plaintiff and the doctrine of acquiescence is founded upon conduct with a knowledge of your legal rights. Fourthly, the defendant, the possessor of the legal right must know of the plaintiff's mistaken belief of his rights. If he does not, there is nothing which calls upon him to assert his own rights. Lastly, the defendant, the possessor of the legal right must have encouraged the plaintiff in his expenditure of money or in the other acts which he has done, either directly or by abstaining from asserting his legal rights. Where all these elements exist, there is fraud of such a nature as will entitle the court to restrain the possessor of the legal right

(16) *Weldon v. Dicks*, (1878) 10 Ch.D. 247; Seb. Dig., p. 391.

(17) *Proctor v. Bennis*, (1887) 36 Ch.D., at p. 761.

(18) (1880) 15 Ch.D. 96; (1881) 17 Ch.D. 772.

from exercising it but in my judgment nothing short of this will do."

**Not applicable in case of fraud.**—The doctrine of acquiescence does not therefore apply in cases of fraud. Where the defendant is fully aware of the legal right of the plaintiff and yet deliberately and fraudulently imitates the plaintiff's mark in order to pass off his goods the doctrine of acquiescence will not operate in favour of the defendant.<sup>19</sup> As Cotton, L. J., said, in *Proctor v. Bennis*,<sup>20</sup> "it is necessary that the person who alleged this lying by should have been acting in ignorance of the title of the other man, and that the other man should have known that ignorance and not mentioned his own title." In *Moolji Sicca & Co. v. Ramjan Ali*,<sup>21</sup> Page, J., stated thus: "Acquiescence is only a form of estoppel, and it is of the essence of acquiescence that the party acquiescing should be aware of and by words or conduct should represent that he assents to what is a violation of his rights, and that the person to whom such representation is made should be ignorant of the other party's rights, and should have been deluded by the representation into thinking that his wrongful action was assented to by the other party."

**Illustrative cases.**—In *Hogg v. Maxwell*<sup>22</sup> injunction to restrain the defendant from using the name "Belgravia" as the title of a new magazine was refused on the ground that the plaintiffs had received and inserted in some of their publications advertisement of the defendant's forthcoming magazine under the above title at a time when they themselves were bringing out their own magazine under the same name. In *Oldham v. James*<sup>23</sup> the claims in respect of past infringements of the mark "Lieutenant James' blistering compound" had been compromised between the parties. It was held that the estoppel applied only to sales which had already taken place and not to future sales even though the spurious goods had been bought before the date of the agreement, the reason being that it would otherwise involve a continuing fraud on the public. In *Burgoyne & Co., Ltd. v. Godfree & Co.*,<sup>24</sup> the plaintiffs were the

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(19) *Mohideen Bawa v. Bigaud Perfume Manufacturers*, A.I.R. 1932 Rang. 114; 10 Rang. 133.

(20) (1887) 36 Ch.D. 740.

(21) A.I.R. 1930 Cal. 678.

(22) (1867) L.R. 2 Ch. 316; Seb. Dig., p. 158.

(23) (1863) 13 Ir.Ch. 393; 14 Ir.Ch. 81; Seb. Dig., p. 117.

(24) (1905) 22 R.P.C. 168. See also *Ripley v. Bandey*, (1897)

owners of the mark "Burgoyne" for wine. The wine in the original casks bearing that mark had been consigned to them on approval and was rejected. It was then sold by the plaintiffs themselves in auction on behalf of the growers. An action for passing off was brought against the defendants who had bought the wine and sold them as "Burgoyne." It was held that the plaintiffs were not entitled to recover any damages from the defendants because the "damage which was caused to them was mainly brought about by their own lamentable mistake in selling this wine at a public auction in a guise from which the trade and everybody else would naturally assume that it was their own wine." In *Coles Proprietary, Ltd. v. Need*<sup>25</sup> the plaintiff company owning a number of stores licensed the use of its trade name in a particular locality to a retail shop owner for the purpose of selling goods supplied by it. Owing to the licensors' inability to supply all the goods the licensee with the licensors' consent purchased other goods and had been selling them under the plaintiffs' trade name. Subsequently the licence was cancelled but the defendant continued to use the trade name. It was held by the High Court of Australia that although the plaintiff company was *prima facie* entitled to the injunction, it was debarred by its conduct from an equitable remedy. The decision was reversed on appeal to the Privy Council, where their Lordships held that there was no fraud in the original grant of the licence and that the continuance of the trade name by the defendant after the termination of the licence amounted to passing off. On the other hand, in *Somerlite Ltd. v. Brown*,<sup>1</sup> where the defendant had been selling formerly the plaintiffs' "Somerlite" oil but subsequently began to sell other oil as "Somerlite" oil with the knowledge but without the consent of the plaintiffs, an action for passing-off was dismissed. In *Lavergne v. Hooper*<sup>2</sup> the defendant was selling in the Madras market brandy imported from the plaintiff firm in France. The defendant had selected a particular trade mark consisting of a Maltese Cross and had asked the plaintiffs to apply

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14 R.P.C. 591, where the action was dismissed owing to the neglect of the plaintiff to assert his rights on three instances of infringement of his mark (oval blue) which were brought to his notice and in one of which the infringer had expressly declined to discontinue using the mark.

(25) (1933) 50 R.P.C. 379; *Bile Bean Manufacturing Co., v. Davidson*, (1906) 23 R.P.C. 725; *Ford v. Foster*, (1872) L.R. 7 Ch. 611, distinguished.

(1) (1934) 51 R.P.C. 205.

(2) (1884) 8 Mad. 149.



it to casks of brandy supplied to him. It was clearly understood that this mark belonged to the defendant, though the mark had been registered in England in the name of the plaintiffs. The defendant, under the honest belief that the mark belonged to him, and with the tacit approval of such belief by the plaintiffs, had extensively advertised the mark. The defendant had also on several occasions sold under that mark wines imported from other sources, and although the plaintiffs were aware of such sales the latter did not take any steps to prevent them. The plaintiffs were estopped from denying the defendant's right to use the mark in the Madras market.

**Delay.**—In case of infringement of a trade mark the period of limitation in India to sue for an injunction and for compensation is six years and three years, respectively,<sup>3</sup> from the date of infringement; but so long as the infringement continues a fresh cause of action arises *de die diem*.<sup>4</sup> Mere delay, if within the period prescribed by the Indian Limitation Act, is not sufficient to deprive a plaintiff in a passing-off action, of his legal right,<sup>5</sup> to an injunction.

Where the delay in taking legal action after knowledge of the infringement is long and unreasonable it may amount to acquiescence or abandonment and constitute an estoppel. Even in the absence of such estoppel delay may operate adversely to the plaintiff. Thus, where there is inordinate delay on the part of the plaintiff to take legal proceedings after becoming aware of the infringement of his rights and such delay is not satisfactorily explained an interlocutory injunction may be refused,<sup>6</sup> or the

(3) Articles 120 and 113 respectively of the Indian Limitation Act, 1908.

(4) *Abdul Salam v. Hamidullah*, (1912) 15 I.C. 116; 166 P.W.R. 1912.

(5) See the following observations of Fry, J., in *Fullwood v. Fullwood*, (1878) 9 Ch.D., p. 178. "The right asserted by the plaintiff in this action is a legal right. . . . It is clear that such an action is subject to the Statute of Limitations. . . . In such a case the injunction is a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit."

(6) "The effect of delay upon an application for interlocutory relief is wholly different from its effect, if any, in relation to final judgment."

damages' or account may be limited to those arising from infringements after filing the bill and may not extend to past infringements. Or, an order for delivery up may be refused,<sup>8</sup> though an injunction is granted. Or, again, costs may be refused, even though the plaintiff is successful.<sup>9</sup>

Delay will not be a bar to relief where the infringement had been originally committed with fraudulent intent and is continuing. In *Rodgers v. Rodgers*,<sup>10</sup> Lord Justice Mellish said: "I do not think that, as a matter of law, the mere fact that the mark has been used for a great number of years necessarily affords defence. If it was clearly made out that it was originally used for the purpose of fraud, and that it has the practical effect of deceiving the public, I do not think that the lapse of years would prevent the plaintiffs from having a remedy."

Where the plaintiff's delay in taking legal action is relied upon by the defendant as his defence it must be shown that such delay has prejudiced him materially, as for instance, in the matter of producing his evidence before the court. So, Farwell, J., said:—"Delay, no doubt, may in some cases be sufficient to prevent an applicant from obtaining relief, but so far as I can see the only case in which delay ought to have that effect is when the respondent has been put to serious disadvantage by the loss of his evidence or the like in consequence of the laches of the applicant. . . . Unless the action or neglect of an applicant has put the respondent at some unfair disadvantage, it appears to me that his laches is sufficiently visited by punishment in the way of getting no costs if he should succeed."<sup>11</sup>

**Delay may be explained.**—A certain amount of delay in instituting legal proceedings after the discovery of the infringement is often unavoidable; and may be satisfactorily explained.<sup>12</sup>

Tomlin, J., in *Reliance Rubber Co., Ltd. v. Reliance Tyre Co., Ltd.*, (1925) 42 R.P.C. at p. 100. See also *Fullwood v. Fullwood*, (1878) L.R. 9 Ch.D. 176.

(7) *Reddaway & Co., Ltd. v. Robert Stevenson & Brother, Ltd.*, (1903) 20 R.P.C. 276.

(8) *County Chemical Co., Ltd. v. Frankenburg*, (1904) 21 R.P.C. 722.

(9) See *Addley Bourne's Application*, (1903) 1 Ch. 211; 20 R.P.C. 114, Farwell, J.

(10) (1874) 31 L.T.N.S. 285; Seb. Dig., p. 265.

(11) *Addley Bourne v. Swan and Edgar, Ltd.*, (1903) 1 Ch. 211; 20 R.P.C. at pp. 114, 115.

(12) *Lee v. Haley*, (1869) 39 L.J.Ch. 284; 5 Ch. App. 155; *Fullwood v. Fullwood*, (1878) L.R. 9 Ch.D. 176; *Rowland v. Mitchell*, (1897) 1 Ch. 71;

For instance, the plaintiff might find that the sale of the spurious goods was small and that there was reasonable cause to believe that the infringement would not be repeated. Thus, in *Reliance Rubber Co., Ltd. v. Reliance Tyre Co., Ltd.*,<sup>13</sup> Mr. Justice Tomlin said that the delay between the first complaint and the issue of the writ was due to the plaintiffs' desire to afford the defendants a means of retreat and in part to circumstances which the plaintiff company could not well control. In *Mohideen Bawa v. Rigaud Perfume Manufacturers*,<sup>14</sup> the court said that it was but reasonable that some time should elapse for the local representative to get the sanction of the head office in France before he could launch legal proceedings in Burma where the infringement took place, and that the delay in the circumstances did not disentitle the plaintiffs to relief.

**Abandonment.**—Where there are notorious infringements of a person's trade mark and he neglects to assert his legal rights the mark may be held to have been abandoned. The owner of a trade mark must not adopt a "sort of Rip Van Winkle policy of going to sleep and not watching what his rivals or competitors in the same line of business were doing;"<sup>15</sup> but must always be on the alert to see whether his rights are infringed by any of his rivals. He should not be standing by while his competitor is building up his business and come at a later stage and say that his mark was being infringed. The object of this rule is clear from the following passage of Eve, J., in his judgment in the Prophylactic case:<sup>16</sup> "I accept the evidence of any gentleman who comes into the box and gives his evidence in a way which satisfies me that he is speaking the truth when he says that he did not know of the existence of a particular element or a particular factor in the goods marked by his opponents. But the question is a wider question than that: Ought not he to have known? Is he entitled to shut his

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13 R.P.C. 457; 14 R.P.C. 37; *Hayward Bros., Ltd. v. Peakall*, (1909) 26 R.P.C. 89; *Daniel and Arter v. Whitehouse and Britton*, (1898) 1 Ch. 685; 15 R.P.C. 134; *Unani Dawakhana v. Hamdard Dawakhana*, (1930) 12 Lah. 224; A.I.R. 1930 Lah. 999; *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461; *Moolji Sica & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678; *Radio Rentals, Ltd. v. Rentals, Ltd.*; (1934) 51 R.P.C. 407.

(13) (1925) 42 R.P.C. at p. 99.

(14) 10 Rang. 133; A.I.R. 1932 Rang. 114.

(15) *Per Eve, J., in Cordes v. Addis and Son*, (1923) 40 R.P.C. at p. 142.

(16) *Cordes v. Addis & Son*, loc. cit.

eyes to everything that is going on around him, and then when his rivals have perhaps built up a very important trade by the user of *indicia* which he might have prevented their using had he moved in time, come to the court and say: "Now stop them from doing it further, because a moment of time has arrived when I have awakened to the fact that this is calculated to infringe my rights?" Certainly not. He is bound, like everybody else who wishes to stop that which he says is an invasion of his rights, to adopt a position of aggression at once, and to insist, as soon as the matter is brought to his attention, or as soon as, in the opinion of the court, it ought to have come to his attention, to take steps to prevent its continuance; it would be an unsufferable injustice were the court to allow a man to lie by, while his competitors are building up an important industry and then to come forward, so soon as the importance of the industry has been brought home to his mind, and endeavour to take from them that of which they had legitimately made use; every day which they used it satisfying them more and more that there was no one who either could or would complain of their so doing. The position might be altogether altered had the use of the factor or the element in question been of a secretive or surreptitious nature, but, when a man is openly using, as part of his business, names or phrases, or other elements, which persons in the same trade would be entitled, if they took steps, to stop him from using, he gets in time a right to use them which prevents those who could have stopped him at one time from asserting at a later stage their right to an injunction."

**Test of abandonment.**—But the occurrence of a few fraudulent infringements without the knowledge of the plaintiff would not form sufficient ground for demurrer. Nor would the copying of a few non-essential features of the mark by a number of traders constitute an abandonment of the whole mark. The question of abandonment is essentially one of intention and would depend upon the circumstances of the case.<sup>17</sup>

In *Thorneloe v. Hill*<sup>18</sup> a firm of watch makers had granted to another firm for seven years a licence to put their mark upon watches and after expiration of the licence practically ceased themselves to sell or manufacture watches so marked. It was held that

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(17) *Mouson & Co. v. Boehm*, (1884) L.R. 26 Ch.D. 398; *Lavergne v. Hooper*, (1884) 8 Mad. 149; *Hart's Tm.*, (1902) 2 Ch. 621; 19 R.P.C. 569.

(18) (1894) 1 Ch. 569; 63 L.J.Ch. 331.

the firm lost all right to restrain others from marking their watches with the particular mark and could not, therefore, assign any such rights.

The rule was stated by Kekewich, J., thus<sup>19</sup>:—"I do not myself see how it is any answer to a man who comes forward to establish a common law trade mark to say that, sometime after your character was established and your goods were known, and your money, time and ingenuity have been expended, perhaps in large advertisements and otherwise, others began to use it, and so, because they began to use it after your rights had been ascertained, it is in common use. That seems to me to be an argument which contradicts itself in the mere statement. When once appropriation has been made, common use becomes impossible; until the person entitled to the trade mark allows others to use it so as to forfeit his right to appropriate the term, and so the words sink again into common use, from which, of course, after that, they cannot be revived. But, until something of that kind has happened, it seems to me that words once appropriated cannot be said to be words in common use, merely because others who, *ex concessis* on the mere statement, are trespassers, have attempted to use those words subsequently."

Where the defendant contends that the trade mark in question has been abandoned the onus of proof is on the defendant to establish the abandonment.<sup>20</sup> No particular length of time is required for the abandonment of a mark.<sup>21</sup>

**Not necessary to prosecute every infringer.**—Under certain circumstances the plaintiff may be justified in not taking legal steps against a particular infringer. Such failure to prosecute the infringer may not be construed as an intention to abandon the mark or as acquiescence. The plaintiff must be guided by reason and good sense in taking legal proceedings against the infringer. In many cases the infringer may be impecunious or the infringement may be small<sup>22</sup> or may have stopped so that the plaintiff may not think it worth his while to take legal proceedings. In *Rowland*

(19) *Ripley v. Bandey*, (1897) 14 R.P.C. 591.

(20) *Noor Ilahi-Maqbul Ilahi v. Wood & Co.*, 9 Lah. 487; A.I.R. 1928 Lah. 924.

(21) *Lavergne v. Hooper*, (1884) 8 Mad. 149; *Jagarnath & Co. v. Cresswell*, (1913) 40 Cal. 814.

(22) *Daniel and Arter v. Whitehouse and Britton*, (1898) 1 Ch. 685; 15 R.P.C. 134. (The plaintiffs showed that there was only sale of a sample lot that was not worth troubling about.)

v. *Michell*<sup>23</sup> the defendant contended that one Hoskins, formerly in the employ of the plaintiff had been selling cough tablets under the plaintiff's mark and that as the plaintiff, although cognizant of the infringement had not taken any action he had lost his right to the mark. The plaintiff explained that he did not think Hoskins worth "powder and shot" and that as he had lost sight of him after the infringement he came to the conclusion that Hoskins had dropped out. In granting an injunction restraining passing off, Lord Russell, C.J., observed: "It cannot be stated as a general proposition in respect of a person, irrespective of the character of the trade done, and the extent of that trade, irrespective of the position and impecuniosity of that person, that the moment it comes to the knowledge of a manufacturer that somebody has been trying to do a fraudulent thing on his part, he is bound to take proceedings, or if he does not take proceedings, it is concluded against him that he means to acquiesce in the right of that other person to continue to do as he has been doing."

In *Moolji Sicca & Co. v. Ramjan Ali*<sup>24</sup> the plaintiff had warned the infringer, a petty dealer, and the latter had agreed to discontinue selling the spurious goods and sell only the plaintiffs' biris. But in violation of this agreement the defendant passed off other goods for the plaintiffs' on two subsequent occasions and the suit was filed within three years after the last infringement. Notwithstanding the plaintiffs' failure to take legal action in the earlier cases injunction was granted by Page, J., who observed: "It may not be worth while to spend money on every man of straw who comes in your way, and in my opinion it was natural and reasonable that the plaintiffs in 1919 having obtained the undertaking from the defendant, and finding that the defendant was prepared apparently to make good his promise to purchase goods from them, should refrain from taking further steps, in the hope that the defendant in the future would not violate their rights."

**Licence.**—Where the owner of a trade mark has permitted the use of his mark under a licence, an action for passing-off will not be maintainable against the licensee.<sup>25</sup> Although under common law such licence would not be valid without the transfer

(23) (1897) 1 Ch. 71; 13 R.P.C. 457; 14 R.P.C. 37.

(24) A.I.R. 1930 Cal. 678. See also *Abdul Kareem Sahib v. Abdul Kareem Sahib*, A.I.R. 1931 Mad. 461.

(25) *Kinahan v. Bolton*, (1863) 15 Ir.Ch. 75; Seb. Dig., p. 132. Plaintiffs who were the proprietors of "LL" mark on whiskey obtained an injunction as acquiescence was not established.

of the business, the licence would be regarded as proof of acquiescence on the plaintiff's part and would constitute an estoppel. Similarly, a licensee cannot question the validity of the trade mark or the validity of its assignment as against the licensor in an action claiming royalty.<sup>1</sup>

**Covenants in restraint of trade.**—Among other estoppels which may be raised in defence, mention may be made of covenants in restraint of trade. This topic will be discussed in greater detail in Chapter IX. In general, it may be said that a covenant in restraint of honest competition is void under Sec. 27 of the Indian Contract Act. Certain exceptions are, however, provided under this Act. Exceptions (2) and (3) dealing with covenants in restraint of trade in case of partnership have been repealed and re-enacted as Secs. 36 (2) and 55 (3) of the Indian Partnership Act. An outgoing partner may bind himself not to carry on a competitive business within a specified time or area and such agreement will be operative if the restrictions are reasonable. Similar covenants may be made between a buyer and seller of the goodwill of a firm.

**Deceptive trade marks.**—It is a well-known legal maxim that a right of action does not arise out of fraud. The object of the law being to prohibit fraudulent trade it follows that a Court of Equity will not protect a trade mark that contains deliberate mis-statements or that deceives the public.<sup>2</sup> Thus, in the early case *Pidding v. How*<sup>3</sup> it was shown that the plaintiff had made false representations in his advertisements as to the origin, composition and value of his tea. In disallowing the injunction Vice-Chancellor Shadwell observed: "It is a clear rule, laid down by courts of equity, not to extend their protection to persons whose

(1) *Hannah v. Jagannath & Co.*, (1914) 19 C.W.N. 1.

(2) See Sec. 11 of the English Trade Marks Act which provides that a deceptive mark shall not be registered and Sec. 35 under which such mark may be expunged from the register. A misrepresentation not made till after the commencement of the action will not affect plaintiff's title to relief:—*Siebert v. Findlater*, (1878) 7 Ch.D. 801. See also *Perry v. Truefitt* (1842) 49 E.R. 749; 6 Beav. 66; *Estcourt v. Estcourt Hop Essence Co.*, (1875) 10 Ch. App. 276; 44 L.J.Ch. 223 (Misrepresentation as to quality.)

(3) Seb. Dig., p. 29. In *Morgan v. McAdam*, (Patent Plumbago Crucibles), 36 L.J.Ch. 228, Seb. Dig., p. 159, *Wood*, V.C. similarly said:—"All that this court has to determine is, has the plaintiff who comes here to seek relief, any ground whatever for seeking the court to assist him in the protection of that right which he sets up? If the court finds it to be a right founded upon fraud, . . . the court says it cannot assist a person in carrying on a fraud."

case is not founded on truth." This rule was fully discussed by Mellish, L.J., in *Ford v. Foster*,<sup>4</sup> which is still the leading authority on the point. It was laid down in that case that a false representation in respect of a trade mark by its owner furnished a valid defence at law to an action on the mark, and that where a trade mark was used in connection with a fraudulent trade it cannot be protected. A few illustrative cases are discussed below.

In *The Leather Cloth Company case*<sup>5</sup> the plaintiffs had stamped their goods with the words "tanned" and "patented" when they were neither tanned nor patented. Injunction was granted by Wood, V. C., on the ground that the public were not likely to be deceived by such misrepresentations, but his decision was overruled by Lord Westbury, C., and by the House of Lords. The Lord Chancellor observed: "Where any symbol or label claimed as a trade mark is so construed or worded as to make or contain a distinct assertion which is false, I think, no property can be claimed in it, or in other words the exclusive use of it cannot be maintained." And, in answer to the plaintiffs' contention that the public could not be deceived by the misrepresentation Lord Westbury observed: "I cannot receive it as a rule, either of morality, or equity, that a plaintiff is not answerable for a falsehood, because it may be so gross and palpable as that no one is likely to be deceived by it. If there be a wilful false statement, I will not stop to inquire whether it be too gross to mislead."

In *Newman v. Pinto*<sup>6</sup> the plaintiff's trade mark contained the words "La Pureza Habana Ramon Romnedo." It was shown that while the cigars were not, in fact, made of Habana tobacco, the plaintiff's label as a whole conveyed a false representation to the

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(4) (1872) L.R. 7 Ch. 611, (*Eureka shirts*). The plaintiff was not disentitled as the misrepresentation in his calling himself a patentee was held at most to be collateral. In the following cases also the misrepresentations were held to be extraneous and not to disentitle the plaintiff to protection; *Hogg v. Kirby*, (1803) 32 E.R. 336; 8 Ves. 215; Seb. Dig., p. 5; *Chappel v. Sheard*, (1855) 69 E.R. 717; 2 K. & J. 117; *Chappel v. Davidson*, (1855) 69 E.R. 719; 2 K. & J. 123; *Holloway v. Holloway*, 13 Beav. 209; 51 E.R. 81.

(5) *The Leather Cloth Co., (Limited) v. American Leather Cloth Co., (Limited)*, (Wood, V.C.), 1 H. & M. 271; (1863) 71 E.R. 118; (Lord Westbury), (1863) 46 E.R. 868; 4 De G. J. & S. 137; (House of Lords), (1863) 11 E.R. 1435; 11 H.L.C. 523. It was held by the House of Lords that the defendants' stamp was not an infringement of the plaintiffs', but even if it had been, the plaintiffs would be disentitled to relief on account of the misrepresentations made by them.

(6) (1887) 57 L.T. 31; 4 R.P.C. 508.



public that the cigars were so made. Injunction and account of profits were ordered by Kekewich, J., but his decision was reversed by the Court of Appeal on the ground that a plaintiff who was engaged in a fraudulent trade could not invoke the aid of the court to protect such trade. In *Wood v. Butler*<sup>7</sup> the plaintiffs' mark for cigarettes was expunged from the register by the Court of Appeal on the ground that the plaintiffs represented cigarettes of their manufacture made in London as Russian cigarettes. Lord Justice Fry observed: "He who has made the goods has taken upon himself to represent two things; in the first place, that they are not his manufacture but somebody else's; in the second place, that a firm exists which does not exist at all. It appears to me that the plaintiff has by that conduct entirely precluded himself from contending in this case that the word is a distinctive word or words."

In the *Bile Bean* case<sup>8</sup> the plaintiffs were selling "Charles Forde's Bile Beans for Biliousness" and falsely represented in their advertisements that they were prepared from an Australian herb discovered by Charles Forde, an eminent scientist. The defendant commenced selling liver pills under the name "Davidson's Bile Beans." Interdict was refused on the ground among others that

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(7) (1886) 36 Ch. D. 247; 3 R.P.C. 81. A disclaimer of any exclusive right to the word "filtered" in the trade mark "Edge's Filtered Blue" was ordered as the evidence showed that the blue did not go through any process of filtration, re. *Edge's Tm.*, (1891) 8 R.P.C. 207. Plaintiff disentitled to relief on account of misrepresentation as to registration of mark, *Lewis v. Goodbody*, (1892) 67 L.T. 194; Use of words 'trade mark' on part only of a registered mark held not calculated to deceive, *Sen Sen & Co. v. Britten*, (1899) 1 Ch. 692; 16 R.P.C. 137; *Bass, Ratcliff and Gretton, Ltd.'s*, (No. 2) Tm., (1902) 2 Ch. 579; 19 R.P.C. 529. Registration of the word "Shamrock" by a firm carrying on business in London, refused on opposition by an association for the development of Irish industries on the ground that the use of the mark would be calculated to deceive purchasers into believing that the applicant's goods were of Irish origin, when, in fact, they were not, *McGlennon's application*, (1908) 25 T.L.R. 23; 25 R.P.C. 797. "Colleen" marked on stoves offered for sale in Ireland not calculated to induce the belief that the stove was of Irish origin, *Jones and Campbell, Ltd.'s Application*, (1924) 41 R.P.C. 523. See also *Johnson & Son, (Loughborough) Ltd. v. W. Puffer & Co., Ltd.*, (1930) 47 R.P.C. 95, where injunction was refused in an action for passing off on the ground that the plaintiff had made a misrepresentation that the trade mark was registered when it was not. The trade mark "Norwegian Sardines" in respect of canned sardines preserved in oil was held to be deceptive and Register was accordingly rectified, *Concord Canning Company's Trade mark*, (1932) 49 R.P.C. 323.

(8) *Bile Bean Manufacturing Co v. Davidson*, 22 R.P.C. 553; (1906) 23 R.P.C. 725.

the complainers' trade was fraudulent. Lord Stormonth Darling observed that in such cases of misrepresentation "it does not matter that the rival may have been actuated by a motive to secure for his own bile beans a certain advantage from the reputation which the complainers had acquired for theirs by advertisements which were as extensive as they were mendacious."

In *Sen v. Oakes*<sup>9</sup> the plaintiff imported bicycles from a firm in Birmingham and had them stamped as the product of a non-existent company, "The Warrior Cycles Company, Birmingham." The bicycles were afterwards obtained from another firm at Glasgow but had stamped on them the name of the same fictitious company. A suit to restrain the appellants from importing bicycles under the above description from the original Birmingham firm was dismissed on the ground that the plaintiff was guilty of misrepresentation as to the place of origin of the bicycles. Sanderson, C. J., observed: "A party seeking the protection of the court in such a case as this must come to the court, as it has been said 'with clean hands' and even, if the plaintiff had established his case to the effect that the stamping of the bicycles with the Warrior transfer indicated to dealers and purchasers that bicycles so stamped were imported, and sold by him only or that the word "Warrior" had become associated in the market with the plaintiff so that it indicated to dealers generally that bicycles bearing the word "Warrior" were imported by the plaintiff only, in my judgment it would not be right for the court to grant him injunction or other relief claimed for the purpose of protecting his alleged right by reason of the misrepresentation of which in my judgment he was guilty."

**False representations as to patent.**—Where the word "patent" or "patented" is used along with the plaintiff's mark in a manner which conveys or is likely to convey falsely to the public that the article is manufactured according to an existing patent when it is not,<sup>10</sup> such misrepresentation would disentitle the plaintiff in a Court of Equity against any one who pirated it.<sup>11</sup> As Jessel, M. R., said: "No man can claim a trade mark in a false-

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(9) (1919) 24 C.W.N. 155; A.I.R. 1920 Cal. 1 (F. B., Sanderson, C. J., Woodroffe and Chaudhuri, JJ.). See also *Abdul Cadar v. Mahamadally*, (1901) 3 Bom.L.R. 220.

(10) Misrepresentation as to existing patent, trade mark, or design may amount to a criminal offence under the Indian Merchandise Marks Act. See Chapter XI.

(11) *Flavel v. Harrison*, (1853) 10 Hare 467; 68 E.R. 1010; 22 L.J.Ch. 866; Seb. Dig., p. 62; *Leather Cloth Co. (Limited) v. American Leather*

hood and it is a falsehood to represent that the patent is still existing when it is not.”<sup>12</sup> But where the use of the word ‘patent’ is not deceptive the plaintiff will not be disentitled to relief. The general rule is that the misrepresentation must be sufficiently material, and must be calculated to deceive the purchaser. “If the word ‘patent’ be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term,” then “nobody is meant to be deceived, or is deceived. A patent may have expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it.”<sup>13</sup>

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*Cloth Co. (Limited)* (1863) 11 E.R. 1435; 11 H.L.C. 523; *Morgan v. McAdam*, (1866) 36 L.J.Ch. 228 (Patent Plumbago Crucibles); *Lamplough v. Balmer* (Royal letters patent for medicines); (1867) W.N. 293; Seb. Dig., p. 172; *Leather Cloth Co. v. Lorisont*, (1869) L.R. 9 Eq. 345; *Nixey v. Roffey*, (Black lead) Seb. Dig., p. 206; *Hubbuck (Thomas) & Son, Ltd. v. (William) Brown Sons & Co.*, (1900) 17 R.P.C. 638.

(12) *Cheavin v. Walker*, (1877) 5 Ch.D. 850.

(13) Per Lord Kingsdown in the *Leather Cloth Co., (Limited) v. The American Leather Cloth Co. (Limited)*, (1863) 11 E.R. 1435; 11 H.L.C. 523; *Edelsten v. Vick*, (1853) 11 Hare 78; 68 E.R. 1194, Seb. Dig., p. 64 (use of original labels after expiration of patent). The use of the word ‘patent’ in ‘patent leather,’ ‘patent medicine,’ etc., is obviously not deceptive; *Marshall v. Ross*, (1869) L.R. 8 Eq. 651, (patent thread); *Cochrane (Sir Henry) v. McNish & Sons*, (1896) A.C. 225; 13 R.P.C. 100 (manufactured in Ireland by H.M.’s Royal Letters Patent). Use of the words ‘patent’ and ‘patented’ held not to amount to more than a collateral misrepresentation, *Perry & Co., Ltd. v. Hessin & Co.*, (1912) 29 R.P.C. 101.

## CHAPTER IX.

### GOODWILL.

The conception of goodwill<sup>1</sup> is not of recent origin though its commercial and legal aspects have come into prominence only in modern times. It had been known from early times that in certain classes of business such as an inn or a retail shop in a thoroughfare there was such an unbroken flow of custom even when the business had changed hands often that a successor in business was willing to pay some money in excess of the value of stock-in-trade and other tangible assets he took over from his predecessor. This form of intangible asset which could be bought and sold for value was called goodwill.<sup>2</sup> At first the Court of Equity refused to enforce special performance of a contract for the sale of goodwill,<sup>3</sup> but after the decision in *Darbey v. Whitaker*<sup>4</sup> such contract could be enforced. The phenomenon has now become so universal, and the importance of an established business reputation and a ready-formed connection of customers had come to be so widely recognised that we can speak of the goodwill of nearly every profitable modern business including some of the learned professions, such as the practice of medicine or law. So that, nowadays, in nearly all transactions where a business as a going concern is bought or sold an evaluation of the goodwill is generally made, apart from other assets.

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(1) See also Chapters V and VI.

(2) See *Llewellyn v. Rutherford*, (1875) 10 C.P. 456; 32 L.T. 610; Seb. Dig., p. 276; *Hitchcock v. Coker*, (1837) 6 Ad. & El. 438; 112 E.R. 167; Seb. Dig., p. 28; *McCormick v. McCubbin*, Seb. Dig., p. 16; *Gibblett v. Read*, (1744) 9 Mod. Rep. 459; 88 E.R. 573, Seb. Dig., p. 2; *Worral v. Hand*, (1791) Peake, 105; 170 E.R. 95; Seb. Dig., p. 3; *Thomas, Ex-parte*, (1841) 2 Mont.D. & De. G., 294 on appeal, (1842) 1 Ph. 159, L.C.; Seb. Dig., p. 34; *Hall v. Barrows*, (1863) 4 De G. J. & Sm. 150; 46 E.R. 873; Seb. Dig., p. 121.

(3) *Baxter v. Conolly*, (1820) 1 Jac. & W. 576; 37 E.R. 487; Seb. Dig., p. 15; *Bozon v. Farlow*, (1816) 1 Mer. 459; 35 E.R. 742; Seb. Dig., p. 10; *Coslake v. Till*, (1826) 38 E.R. 146; 1 Russ. 376; Seb. Dig., p. 20.

(4) (1857) 4 Drew. 134; 62 E.R. 52; Seb. Dig., p. 85.

**Definition.**—In spite of such importance attaching to goodwill there is no statutory definition of it so far, and the judges themselves have found it difficult to define.<sup>5</sup> This difficulty is due to the fact that goodwill covers many circumstances such as locality, personality, nature of the goods, possession of a recipe, one or more of which may preponderate or be absent in any particular case.<sup>6</sup>

One of the earliest definitions of goodwill was that by Lord Chancellor Eldon in *Cruttwell v. Lye*<sup>7</sup> where he described goodwill as “nothing more than the probability that the old customers will resort to the old place.” It is obvious that this definition is not sufficiently broad based. A definition more in keeping with the changed conditions of commerce is that of Wood, V. C., (afterwards Lord Chancellor Hatherley), in *Churton v. Douglas*<sup>8</sup>:—“Goodwill, I apprehend must mean every advantage, every positive advantage, if I may so express it, as contrasted with the negative advantage of the late partner not carrying on the business himself, that has been acquired by the old firm in carrying on its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm, or with any other matter carrying with it the benefit of the business.”

In the *Inland Revenue Commissioners v. Muller & Co.'s Margarine, Ltd.*,<sup>9</sup> Lord Macnaghten said: Goodwill “is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business

(5) “Goodwill is a thing very easy to describe, very difficult to define.” Lord Macnaghten in *Inland Revenue Commissioners v. Muller & Co.'s Margarine, Ltd.*, (1901) App. Ca. 217. “I am not aware that anybody has succeeded in ever defining the meaning of the word ‘goodwill’”. Maugham, J., in *John Sinclair Ltd.'s Tm.*, (1932) 1 Ch. 598; 49 R.P.C. at p. 129.

(6) See Lord Macnaghten's judgment in *Inland Revenue Commissioners v. Muller & Co.'s Margarine, Ltd.*, (1901) App. Ca. 217.

(7) (1810) 17 Ves. 335; 34 E.R. 129; Seb. Dig., p. 8. “Chance or probability that custom will be had at a certain place of business, in consequence of the way in which that business has been previously carried on.” (Lord Langdale, M. R.) *England v. Downs*, (1842) 49 E.R. 829; 6 Beav. 269; Seb. Dig., p. 37.

(8) (1859) John. 174; 70 E.R. 385; 28 L.J.Ch. 841; Seb. Dig., p. 96. This definition was approved by the House of Lords in *Trego v. Hunt*, (1896) A.C. 7. See also *Hill v. Fearis*, (1905) 1 Ch. 466; 74 L.J.Ch. 237.

(9) (1901) A.C. 217, at p. 223. Quoted in *Hannah v. Jagannath & Co.*, 27 I.C. 483; 19 C.W.N. 1.

from a new business at its first start." Emphasising the inseparability of goodwill from business, Lord Lindley, in the same case, observed: "Goodwill regarded as property has no meaning except in connection with some trade, business, or calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value and, in my judgment, exists where the business is carried on. Such business may be carried on in one place or country or in several, and if in several there may be several businesses, each having a goodwill of its own."<sup>10</sup>

Another comprehensive definition is that of Judge Story, who describes goodwill as "the advantage or benefit which is acquired by an establishment beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position or common celebrity, or reputation for skill or affluence, or punctuality or from other accidental circumstances or necessities, or even from ancient partialities or prejudices."<sup>11</sup>

**Property right in goodwill.**—It is clear from the above definitions that goodwill is now universally regarded as a species of intangible property.<sup>12</sup> The right of property in goodwill was clearly brought out by Lord Macnaghten in the following passage: "Goodwill is bought and sold every day. It may be acquired, I think, in any of the different ways in which property is usually acquired. When a man has got it he may keep it as his own. He may vindicate his exclusive right to it if necessary by process of law. He may dispose of it if he will—of course, under the conditions attaching to property of that nature."<sup>13</sup>

The conception of property in goodwill has obtained statutory recognition in the Indian Partnership Act (Act IX of 1932). Section 14 of the Act reads:—

(10) Quoted in *Rickerby v. Reay*, (1903) 20 R.P.C. at p. 388. (Byrne, J.).

(11) *Story on Partnership*.

(12) *Vide*, for instance, *Holland's Jurisprudence*, pp. 189, 213.

(13) *Inland Revenue Commissioners v. Muller & Co.'s Margarine Ltd.*, (1901) App. Ca. 217.

"Subject to contract between the partners, the property of the firm includes all property and rights and interests in property originally brought into the stock of the firm, or acquired, by purchase or otherwise, by or for the firm or for the purposes, and in the course of the business of the firm, and includes also the goodwill of the business."<sup>14</sup>

**Locality.**—Some of the important elements of goodwill may now be mentioned. Of these the connection of the goodwill of a business with the locality in which it is carried on received special emphasis in the earlier cases before the Chancery courts.<sup>15</sup> The attribute of locality is even nowadays an important part of the goodwill in certain class of business. So, Lord Lindley said: "That in some cases and to some extent goodwill can and must be considered as having a distinct locality, is obvious, and was not, in fact, disputed. The goodwill of a public house or of a retail shop is an instance. The goodwill of a business usually adds value to the land or house in which it is carried on if sold with the business; and so far as the goodwill adds value to land or buildings, the goodwill can only be regarded as situate where they are. In such a case the goodwill is said to be annexed to them."<sup>16</sup> But in most of the businesses the emphasis has in modern times shifted to the other aspects of goodwill, such as the personality of the head of the establishment, the repute of a trade mark, the care and attention bestowed on the production and delivery of goods, general reliability, and such other reputation as win public favour and patronage for the business in question.

**Goodwill and profession.**—The existence of a goodwill in a trade or profession where the personal character of the owner of the business plays a great part was not recognised by the Court of Equity in early cases. Thus, for instance, in *Bain v. Munro*,<sup>17</sup>

(14) See also Section 55.

(15) *Crutwell v. Lye*, (1810) 34 E.R. 129; 17 Ves. 335, Seb. Dig., p. 8. In *Parsons v. Hayward*, Seb. Dig., p. 115, Romilly, M. R., observed: "Although it is true that a house may be of little value in itself, if held at rack rent, still it may be of great value as a place for carrying on the business, and there may be a peculiar species of value attached to a particular spot where a business has for a long time been carried on, and which may be an asset of the partnership of very high value." See also *Chissum v. Dewes*, (1828) 5 Russ. 29; 38 E.R. 938; Seb. Dig., p. 21.

(16) *Inland Revenue Commissioners v. Muller & Co.'s Margarine, Ltd.*, (1901) A.C. 217.

(17) (1878) 15 Sc.L.R. 260; Seb. Dig., p. 356. See also *Austen v. Boys*, (1858) 2 De G. & J. 626; 44 E.R. 1133; Seb. Dig., p. 87; *Arundell*

where an action was brought to recover from the widow and executrix of a medical man a sum of money guaranteed by the defendant's husband to the plaintiff, it was held that the goodwill of medical practice being personal and consequently not transmissible, the purchase money did not belong to the estate of her deceased husband. Lord Curriehill representing the view of the majority of the court observed: "There is truly no such thing as goodwill in the case of a business carried on by a professional man, such as a physician, surgeon, or law agent, whose success depends entirely upon his own personal skill. . . . His business dies with him and the man who comes after him in the district must depend for success upon his own exertions." But, Lord Gifford, who dissented, stated: "I think it is quite clear that there may be the goodwill of the practice of a professional man as well as of a trade. . . . I see nothing to prevent a medical man bequeathing his practice to a friend."

Opinion has since changed in favour of the view taken by Lord Gifford with the result that the rule laid down by the courts in the early cases denying goodwill in a profession does no longer hold good. It may now be taken as well settled that the sale of the goodwill of a profession or a business involving personal skill is perfectly valid in law, provided of course the result of the transmission of such goodwill is not to cause deception of the public.

**Trade Mark and Business Name.**—Under modern conditions of trade the most important aspect of the goodwill of a business consists in the trade marks or name of the firm. The enormous value which the goodwill of a successful trade mark like 'Kodak' or 'Gold flake', can fetch will be readily appreciated. Many of the questions relating to the goodwill of trade marks and business names have already been discussed in the earlier chapter.<sup>18</sup>

**Sale of goodwill.**—It has already been pointed out that goodwill is property and is included in the business assets. It can therefore be a subject of sale, but as it is inseparable from business it has been held that it cannot

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*v. Bell*, (1883) 52 L.J.Ch. 537; *Bozon v. Farlow*, (1816) 1 Mer. 459; 35 E.R. 742; Seb. Dig., p. 10; *Farr v. Pearce*, (1818) 3 Madd. 74; 56 E.R. 437; Seb. Dig., p. 13.

(18) See Chapters V and VI.



be sold apart from the business to which it is attached.<sup>19</sup> So, in a case<sup>20</sup> where a partner's share in the goodwill was bequeathed separately, the share in the business having been sold to the other partner, it was held by Romilly, M.R., that the goodwill passed with the sale of the business to the other partner and not the legatee. His Lordship observed. "The goodwill is a valuable and tangible thing in many cases, but it is never a tangible thing unless it is connected with the business itself, from which it cannot be separated, and I never knew a case in which it has been so treated." Again, in the recent case *Lacteosote, Ltd. v. Alberman*<sup>21</sup> it was held that the assignment of goodwill apart from the manufacturing business was not valid and that as the plaintiff did not succeed to the business no goodwill passed to him.<sup>22</sup> In recent times, however, there has been a change in the view point and it is felt that owing to the conditions under which modern business is carried on it ought to be possible to sell goodwill apart from some or all the other business assets. In India the principle has obtained statutory recognition so far as partnership is concerned, vide Sec. 55 (1) of the Indian Partnership Act, 1932, which provides for the sale of goodwill, either separately or along with other property of the firm.

**Transfer of goodwill implied in sale of business.**—In the absence of any express stipulations it will be assumed that when a business is sold its goodwill also passes with the business to the vendee. So, in *Shipwright v. Clements*<sup>23</sup> where the defendant sold to the plaintiff all his interest in the partnership premises and effects without specifically referring to the goodwill, Vice-Chancellor Malins, held that "the sale of a business is a sale of the goodwill. It is not necessary that the word 'goodwill' should be mentioned. The defendant sold the business and with it everything producing profit." Again, in *Rickerby v. Reay*<sup>24</sup> where the plaintiff purchased from the executors of the defendant's father a

(19) *A fortiori* where there is no business there is no goodwill to be assigned; *Fine Cotton Spinners and Doublers' Association, Ltd., and J. Cash & Sons, Ltd. v. Harwood Cash & Co., Ltd.*, (1907) 2 Ch. 184; 24 R.P.C. 533; *Tussaud v. Tussaud*, (1890) L.R. 44 Ch.D. 678; *Kingston, Miller & Co., Ltd. v. Thomas Kingston & Co.*, (1912) 1 Ch. 575; 29 R.P.C. 289.

(20) *Robertson, v. Quiddington*, (1860) 54 E.R. 469; 28 Beav. 529; Seb. Dig., p. 105.

(21) (1927) 2 Ch. 117; 44 R.P.C. 211.

(22) The same law prevails in India, see Chapter V.

(23) (1871) 19 W.R. 599; Seb. Dig., p. 210. See also *Jennings v. Jennings*, (1898) 1 Ch. 378; 67 L.J.Ch. 190.

(24) (1903) 20 R.P.C. 380.

business of agricultural machine makers, Byrne, J., held that though goodwill was not specifically conveyed by the terms of sale, its transfer was implied. His Lordship stated that whenever a business is bought as a going concern and not at a break-up price, the goodwill including the right to trade name and trade marks passes on to the purchaser, whether specifically mentioned or not.

Where, however, the terms of agreement provide for the resumption of a business by its vendor after a specific period, it is obvious that the goodwill at the end of the period reverts to the original vendor. Thus, in *Roger's Trade Mark case*,<sup>25</sup> where the Bodega Company sold for a period of ten years the goodwill of their whisky business in Glasgow along with the plant, fittings and lease of premises, it was held by North, J., that the goodwill in question should be restored to the vendor company at the end of the period.

**Whether incident to premises or stock-in-trade.**—Sometimes it happens that on the sale or transfer of a business the purchaser leases the old premises for a specified period and then removes his business to another site. On the termination of the lease the question arises whether the goodwill of the business continues to be annexed to the premises or is carried away by the purchaser and lessee along with the stock-in-trade and machinery. The answer will depend on the original terms of sale, as well as, on the nature of the business: "One or more of the elements going to make up what is called goodwill may be retained, while others may be parted with, and all or every such elements may be disposed of without express mention. The right way to approach the question. . . . is to consider the facts and endeavour to ascertain what rights, if any, were acquired by the purchaser and lessee beyond the mere right and title to the chattels and premises bought and leased."<sup>1</sup>

In some cases it may happen that the original goodwill, if any, was negligible and that the goodwill of the business at the end of the lease was entirely built up by the lessee.<sup>2</sup> In deciding what happens to the goodwill in such cases, the nature of the business will have to be taken into account. Where the goodwill is incident to the means of production rather than to the place of business,

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(25) (1895) 12 R.P.C. 149.

(1) Per Byrne, J., in *Rickerby v. Reay*, (1903) 20 R.P.C. 380 at p. 388. The goodwill of a public house is something apart from the house (Cozens-Hardy, J.) *Baglioni v. Cavalli*, (1900) 49 W.R. 236; 45 Sol. Jo. 78.

(2) *Rickerby v. Reay*, (1903) 20 R.P.C. 380.

as, for instance, a manufacturing business, the goodwill passes on with plant and stock to the lessee.<sup>3</sup> On the other hand, where the attribute of locality is the predominant feature, as in the business of a hotel or public house,<sup>4</sup> the goodwill is generally incident to the premises and, consequently, passes to the reversioner. By an express contract it may, however, pass to the lessee.

**Personal goodwill.**—A personal goodwill cannot be transmitted by assignment or sale. "If an artist or an artisan has acquired by his personal skill and ability a reputation which gives to his works in the market a higher value than those of other artists or artisans, he cannot give any other person the right to affix his name or mark to their goods, because he cannot give the right to them to practice a fraud upon the public."<sup>5</sup>

For the same reason the goodwill of a business which involves the knowledge of a secret process or recipe cannot be validly assigned without the secret recipe being conveyed at the same time.<sup>6</sup> These aspects of goodwill have already been discussed in Chapter V in connection with the assignment of trade marks.

**Divisibility of goodwill.**—The goodwill of a business is, in most cases, an indivisible whole connected with the seat of business. Where there is a single seat of business there can be only one goodwill and a sale of part of it will be obviously meaningless and invalid. In the *Lacteosote* case<sup>7</sup> it was held that the goodwill remained wholly vested in the manufacturer and that, as the latter had not ceased to manufacture, the plaintiff's attempt to sever the goodwill into a manufacturing goodwill and a vending goodwill was not permissible in law.

On the other hand, where there are several businesses carried on under the same management but the accounts of each of them

(3) *England v. Downs*, (1842) 49 E.R. 829; 6 Beav. 269; *Morris v. Moss*, (1855) 25 L.J.Ch. 194; *Rickerby v. Reay*, (1903) 20 R.P.C. 380.

(4) *Llewellyn v. Rutherford*, (1875) 10 C.P. 456; 32 L.T. (N.S.) 610; Seb. Dig., p. 276: "When we come to speak of the goodwill of a public house, it is obvious that it is a thing which is attached to a locality." (Brett, J.).

(5) Per Lord Kingsdown, *The Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*, (1863) 11 H.L.C. at p. 544.

(6) *Cotton v. Gillard*, (1874) 44 L.J.Ch. 90; Seb. Dig., p. 267; *Rey v. Lecouturier*, (1908) 2 Ch. 715; 25 R.P.C. 265, (1910) A.C. 262; 27 R.P.C. 268. The existence of a secret recipe was alleged, but could not be proved in *Mumm & Co.'s, Application*, (1922) 39 R.P.C. 379, and in *Smith's trade mark*, (1927) 44 R.P.C. 533.

(7) *Lacteosote, Ltd. v. Alberman*, (1927) 2 Ch. 117; 44 R.P.C. 211.

are kept separate, then the goodwill is divisible and transmissible with each of these separate businesses.

**Vendor may start similar business.**—In an early case<sup>8</sup> Lord Eldon observed: "If it had been nothing more than a purchase of the goodwill of this trade, the vendor would be at liberty to set up the same trade in any other situation." In *Churton v. Douglas*<sup>9</sup> Wood, V. C., said: "The sale of the goodwill of a business, without more, does not imply a contract on the part of the vendor not to set up again a *similar* business himself." And, in a later case,<sup>10</sup> James, V. C., observed: "It has been settled that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business."

The above rule of law has obtained statutory recognition in the Indian Partnership Act, 1932. According to section 55 (2), "where the goodwill of a firm is sold after dissolution, a partner may carry on a business competing with that of the buyer." Section 36 (1) of the Act secures the same right to an outgoing partner.

**Covenant not to compete in business.**—A vendor may, however, by express agreement deprive himself of the right to compete with the vendee. Such a covenant will ordinarily be enforced by the courts unless the restrictions imposed are shown to be unreasonable or too oppressive.<sup>11</sup> In India the above principle is embodied in statutory law.<sup>12</sup> This question is considered at some length in a later section.

**Vendor can state connection with the old business.**—The vendor of the goodwill of a business can state his previous connection with the business he has sold. He can paint on his signboards or print on his letter heads, advertisements, circulars etc., "late A.B." Thus, in *Clark v. Leach*<sup>13</sup> Romilly, M. R., refused to res-

(8) *Shackle v. Baker*, (1808) 14 Ves. 468; 33 E.R. 600; Seb. Dig., p. 6.

(9) (1859) 70 E.R. 385; Johns. 174; Seb. Dig., p. 96. See also *Johnson v. Helleley*, (1864) 2 De G.J. & Sm. 446; 46 E.R. 447; Seb. Dig., p. 139.

(10) *Hudson v. Osborne*, (1869) 39 L.J.Ch. 79; Seb. Dig., p. 193.

(11) See for instance *Williams v. Williams*, (1818) 36 E.R. 612; Seb. Dig., p. 14; *Cooper v. Watson*, Seb. Dig., p. 3; *Auchterlonie v. Charles Bill*, (1868) 4 M.H.C. 77.

(12) See Exception (1) to Section 27 of the Indian Contract Act, 1872 and Sections 36 (2), 54 and 55 (3) of the Indian Partnership Act, 1932.

(13) 32 L.J.Ch. 290 (1863); Seb. Dig., p. 117.

train the defendant from styling his new business "R. Leach & Co., late Leach & Clark." The Master of the Rolls observed: "Has not the defendant a right to say that he lately belonged to a certain firm, and cannot he advertise that fact? The difficulty is, if he cannot be prevented from carrying on the same business, is he not at liberty to solicit the public at large, and to do so by telling, as is the truth, that he belonged to a late firm?"

But the manner of stating this previous connection must not be calculated to deceive. So, in *Hookham v. Pottage*<sup>14</sup> the defendant, after selling his share in a tailoring business to the plaintiff (who was entitled to the goodwill according to a court's decree), set up business within a few doors of the plaintiff and painted over his door "S. Hookham from Hookham & Pottage," the word "from" being in small letters. It was held that though the defendant was entitled to state fairly his connection with the former firm, he was not entitled to act so as to divert to himself the custom intended for the plaintiff.

**Vendor may not use the old firm name.**—It was already pointed out in Chapter VI that the right to the use of a firm name passes to the vendee on the sale of the goodwill of a business in the absence of express stipulations to the contrary.<sup>15</sup> The vendor shall not, in such cases, use the old firm name or represent directly or indirectly that his business is identical with, or is a continuation of, the old business. Thus, in *Churton v. Douglas*<sup>16</sup> the defendant who had sold his share and goodwill to his partners in the firm of "John Douglas & Co.," was restrained from trading under the old firm name and otherwise representing that his business was a continuation of the old firm. Wood, V. C., observed: "When you are parting with the goodwill of a business you mean to part with all that good disposition which customers entertain towards the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it." And, in *Hudson v. Osborne*,<sup>17</sup> James, V. C., said: "It seems to be settled that a trader, whose business and the goodwill of whose

(14) (1872) L.R. 8 Ch. 91; Seb. Dig., p. 236.

(15) In *Currie & Co. v. Currie*, (1898) 15 R.P.C. 339, there was an express stipulation that the vendee should not use the former business name.

(16) (1859) 70 E.R. 385; 28 L.J.Ch. 841; Seb. Dig., p. 96. See also *Burrows v. Foster*, Seb. Dig., p. 115.

(17) (1869) 39 L.J.Ch. 79; Seb. Dig., p. 193.

business have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade marks which were the marks of that business, or by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which was sold."

The right of the vendor to use his personal name for honest trade purposes has already been discussed in Chapter VI.

**Rights of vendee.**—The purchaser of a business along with its goodwill acquires the right to continue to trade under the old business name. Thus, in *Lery v. Walker*,<sup>15</sup> where, on dissolution of partnership the defendant bought the whole business including leasehold premises, stock-in-trade, goodwill, etc., and continued to carry on the business under the old firm name of "Charbonnel & Walker," injunction to restrain the defendant from using the firm name was refused. The only limitation on this right of the vendee is that his use of the business name should not involve the vendor in any risk of liability.<sup>16</sup> Where a trade name has become so identified with the individual carrying on business that the use of such name *simpliciter* and without explanation by the purchaser exposes or is likely to expose the vendor to some personal liability, the vendee will be prevented from using the name in that manner.<sup>20</sup>

(18) (1879) 10 Ch. D. 436; 48 L.J.Ch. 273; Seb. Dig., p. 392. See also *Churton v. Douglas*, (1859) 70 E.R. 385; Johns, 174; Seb. Dig., p. 96; *Banks v. Gibson*, (1865) 55 E.R. 753; 34 Beav. 566; Seb. Dig., p. 145; *Hudson v. Osborne*, (1869) 39 L.J.Ch. 79; Seb. Dig., p. 193; *Gray v. Smith*, (1889) 43 Ch.D. 208; *Rosher v. Young*, (1901) 17 Times L.R. 347; *Day v. Finch*, 25 Sol. J. 354; *Townsend v. Jarman*, (1900) 2 Ch. 698; 17 R.P.C. 649. *Pomeroy (Mrs.), Ltd. v. Scale*, (1906) 22 T.L.R. 795; 24 R.P.C. 177; *Wood v. Hall*, (1915) 33 R.P.C. 16; *Hannah v. Jagannath & Co.*, (1914) 19 C.W.N. 1.

(19) *Walter v. Ashton*, (1902) 2 Ch. 282. See also *Townsend v. Jarman*, (1900) 2 Ch. 698; 17 R.P.C. at p. 663 (Farwell, J.); *Morarji v. Madonji*, (1903) 5 Bom.L.R. 545.

(20) In *Chatteris v. Isaacson*, (1887) 57 L.T. 177, the buyer of the goodwill of a business including the exclusive right to the firm name "Madame Elise and Co.," was restrained from using the name "Madame Elise," as the use of the name *simpliciter* would expose the vendor to liability. But in *Townsend v. Jarman*, (1900) 2 Ch. 698; 17 R.P.C. 649 where the buyer of the goodwill used the name "Jarman & Co." it was held that there was no such risk to the vendor. Farwell, J., observed. "The vendor with his eyes open transferred the right to use that name to the company, knowing that the company might sell it again to somebody else and that they have done. It does not lie in his mouth to complain that they have sold that which he gave them the right to sell, nor can I say that there is any liability at all."

The risk of liability on the vendor will be great, where the name in question is the personal name of the vendor, and the use of the name simpliciter by the vendee will not, therefore, be allowed generally in these cases. The vendor may, however, by express agreement confer on the purchaser of the goodwill the right to carry on the business under the vendor's own name and also preclude himself from using his own name for trade purposes.<sup>21</sup> Again, as a company cannot acquire any corporate name except by grant from the Crown it follows that the vendee of the goodwill of a limited company does not automatically acquire the right to use the name of the limited company, but must apply for registration of the new company. The new company has, however, the right to represent itself as successor to, and as carrying on, the old business.<sup>22</sup>

**Soliciting of former customers.**—As one of the most valuable ingredients in the goodwill of a business is the ready-formed connection of customers, the purchaser of the goodwill is naturally paying for this business connection. If the vendor starts new business it behoves on him, therefore, not to solicit the custom of his old customers for his new business, and thus derogate from the grant he had made. This important principle of law has been embodied in a number of well-known judicial decisions. It was first enunciated by Lord Romilly, M.R., in *Labouchere v. Dawson*,<sup>23</sup> where the defendant after selling his brewery business to the plaintiff started another brewery business and solicited his former customers. In granting an injunction the learned Master of the Rolls said: "The goodwill is the probability of the old customers going to the new firm to whom the business is sold. . . . He (the vendor) is entitled to publish any circulars to all the world to say that he is carrying on such a business but he is not entitled, either by private letter or by a visit, or by his traveller or agent, to go to any person who was a customer of the old firm and solicit him not to continue his business with the old firm, but to transfer it to him. That is not a fair and reasonable thing to do after he has sold the goodwill."

The above rule of law is now well established.<sup>24</sup> A contrary

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(21) *Pomeroy (Mrs.)*, *Ld. v. Scale*, (1906) 22 T.L.R. 795; 24 B.P.C. 177.

(22) *The Montreal Lithographing Co., Ld. v. Sabiston*, (1899) A.C. 610; 16 B.P.C. at p. 446, (Lord Davey in the Privy Council).

(23) (1872) L.R. 13 Eq. 322; 41 L.J.Ch. 427; *Seb. Dig.*, p. 229.

(24) See *Ginesi v. Cooper*, (1880) 14 Ch.D. 596; *Legott v. Barrett*,

view was however, taken in *Pearson v. Pearson*<sup>25</sup> where it was held that there was no such implied covenant as contemplated by Lord Romilly in *Labouchere v. Dawson*<sup>25-a</sup> and that in the absence of express stipulations to the contrary it was open to the vendor to solicit his former customers.. But, the decision in this case was overruled in *Trego v. Hunt*<sup>1</sup> by the House of Lords, who laid down that *Labouchere v. Dawson* was rightly decided and that the view of Lord Romilly in that case represented the correct statement of the law. Lord Herschell said: "If a person who has previously been a partner in a firm sets up in business on his own account and appeals generally for custom, he only does that which any member of the public may do, and which those carrying on the same trade are already doing. It is true that those who were former customers of the firm to which he belonged may, of their own accord, transfer their custom to him; but this incidental advantage is unavoidable, and does not result from any act of his. He only conducts his business in precisely the same way as he would have done if he had never been a member of the firm to which he had previously belonged. But when he specifically and directly appeals to those who were customers of the previous firm, he seeks to take advantage of the connection which he had previously acquired, to take that which constitutes the goodwill away from the persons to whom it has been sold and to restore it to himself."

**May solicit in case of sale in bankruptcy.**—The restriction that the vendor shall not solicit business from his old customers does not apply where the goodwill of the business is sold in

(1880) 15 Ch.D. 306, implied contract on the part of the vendor of a goodwill that he will not immediately after solicit the customers who are really the people who form the goodwill (Brett, L.J.) but vendor not disentitled to deal with old customer whom he did not solicit to come there and who came to him of his free will, (Cotton, L.J., and approved in *Trego v. Hunt* by Lord Herschell); *Trego v. Hunt*, (1896) A.C. 7; *West London Syndicate v. Inland Revenue Commissioners*, (1898) 2 Q.B. 507; (old customers who had been in the habit of staying in the hotel may be solicited if the lease alone is sold but not where the vendor sells the goodwill of the hotel along with the lease); *re David & Mathews*, (1899) 1 Ch. 378; 68 L.J.Ch. 185; *Gillingham v. Beddow*, (1900) 2 Ch. 242; (one of the partners bought out the other, the articles providing that the outgoing partner may start a similar business in the neighbourhood; held that the proviso was merely declaratory and did not authorise solicitation of old customers).

(25) (1884) 27 Ch. D. 145, per Baggallay and Cotton, L.JJ., (Lindley, L.J., dissenting).

(25-a) (1872) L.R. 13 Eq. 322; Seb. Dig., p. 229.

(1) (1896) A.C. 7; 65 L.J.Ch. 1. Applied: *Jennings v. Jennings*, (1898) 1 Ch. 378; *Gillingham v. Beddow*, (1900) 2 Ch. 242; *Curl Bros. v.*



bankruptcy. The question was discussed in *Walker v. Mottram*<sup>2</sup> where the rule was stated thus: "The right of a purchaser of the goodwill of a business from the trustee in bankruptcy does not extend to restrain the bankrupt (even if he joins in the conveyance) from *bona fide* commencing a fresh business, and from seeking assistance in it from his old friends and customers. It would, in our opinion, be contrary to the policy of the bankruptcy laws to extend *Labouchere v. Dawson* to such a case. It is not necessary to overrule that decision; we leave it where it is, that is to say, it will still be applicable to voluntary sales. But we do not think it ought to be extended to alienations which are compulsory."<sup>3</sup>

**The Indian Partnership Act.**—The above equitable principles governing the sale of goodwill and the rights of the vendor and the vendee have come into special prominence in connection with partnership suits, and are embodied in Sec. 55 of the Indian Partnership Act, 1932.<sup>4</sup> It has already been stated that goodwill is recognised as a species of property in Sec. 14 of this Act. Chapter VI of the Act of which Sec. 55 forms a part deals with the dissolution of a firm. The earlier Secs. 39-44 state how and under what circumstances dissolution can take place. Secs. 45-47 deal with the liability and rights of partners during dissolution,

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*Webster*, (1904) 1 Ch. 685; 73 L.J.Ch. 540; *Boorne v. Wicker*, (1927) 1 Ch. 667. The rule which prohibits the vendor from soliciting customers applies when the customers, although remaining customers of the purchaser, have, in fact, become customers of the new firm started by the vendor, *Curl Bros. v. Webster*, (1904) 1 Ch. 685; 73 L.J.Ch. 540. Rule applies to vendor's executors carrying out a contract for the sale of the goodwill, *Boorne v. Wicker*, (1927) 1 Ch. 667; 96 L.J.Ch. 361.

(2) (1881) 19 Ch.D. 355. Debtor assigning his business and goodwill to a trustee for the benefit of creditors, not precluded, in the absence of express stipulations to the contrary, from soliciting the customers of the old business, *Green & Sons (Northampton), Ltd. v. Morris*, (1914) 1 Ch. 562; 83 L.J.Ch. 559; *Farey v. Cooper*, (1927) 2 K.B. 384. The same rule applies where the goodwill is sold in lots by the liquidator between the plaintiff and the defendant as in *Townsend v. Jarman*, (1900) 2 Ch. 698; 17 R.P.C. 649. The solicitation complained of in that case was that the defendant sent a catalogue to one of the old customers who met him at a 'seeds show' and told him that he would be sending an order. Farwell, J., said that where a business like that of a seedsman has to be carried on by frequenting the markets, a trader should be at liberty to stand at the stalls and invite custom at large and it ought not to matter if he distinguished some of his old customers in so doing.

(3) The distinction between the rights of the vendor in bankruptcy and that in voluntary sale is not recognised under the Indian Partnership Act, *vide* Sec. 55 (2) and Sec. 36 (1).

(4) Repealing Chapter XI of the Indian Contract Act, 1872. The new Act is based on the English Partnership Act, 1890.

and Secs. 48 and 52 deal with the mode of settlement of accounts between partners. Sec. 53 provides for the restraint of the use of the firm name by any one partner during dissolution and before complete winding up unless that partner has bought the goodwill. Sec. 54 which provides for agreements in restraint of trade reenacts exception 2 to Sec. 27 of the Indian Contract Act which has been repealed.<sup>5</sup> Sec. 55, which deals with the disposal of goodwill on dissolution of partnership, comprises three sub-sections: sub-Sec. (1) provides for the sale of the goodwill, sub-Sec. (2) enunciates the rights of vendor and vendee and sub-Sec. (3) permits the making of agreement for further restricting the right of the vendor.<sup>6</sup>

**Dissolution of partnership.**—It was already stated that on dissolution of a partnership the goodwill shall, subject to contract between the partners, be included in the assets.<sup>7</sup> Thus, for instance, in a case<sup>8</sup> relating to the dissolution of a partnership of a newspaper it was held that the goodwill, title, etc., of the paper were partnership assets and should be disposed of for the benefit of the creditors of the firm, or of the partners jointly. In *Hall v. Barrows*,<sup>9</sup> which was decided in 1863, Lord Chancellor Westbury

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(5) See Sec. 73 of the Indian Partnership Act, 1932.

(6) Section 55—

(1) In settling the account of a firm after dissolution, the goodwill shall, subject to contract between the partners, be included in the assets, and it may be sold either separately or along with other property of the firm.

(2) Where the goodwill of a firm is sold after dissolution, a partner may carry on a business competing with that of the buyer and he may advertise such business, but, subject to agreement between him and the buyer, he may not—

(a) use the firm name;

(b) represent himself as carrying on the business of the firm, or

(c) solicit the custom of persons who were dealing with the firm before its dissolution.

(3) Any partner may, upon the sale of the goodwill of a firm, make an agreement with the buyer that such partner will not carry on any business similar to that of the firm within a specified period or within specified local limits, and, notwithstanding anything contained in Sec. 27 of the Indian Contract Act, 1872, such agreement shall be valid if the restrictions imposed are reasonable.

(7) See Sec. 55 (1) of the Indian Partnership Act quoted in the preceding footnote.

(8) *Dayton v. Wilkes*, Seb. Dig., p. 100.

(9) 4 De G.J. & S. 150; 46 E.R. 873; Seb. Dig., p. 121; see also *Wade v. Jenkins*, 30 L.J.Ch. 633; *Burfield v. Rouch*, (1862) 54 E.R. 1180; 31 Beav. 241; Seb. Dig., p. 116; *Smith v. Everett*, (1857) 54 E.R. 175;

laid down clearly that the goodwill of a business must be taken into account and valued, as being included in the "stock belonging to the partnership." It was also stated that where no specific reference was made about the disposal of the goodwill it passed on sale to the purchaser. Thus, in *Dickson v. McMaster & Co.*,<sup>10</sup> the agreement provided that on the termination of partnership the continuing partner (who was the owner of the premises on which the partnership business was carried on) was entitled to take over the shares of the retiring partners at a valuation. The court held that the goodwill, trade name and the trade marks of the firm also passed to the surviving partner, without further payment on a separate valuation of those particulars, but that he was not entitled to use the names of the retiring partners.

On the other hand, where there is no sale of goodwill and no provision for the use of the firm name each of the partners will have an equal right to the firm name on the dissolution of partnership. Thus, in *Burchell v. Wilde*<sup>11</sup> where a solicitors business was divided among the partners on dissolution it was held that the partner whose name was Burchell could not restrain the other partner Wilde from using the old name Burchell & Co. But a partner shall not use the old business name *simpliciter* if such use is likely to expose the late partner to any risk of liability.<sup>12</sup>

**Mortgage.**—The rule as to the rights of a mortgage in the goodwill was stated by Cotton, L.J., thus:—"It is obvious that to certain kinds of goodwill a mortgagee will be entitled. The goodwill which attaches to a house increases the value of that house, and therefore the mortgagee is entitled to that. By that I mean, for instance, there is a well-known public-house, and from its position being well-known, people go to it; or a well-known shop, from its being situated in a good thoroughfare, people go to it. The goodwill is attaching to the house, and adds to the value of the house. But there may be other goodwills attaching to the personal

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27 Beav. 446; Seb., Dig., p. 98; *Reynolds v. Bullock*, (1878) 47 L.J.Ch. 773; Seb. Dig., p. 375; In re *David & Matthews*, (1899) 1 Ch. 378; Express provision for exclusion of goodwill in the valuation may be provided in the articles of partnership and would then be binding, *Horden v. Horden*, (1910) A.C. 465.

(10) (1866) 18 Ir. Jur. 202; Seb. Dig., p. 154.

(11) (1900) 1 Ch. 551. See also *Banks v. Gibson*, (1865) 55 E.R. 753; 34 Beav. 566; 34 L.J.Ch. 591; Seb. Dig., p. 145 where this rule was first adopted; *Mancherje Manokaji Poonjiajee v. Framji Manokaji Poonjiajee*, (1900) 2 Bom.L.R. 1026.

(12) See footnote 19 on p. 409.

reputation which a man has made for himself. That, of course, does not go to the mortgagee, but is a thing personal to the man whose skill and whose name have acquired that goodwill. It does not follow at all that because it is called 'goodwill' the mortgagee will be entitled to it. So far as it is incident to the house, and is connected with the house, and increases the value of the house, it goes as part of the value of the house to the mortgagee."<sup>13</sup>

**Covenants in restraint of trade.**—It has already been mentioned in a previous section that at the time of sale the vendor and vendee may enter into any agreement to restrain competition among themselves. Ordinarily, covenants in restraint of trade are void in the eye of law, and the courts will not enforce them except under special circumstances. This equitable doctrine is enacted in Sec. 27 of the Indian Contract Act which reads:—"Every agreement by which any one is restrained from exercising a lawful profession, trade or business of any kind, is to that extent void."<sup>14</sup> The section is directed against "contracts by which a person precludes himself altogether either for a limited time or over a limited area from exercising his profession, trade or business," but not against "contracts by which in the exercise of his profession, trade or business he enters into ordinary agreements with persons dealing with him which are really necessary for the carrying on of his business."<sup>15</sup> It is seen from the wording of the section that only that portion of the agreement which amounts to a covenant in restraint of trade is void; and that the validity of the rest of the agreement is left unaffected.<sup>16</sup> The cases of *Madhub Chunder v. Rajcoomar Dass*<sup>17</sup> and *Nur Ali Dubash v. Abdul Ali*<sup>18</sup> may be cited here as examples where covenants in restraint of trade were held to be void.

(13) *Cooper v. Metropolitan Board of Works*, (1883) 25 Ch.D. 472; 53 L.J.Ch. 109.

(14) "Covenants of this class though they may be void and unenforceable are certainly not illegal in the sense of being contrary to law." Farran, C.J., in *Haribhai Maneklal v. Sharaf Ali Isabji*, (1897) 22 Bom 861; *Mogul Steamship Co. v. McGregor*, (1888) 21 Q.B.D. 544.

(15) Per Handley, J., in *Mackenzie v. Striramiah*, (1890) 13 Mad. 472.

(16) *Parasullah Mullick v. Chandra Kant Das*, (1917) 21 C.W.N. 979; *Mackenzie v. Striramiah*, (1890) 13 Mad. 472.

(17) (1874) 14 B.L.R. 76.

(18) (1892) 19 Cal. 765. See also *Oakes & Co. v. Jackson*, (1876) 1 Mad. 134; *The Brahmaputra Tea Co., Ltd. v. Scarth*, (1885) 11 Cal. 545; *Mackenzie v. Striramiah*, (1890) 13 Mad. 472.

**Covenants when valid.**—Under certain circumstances a covenant in restraint of trade may be valid.<sup>19</sup> These are laid down in Exception (1) to Sec. 27 of the Indian Contract Act and in Secs. 36 (2), 54, and 55 (3) of the Partnership Act. Exception 1 to Sec. 27 of the Contract Act reads: "One who sells the goodwill of a business may agree with the buyer to refrain from carrying on a similar business within specified local limits, so long as the buyer, or any person deriving title to the goodwill from him carries on a like business therein, provided that such limits appear to the court reasonable, regard being had to the nature of the business." Under Sec. 36 (2) of the Partnership Act "a partner may make an agreement with his partners that on ceasing to be a partner he will not carry on any business similar to that of the firm within a specified period or within specified local limits." Section 54 of this Act likewise provides for such agreements between partners upon or in anticipation of the dissolution of the firm. "Such agreement shall be valid if the restrictions imposed are reasonable." A similar provision is contained in Sec. 55 (3) of the same Act which lays down that any partner may, upon the sale of the goodwill of a firm, make an agreement with the buyer that such partner will not carry on any business similar to that of the firm and that such agreement shall be valid if the restrictions imposed are reasonable.

Where the vendor of the goodwill of a business enters into such a restrictive covenant with the vendee it will be presumed that the vendor has thus been able to obtain a higher price for the goodwill and to that extent the covenant is supported by valuable consideration. Whether the consideration is adequate the Court will not inquire; nor is it necessary that the consideration should be separately stated.<sup>20</sup> Similarly, the benefit of any covenant entered into between the vendor and his previous employees would pass to the vendee as being incident to the goodwill of the business sold in the absence of stipulations to the contrary. A covenant in restraint of trade between an employee and employer is not void.<sup>21</sup>

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(19) *Chandra Kanta Das v. Parasullah Mullick*, (1921) 48 Cal. 1030 (P.C.).

(20) A covenant in restraint of trade even when supported by consideration may be void under Sec. 27 of the Indian Contract Act, unless such covenants come under Sec. 36 (2) and 55 (3) of the Indian Partnership Act.

(21) *Subba Naidu v. Haji Badsha Sahib*, (1902) 26 Mad. 168; *Pragji Soorji v. Pranjivan Tooljiram*, (1903) 5 Bom.L.R. 878; *Charlesworth v. MacDonald*, (1898) 23 Bom. 103.

The general considerations for deciding whether the restrictions are reasonable are set forth in the following passage from the judgment of Farwell, J., in *Townsend v. Jarman*:<sup>22</sup> "I cannot state a better test of reasonableness than that given by Chief Justice Tindal, in *Horner v. Graves*.<sup>23</sup> He says: 'We do not see how a better test can be applied to the question, whether reasonable or not, than by considering whether the restraint is such only as to afford a fair protection to the interests of the party in favour of whom it is given, and not so large as to interfere with the interests of the public. Whatever restraint is larger than the necessary protection of the party can be of no benefit to either—it can only be oppressive; and if oppressive it is, in the eye of the law, unreasonable. Whatever is injurious to the interests of the public is void on the grounds of public policy.' Now, if a man, apart from any business, takes a covenant in gross from another man that he will not trade at all, that is simply oppressive. He does not require it to protect his own interest because he has no interest to protect. It is, therefore, only as incident to the business that the covenant can originally exist or have legal validity."

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(22) (1900) 2 Ch. 698; 17 R.P.C. at 662. "I think that a covenant entered into in connection with the sale of the goodwill of the business must be valid where the full benefit of the purchase cannot be otherwise secured to the purchaser. It has been recognised in more than one case that it is to the advantage of the public that there should be free scope for the sale of the goodwill of a business or calling. These were cases of partial restraint. But it seems to me that if there be occupations where the sale of the goodwill will be greatly impeded, if not prevented, unless a general covenant could be obtained by the purchaser, there are no grounds of public policy which countervail the disadvantage which would arise if the goodwill were in such cases rendered unsaleable." Per Lord Herschell, C., in *Thorsten Nordenfelt v. Maxim Nordenfelt Guns and Ammunition Co., Ltd.*, (1894) App. Ca. 535. For the history of the law relating to covenants in restraint of trade see the judgments of the Lord Chancellor & Lord Macnaghten in this case.

(23) (1831) 7 Bingham, 735; 131 E.R. 284.

## CHAPTER X.

### TRADE LIBEL.

A person shall not make false and malicious statements about the goods of his rival, his title to his mark or his business capacity in general. Such statements constitute trade libel. They are calculated to injure or destroy the trade reputation of a rival and will not be permitted by the court. Actions for slander of title sometimes arise in the course of passing-off suits. The defendant may often put in a counterclaim charging the plaintiff with trade libel.<sup>1</sup> In such cases the defendant generally contends that the plaintiff in the passing-off action had issued circulars or advertisements alleging infringement of his mark by the defendant and that he had threatened him with legal proceedings in respect of the infringements charged. It is proposed to discuss in this Chapter some of the requirements which must be satisfied in order to entitle the plaintiff to an action for trade libel. Before considering these points a brief history of the evolution of the law of trade libel in England will be given.

**View of the Chancery Courts before the Judicature Act.**—In the earlier cases the Chancery Court took the view that it had no jurisdiction in libel cases and that the injured party seeking relief should go to the common law court.<sup>2</sup> Thus, in *Clark v. Freeman*<sup>3</sup>

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(1) See *Ripley v. Arthur & Co.*, (1901) 18 R.P.C. 82; *Colley v. Hart*, 6 R.P.C. 17; (1890) 44 Ch.D. 179; 7 R.P.C. 101; *Nahmaschinen Fabrik Vormal's Frister Und Rossmann Actiengesellschaft and Siegmund Loewe v. The Singer Manufacturing Co.*, (1893) 10 R.P.C. 310.

(2) *Gee v. Pritchard*; Seb. Dig., p. 14; *Martin v. Wright*, (1833) 6 Sim. 297; 58 E.R. 605; Seb. Dig., p. 25; *Fleming v. Newton*, Seb. Dig., p. 49; *Browne v. Freeman*, (No. 2) W.N. (1873), p. 178; Seb. Dig., p. 253; *Fisher & Co., Ld. v. The Apollinaris Co., Ld.*, (1875) L.R. 10 Ch. 297; Seb. Dig., p. 274; *Mulkern v. Ward*, (1872) 13 Eq. 619. See also the Indian case *Shepherd v. The Trustees of the Port of Bombay*, (1876) I.L.R. 1 Bom. 132.

(3) (1848) 50 E.R. 759; 11 Beav. 112; Seb. Dig., p. 48. The decision in this case has been frequently commented upon; see *Williams v. Hodge & Co.*, (1887) 4 T.L.R. 175; *Lee v. Gibbings*, (1892) 67 L.T. (N.S.) 263. For a recent discussion of the judgment in this case see *British Medical*

Lord Langdale, M. R., refused the application of the physician Sir J. Clarke for an injunction restraining the defendant from advertising his quack medicine as "Sir J. Clarke's Consumption Pills." The Master of the Rolls said that in such a case the offence must first be established at law. "If, after that had been done, you find that an injury is thereby done to the plaintiff's property, or to his means of subsistence or of gaining a livelihood, I will not say that in such a case the court might not interfere by injunction." Again, in *Prudential Assurance Co. v. Knott*<sup>4</sup> where an action was brought to restrain the publication of a pamphlet which was calculated to injure the plaintiffs' reputation and business it was affirmed that the Court of Chancery had no jurisdiction to restrain the publication of a libel. The principle on which the Court of Chancery acted in such cases was based on the view that the court had power to intervene by injunction to protect property, but not to protect character, and that in the case of a trade libel there was no violation of a property right.<sup>5</sup>

A contrary view was, however, taken even in an early case,<sup>6</sup> by Malins, V. C. The plaintiff who was a well-known merchant in Liverpool brought an action for trade libel against a solicitor who had quarrelled with the plaintiff about his bill of costs and published repeatedly in newspapers and placards over the town that the plaintiff had been a member of an insolvent firm which had failed. In granting an injunction the learned Vice-Chancellor observed: "This court has jurisdiction to prevent the publication of any letter, advertisement or other document, which, if permitted to go on, would have the effect of destroying the property of another person, whether that consists of tangible or intangible property, whether it consists of money or reputation." His Lordship clearly stated that a trader has a right of property in his business reputation and that a trade libel which is likely to injure that right was actionable before the Court of Equity.

The matter was finally settled by the Judicature Act of 1873. The jurisdiction of the Court of Equity was considerably extended

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*Association v. Marsh*, (1931) 47 T.L.R. 472; 48 R.P.C. at pp. 572 and 573 (Maugham, J.).

(4) (1875) 10 Ch. 142; Seb. Dig., p. 271.

(5) See for instance the observations of Chitty, J., in *Collard v. Marshall*, (1892) 1 Ch. 571.

(6) *Dizon v. Holden*, (1869) 7 Eq. 488; Seb. Dig., p. 186.



and the court commenced to grant injunctions in trade libel cases.<sup>7</sup> For instance, in *Thorley's Cattle Food Co. v. Massam*<sup>8</sup> the defendants alleged that they alone possessed the secret recipe of the article and that the plaintiffs' article was not genuine and was being passed off for the defendants'. It was shown that the allegations were false. An injunction was granted by Malins, V. C., and his decision was affirmed by the Court of Appeal. Similarly, an injunction was granted by Fry, J., in *Thomas v. Williams*<sup>9</sup> restraining the defendants from issuing circulars representing or suggesting that the plaintiff's goods were imitations of the defendants. In all cases where there was the finding of fact by the jury that the defendant's act constituted a trade libel which was actionable the Court of Equity granted an injunction restraining further publication of the libel.<sup>10</sup> Thus, Lord Justice Lindley said: "The principle upon which the Courts of Equity have acted in declining to restrain the publication of matter alleged to be libellous, is, that the question of libel or no libel is pre-eminently for a jury. But, when a jury have found the matter complained of to be libellous, and that it affects property, I see no principle by which the Court ought to be precluded from saying that the repetition of the libel shall be restrained."<sup>11</sup>

**Requirements to constitute trade libel.**—In order to succeed in an action for trade libel or slander of goods the plaintiff must show: (1) that the defendant's statement complained of was made concerning his goods, or his business, (2) that it was untrue in fact, (3) that it was made in disparagement of his goods or business, (4) that it was made maliciously, and (5) that the plaintiff had suffered special damage thereby. Unless each and all of these things be established it must be held that the defendant has acted within his rights and that the plaintiff has not suffered any legal *injuria*.<sup>12</sup>

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(7) See judgment of Chitty, J., in *Collard v. Marshall*, (1892) 1 Ch. 571.

(8) (1880) 14 Ch.D. 763.

(9) (1880) 14 Ch.D. 864. Injunction was granted in *Hill v. Hart-Davies*, (1882) 21 Ch.D. 798; *Loog v. Bean*, (1884) 26 Ch.D. 306; *Hayward & Co. v. Hayward & Sons*, (1886) 34 Ch.D. 198; *Punch v. Boyd*, 16 L.R.Ir. 476; *Dunlop Pneumatic Tyre Co., Ltd. v. Maison Talbot*, 52 W.R. 254; *Collard v. Marshall*, (1892) 1 Ch. 571.

(10) *Hinrichs v. Berndes*, (1878) W.N. 11; Seb. Dig., p. 362.

(11) *Saxby v. Eastbrook*, (1878) 27 W.R. 188; Seb. Dig., p. 371.

(12) Per Lord Herschell, C., in *White v. Mellin*, (1895) App. Ca. 154. Followed:—*Royal Baking Powder Co. v. Wright, Crossley & Co.*, (1900)

**Trade puff not actionable.**—The statement must expressly allege that the plaintiff's goods are spurious or worthless. A mere commendation of one's own goods, or a trade puff, or even a mere disparagement of the plaintiff's goods is not actionable. A leading case on the point is *White v. Mellin*.<sup>13</sup> In that case the plaintiff (respondent in the House of Lords) who was selling "Mellins Infants' Food" brought an action for trade libel against the defendant for stating in the labels that his own "food for infants and invalids" was "far more nutritious and healthful than any other preparation." The action was dismissed by Romer, J. A new trial was ordered by the Court of Appeal, but the House of Lords reversed this order and dismissed the plaintiff's case. Lord Chancellor Herschell said: "I cannot help saying that I entertain very great doubts whether any action could be maintained of an alleged disparagement of another's goods, merely on the allegation that the goods sold by the party who is alleged to have disparaged his competitor's goods are better either generally or in this or that particular respect than his competitor's are." And Lord Watson observed: "Every extravagant phrase used by a tradesman in commendation of his own goods may be an implied disparagement of the goods of all others in the same trade; it may attract customers to him and diminish the business of others who sell as good and even better articles at the same price; but that is a disparagement of which the law takes no cognizance."

**True statement not actionable.**—It is a well settled rule that truth is a sufficient answer in an action for trade libel. Thus, in one of the early *Singer* cases,<sup>14</sup> after the commencement of the main action for passing-off, the plaintiffs issued an advertisement stating that persons had wrongfully used the name 'Singer' to designate other machines, that legal proceedings had been taken and that notice was given that all persons wrongfully using the name would be liable for so doing. The manufacturers of the defendants' machines thereupon brought an action<sup>15</sup> to restrain the *Singer* Company from issuing their circular on the ground that

18 R.P.C. 95 (H.L.); *Greers, Ltd. v. Pearman & Corder, Ltd.*, (1922) 39 R.P.C. 406; *Nemi Chand v. Wallace*, (1907) 34 Cal. 495; *Imperial Tobacco Co. v. Albert Bonnan* (No. 2), A.I.R. 1928 Cal. 1; 46 C.L.J. 455.

(13) (1895) App. Ca. 154. See also *Hubbock and Sons, Ltd. v. Wilkinson, Heywood and Clark, Ltd.*, (1899) 1 Q.B. 86.

(14) *Singer Manufacturing Co. v. Spence & Co.*, (1893) 9 T.L.R. 536; 10 R.P.C. 297.

(15) *Nahmaschinen Fabrik Vormal's Frister Und Rossman, etc. v. The Singer Manufacturing Co.*, (1893) 10 R.P.C. 310.

the language was unwarranted. Romer, J., held that the circular was not a libel as the statements contained therein were true. So also, in *Royal Baking Powder Co. v. Wright, Crossley & Co.*,<sup>16</sup> the Court of Appeal held that the circular issued by the defendants was not in any respect untrue and that the injunction should therefore be dissolved. Lindley, M. R., observed: "I cannot see any ground whatever for saying that there is any false statement at all on this document. It appears to me to state nothing more than was absolutely true. There is not a line to show that it is false. If that is so there is an end of the action." Injunction was refused on similar grounds in *Anderson v. Liebig's Extract of Meat Co., Ltd.*<sup>17</sup>

In *Nemi Chand v. Wallace*<sup>18</sup> a representation was made by the defendants to the Collector of Customs that the trade mark on the goods imported by the plaintiff was a colourable imitation of their trade mark. Thereupon, the Collector of Customs held an inquiry and detained those goods. An action for damages against the defendants for slander of title was dismissed by Sale, J., on the ground that no such action lay inasmuch as the plaintiff's trade mark on the goods was a counterfeit of the defendants'. An appeal was dismissed.

In considering whether the statement is a representation of truth the following rule laid down by Vaughan Williams, L. J., must be observed: "In all actions of defamation, properly speaking, and also in actions on the case in the nature of slander of title, the meaning of the writer of the libel complained of is quite immaterial. The question is not what the writer meant, but what he conveyed to those who heard or read according as it is a case of slander or libel."

**Malice must be shown.**—It is not enough to show that the defendant's representations are false; they must have been made maliciously also; that is to say "without just cause, or excuse."<sup>19</sup>

(16) (1899) 16 R.P.C. 217. In the House of Lords, (18 R.P.C. 95) Lord Davey dissented from this view, while Lords James and Morris concurred.

(17) (1881) 45 L.T.N.S. 757. Injunction was granted in *Gillette Safety Razor, Ltd. v. Pellett, Ltd.*, 26 R.P.C. 588, where false circulars were issued misrepresenting the legal proceedings in respect of a passing-off action by the plaintiffs.

(18) (1907) 34 Cal. 495; 11 C.W.N. 537.

(19) Per Lord Davey in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, (1900) 18 R.P.C. at p. 99.

The representations must have been made by the defendant with the direct object of injuring the plaintiff's trade. The law was clearly laid down in *Halsey v. Brotherhood*<sup>20</sup> in the following passage: "It seems to me to be clear law that in an action in the High Court in the nature of slander of title where the defendant has property of his own, in defence of which the supposed slander of the plaintiff's title is uttered, it is not enough that the statement should be untrue, but there must be some evidence, either from the nature of the statement itself or otherwise, to satisfy the court or the jury that the statement was not only untrue, but was made *male fide* for the purpose of injuring the plaintiff, and not in the *bona fide* defence of the defendant's own property. It seems to be clear that if a statement is made in defence of the defendant's own property, although it injures and is untrue, it is still what the law calls a privileged statement, it is a statement that the defendant has a right to make, unless besides its untruth and besides its injury express malice is proved—that is to say, want of *bona fides* or the presence of *mala fides*."

So, in *Ripley v. Arthur*,<sup>21</sup> a passing-off case, the defendants' counterclaim, alleging threats and claiming an injunction to restrain such threats, was dismissed by Farwell, J., on the ground that no malice on the part of the plaintiff was alleged and that the existence of the plaintiff's action was in itself conclusive to show that the plaintiff did not make the allegations maliciously but that he was making them in defence of that which he claimed to be his legal right. So also, in *Nemi Chand v. Wallace*<sup>22</sup> the action for slander of title was dismissed, Maclean, C. J., observing that the defendants had acted with perfect *bona fides* and in the honest belief that the plaintiff's trade mark was a colourable imitation of theirs, and that what they did in applying to the Collector was

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(20) (1881) 19 Ch.D. at p. 388. See also *Lyne v. Nicholls*, (1906) 23 T.L.R. 86; *Dunlop Pneumatic Tyre Co., Ltd. v. Maison Talbot*, (1904) 20 T.L.R. 579. In *Thomas Withers & Sons, Ltd. v. Samuel Withers & Co., Ltd.*, (1927) 44 B.P.C. 19, the plaintiffs alleged that the defendants' advertisements giving caution to purchasers of their "genuine Withers safes" constituted an innuendo that the plaintiffs were trying to pass off their goods as those of the defendants. It was held that there was no express malice and that the advertisements were not defamatory. An action for trade libel was dismissed.

(21) (1901) 18 R.P.C. 82. See also *Colley v. Hart* (2), (1890) 44 Ch.D. 193; 7 R.P.C. 101.

(22) (1907) 34 Cal. 495; 11 C.W.N. 537. Followed in *Imperial Tobacco Co. v. Albert Bonnan* (No. 2), A.I.R. 1928 Cal. 1.

done not for the purpose of injuring the plaintiff's goods but for the purpose of protecting their own.

It is, however, generally not difficult to establish malice once it is shown that the statement is false, for, the only question to decide in the case of a false statement is whether the person making the statement knew it to be false at the time of making it. As Lindley, L. J., observed, where a person makes a statement which he knows to be untrue it would not take much to persuade a jury that he was acting dishonestly.<sup>23</sup> But "honest belief in an unfounded claim is not malice," although "the nature of the unfounded claim may be evidence that there was not an honest belief in it. It may be so unfounded that the particular fact that it is put forward may be evidence that it is not honestly believed."<sup>24</sup>

**Special damage must be proved.**—Finally, to sustain an action for trade libel, damage must be specifically alleged and proved. The damage must be shown to have flowed from the libellous statement complained of. It is not enough to show that there has been generally some loss of custom. The special damage must be "certain and precise."<sup>25</sup> The leading authority on this point is *White v. Mellin*<sup>1</sup> which has already been referred to in an earlier section. In that case the House of Lords dismissed the plaintiff's action on the ground that no special damage had been shown as resulting from the defendant's act.

The necessity for proving special damage was discussed in the *Royal Baking Powder* case<sup>2</sup> in the House of Lords. Lord Robertson said: "Unless the plaintiff has in fact suffered loss which can be and is specified, he has no cause of action. The fact that the defendant has acted maliciously cannot supply the want of special

(23) *Halsey v. Brotherhood*, (1881) 19 C.D. at p. 392, citing *When v. Weild*, (1869) L.R. 4 Q.B. 730.

(24) Per Scrutton, L. J., in *Greers, Ltd. v. Pearman & Corder, Ltd.*, (1922) 39 R.P.C. 406. See also *Lord James' judgment in Royal Baking Powder Co. v. Wright, Crossley & Co.*, (1901) 18 R.P.C. at p. 102.

(25) Per Lord Robertson in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, (1901) 18 R.P.C. at p. 103. His Lordship referred to the judgment of Bowen, L.J., in *Batcliffe v. Evans*, (1892) L.R. 2 Q.B. 524, on the subject of special damage and quoted the following passage from the judgment: "The necessity of alleging and proving actual temporal loss with certainty and precision in all cases of this sort has been insisted upon for centuries."

(1) (1896) App. Ca. 154.

(2) *Royal Baking Powder Co. v. Wright, Crossley & Co.*, (1901) 18 R.P.C. 95.

damage, nor can a superfluity of malice eke out a case wanting in special damage." And, Lord Chancellor Halsbury said: "There is a class of cases, of which this is one, the true legal aspect of which, however they may be described technically, is that they are actions for unlawfully causing damage. The damage is the gist of the action, and, of course, however much in a certain sense the thing that is complained of may be the subject of animadversion, it gives no right to an action in a court of law unless damage is proved, because the damage itself is the gist of the action."

The same rule is followed in India. Thus, in *Nemi Chand v. Wallace*<sup>3</sup> the plaintiff's action for slander of goods was dismissed on the ground that no special damage was proved.

**Interlocutory injunctions.**—It has already been pointed out in Chapter VII that the granting of an interlocutory injunction is entirely within the discretion of the court, which will be exercised only, in exceptional cases where the granting of such injunction is absolutely required to protect the plaintiff's right. The same rule holds in trade libel cases. "To justify the court in granting an interim injunction, it must come to a decision upon the question of libel or no libel, before the jury have decided whether it is a libel or not. Therefore the jurisdiction is of a delicate nature. It ought only to be exercised in the clearest cases, where any jury would say that the matter complained of was libellous, and where, if the jury did not so find, the court would set aside the verdict as unreasonable."<sup>4</sup> Interlocutory injunction was granted in *Punch v. Boyd*<sup>5</sup> where the defendants maliciously caused placards to be posted warning the farmers that the plaintiff's machine-made firkins did not keep butter well. An interim injunction was likewise granted in *Collard v. Marshall*<sup>6</sup> to restrain a placard which stated that a strike was on at the plaintiff's works against cheap labour and the sweating system of contract work.

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(3) (1907) 34 Cal. 495; 11 C.W.N. 537.

(4) *Coulson (William) & Sons v. James Coulson & Sons*, (1877) 3 Times L.R. 740, 846. See also *Bonnard v. Perryman*, (1891) 2 Ch. 269; *Lee v. Gibbings*, (1892) 67 L.T. (N.S.) 263.

(5) (1885) 16 L.R.Ir. 476.

(6) (1892) 1 Ch. 571.

## CHAPTER XI.

### THE INDIAN MERCHANDISE MARKS ACT, 1889.

(Act No. IV of 1889.)

**Historical.**—The Indian Merchandise Marks Act was passed in 1889 on the lines of the English Act of 1887. Many of the corresponding sections in the two Acts are identical. The English Merchandise Marks Act was first enacted in 1862 and was replaced by the Act of 1887. The latter was amended in 1891, 1894 and 1926. The Act was directed to protect the rights of trade mark owners and to protect the public from unscrupulous traders. The sections of the Act accordingly comprised, (1) those relating to the use of false trade marks and (2) those dealing with false trade descriptions, stamping of length on piece-goods, etc. The Act contained no provision for the compulsory marking of the country of origin on imported goods. This question was considered by the Committee of 1890 who reported against the adoption of such a measure. The matter was considered again by another Committee in 1893, with special reference to imported foreign agricultural produce and the Committee reported that the problem of the compulsory marking of the country of origin on such imported goods was not impracticable. But the Committee of 1897 who reinvestigated the question could not recommend this course.

The subject was again dealt with by the Merchandise Marks Committee in 1919. The report of this Committee may be considered in some detail. The terms of reference to this Committee were:—

(1) whether any extension or amendment of the Merchandise Marks Act was required in respect of provision relating to indications of origin;

(2) the utility and effect of national trade marks or other similar (collective) marks and how far they should be authorised or encouraged in this country; and

(3) how far further international action may be necessary for the purpose of preventing the false marking of goods.

The report of this committee was submitted to the Board of Trade in June, 1920. As regards the first question the committee felt that the Board of Trade should have power to make an order requiring indications of origin on any class of imported goods, provided official enquiry showed that such order would be to the public interest. In making such an order, special account should be taken of the circumstances of the manufacture of the goods constituting unfair competition. Another recommendation was that no trade mark on the United Kingdom Register indicating the goods of a firm in that country should be allowed to be transferred in the register to a person or body of persons in a foreign country without the consent of the Registrar of Trade Marks. This suggestion deserves to be specially considered in India when a Trade Marks Act is enacted. On the second question, *viz.*, the use of national or other collective emblems, the committee were of opinion that in the absence of agreement among the bulk of the traders concerned there were grave objections to the institution of a British national or Empire mark. As regards the third question, the Committee recommended that efforts made at the International Conference to effect greater uniformity of laws and procedure in various countries should be energetically pursued, and that endeavours should be made to secure further adhesions to the Industrial Property Convention. The report of this committee led to the passing of the Merchandise Marks Act of 1926 (16 & 17 Geo. V, Ch. 53).

**The Indian Act of 1889.**—The Indian Merchandise Marks Act (Act IV of 1889), came into force on the first of April, 1889. It was later amended by Acts IX of 1891 and XVI of 1904. The Act extends to the whole of British India and has been declared in force in Upper Burma (excepting the Shan States) by Act XIII of 1898. The Act consists of 22 sections which deal with the following topics. Secs. 1 & 2 consist of title, extent and definition clauses. By Sec. 3 of the Act, Chapter XVIII of the Indian Penal Code, which relates to trade and property marks is amended and new Secs. 478 to 489 have been substituted. Secs. 4 to 7 of the Act deal with trade descriptions and penalty for applying false descriptions to goods or selling such articles. Unintentional contravention of the law relating to trade marks and descriptions as a ground of exemption from prosecution is dealt with in Sec. 8.



Sec. 9 deals with forfeiture of goods in cases of conviction under the Act. By Secs. 10 and 11 of the Act, Secs. 18 and 19 of the Sea Customs Act of 1878 have been amended and new sections have been substituted. Sec. 12 deals with the stamping of length on piece goods manufactured in British India. Secs. 13 to '22 contain supplemental provisions such as those relating to evidence of origin, limitation of prosecution, determination of character of goods by sampling, etc.

**Trade and property and other Marks.**—By Sec. 3 of the Merchandise Marks Act certain sections of the Indian Penal Code have been incorporated as part of this Act. Chapter XVIII of the Indian Penal Code comprises sections which deal with offences relating to documents and to trade, property, and other marks. Of these, Secs. 478 to 489 relate to trade, property, and other marks. These sections as originally enacted were repealed in 1889 and the present sections were substituted in their place.

#### **Trade Mark.—**

*“478. A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purposes of this Code the expression ‘trade mark’ includes any trade mark which is registered in the register of trade marks kept under the Patents, Designs and Trade Mark Act, 1883, and any trade mark which, either with or without registration, is protected by law in any British possession or Foreign State to which the provisions of the one hundred and third section of the Patents, Designs and Trade Marks Act, 1883, are under Order in Council, for the time being applicable.”*

This section corresponds to Sec. 3 (1) of the English Merchandise Marks Act of 1887.

**Section 103 of English Act of 1883.**—The Patents, Designs and Trade Marks Act, 1883<sup>1</sup> referred to in the section is the English statute of that year. Sec. 103 of the Act of 1883<sup>2</sup> relates to international arrangements for protection of inventions, designs and trade marks. Sub-Sec. (4) of this section reads: “The provisions of this section shall apply only in the case of those Foreign States with respect to which His Majesty shall from time to time by Order-in-Council declare them to be applicable and so long only in the case of each state as the Order-in-Council shall continue

(1) This Act was amended in 1888, 1905, 1914 and 1919.

(2) This section is now replaced by Sec. 91 of the Patents and Designs Act, 1907.

with respect to each state." Sec. 104 makes similar provision for arrangements between Great Britain and her Dominions and Colonies. The reference to British possession in Sec. 478, I.P.C. suggests that Sec. 104 of the English Act of 1883 is also meant to apply though this section is not specifically referred to. The term 'British possession' is explained under Sec. 117 of the Act of 1883 and means "any territory or place situated within Her Majesty's Dominions and not being or forming part of the United Kingdom or the Channel Islands or the Isle of Man, and all territories and places under one legislature are deemed to be one British possession for the purpose of this Act." The list of foreign states and British possession to which the provisions of Secs. 103 & 104 are made applicable is given in the Appendix. It will be seen from this list that India is excluded owing to the absence of a Trade Marks Registration Act in this country.

**Foreign marks enjoy more advantages.**—As Section 478 I.P.C. stands at present, foreign and colonial trade marks, registered or unregistered, are entitled to protection under the Indian Merchandise Marks Act. But Indian trade marks are not entitled to any protection in these states or foreign countries. The arrangement is thus one-sided and most unfair to India. Any reciprocity arrangement which England enters into with any foreign state automatically commits India to obligations without any concomitant rights.

This anomalous situation has arisen from the fact that the framers of the Indian Act had merely adopted the definition of a trade mark as given in the English Merchandise Marks Act. It may be of interest to inquire why this definition was adopted in England. On the accession of Great Britain in 1884 to the International Convention it became necessary to amend the law of the country so as to give effect to article IX of the Convention, which reads as follows:—"All goods illegally bearing a trade mark or trade name may be seized on importation into those states of the Union where this mark or name has a right to legal protection." It must have been realized in England that the protection extended to foreign and colonial marks is greater than that accorded to English marks. Whereas in the case of home marks the Merchandise Marks Act confines its protection to registered trade marks, in the case of foreign marks it extends the protection to both registered and unregistered ones. Nevertheless, there is probably no real hardship to owners of common law marks in

England. For, in the first place the arrangement is a reciprocity one whereby the home common law marks are entitled to the same protection in the contracting states as the common law marks of any of those countries in England. Secondly, although the English common law marks are not protected as trade marks under the Act, they can in most cases obtain protection under the provisions relating to the application of false trade description which term has been extended by Sec. 3 (2) to include all trade marks.

Reverting to the case of India, it may be pointed out that in 1889 when the Indian Merchandise Marks Act, was first enacted, India had already decided not to accede to the International Convention when the subject was moved by the Secretary of State for India in 1884.<sup>3</sup> There was therefore no need or justification for the introduction in the Indian Act of such a unilateral provision for the protection of foreign marks.

**Trade marks classified.**—A reading of Section 478 I.P.C. will show that the definition of a trade mark includes the following kinds of marks:—

(1) Marks registered on the English Trade Marks Register.

(2) Marks registered on the Trade Marks Registers of British Possessions to which the provisions of Sec. 103 of the Act of 1883 are under Order-in-Council applicable.

(3) Marks which though unregistered are still protected under the law in such British possession.

(4) Trade marks registered on the Trade Marks Registers of foreign countries which are members of the International Convention.

(5) Trade Marks which though unregistered are still protected under law in countries specified in (4).

(6) Indian Trade Marks.

It is important to note the words “the expression trade mark includes any trade mark, etc.” The Section gives a broad definition of a trade mark and specifically states that certain kinds of marks are included under this definition. It is curious that in defining a trade mark the section does not make any specific reference to trade marks acquired by user in India.

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(3) Despatch No. 8 of 3rd April 1884.

**Colonies and Foreign States more favoured than England.—**

It will be seen from Sec. 478 that the unregistered marks of England are not included, so that England gets a less favourable treatment in India than her colonies or foreign states. The omission of user in India as a requirement for protection under the Merchandise Marks Act, is a serious defect.

**Apparent conflict between Criminal and Civil Law.—**

According to the civil law of the country relating to trade marks, title to a mark arises solely from prior exclusive user in India. Title to the mark in a foreign country does not by itself confer on its owner any rights in India, and the courts do not take judicial cognisance of user of the mark outside the country. On the other hand, the wording of Sec. 478 I.P.C. gives room for a possible interpretation that notwithstanding prior user in India a person may be committing an offence under the Act, if it is shown that the mark in question has been entitled to legal protection from an earlier date in any of the convention countries. Such a construction was actually put by the Supreme Court of Newfoundland<sup>4</sup> on Sec. 2 of their Trade Marks Act,<sup>5</sup> which uses the same language as Sec. 478 I.P.C. in defining a trade mark.

It will be seen at once that this interpretation of Section 478 would give rise to an anomalous position. Any trader whose mark, registered or unregistered, is entitled to protection in a foreign country may claim the mark as his own as against a person having the right of prior user in the mark in India. Obviously this could not have been the intention of the Indian legislators in framing the Act.

**Imperial Tobacco Co. (Newfoundland), Ltd. v. Duffy.**—In this Newfoundland case<sup>6</sup> the plaintiff company had been using since 1910 a trade mark consisting of a representation of a 'clover leaf' in

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(4) *Imperial Tobacco Co. (Newfoundland), Ltd. v. Duffy*, (1918) A.C. 181; 35 R.P.C. 12.

(5) Section (2) of the Newfoundland Act reads "The expression 'trade mark' means a trade mark registered in the Register of trade marks kept under the provisions of this chapter, and includes any trade mark which, with or without registration is protected by law in any British possession or foreign state, to which the provisions of the one hundred and third section of the Imperial Patents, Designs and Trade Marks Act, 1883 are under Order-in-Council for the time being applicable."

(6) *Imperial Tobacco Co. (Newfoundland), Ltd. v. Duffy*, (1918) A.C. 181; 35 R.P.C. 12.

connection with tobacco and had described the goods as the 'clover' brand. In 1915 the defendant imported from Larus Brother & Co., a company incorporated in Virginia, U.S.A., tobacco which bore a similar trade mark as the plaintiffs' and was described as the 'clover leaf' tobacco. Thereupon, the plaintiffs registered their mark in Newfoundland and commenced an action for infringement. It was shown that Larus Co., had been using the mark in question in America from 1896 but the firm had not used the mark in Newfoundland before 1915. The plaintiff company when they adopted the mark were in ignorance of the existence in America of the Larus Co.'s mark. It was admitted that the Larus mark was protected by law in the United States to which country the provisions of Sec. 103 of the Act of 1883 were applicable. The question for decision was whether by extending to Newfoundland a user which prior to 1915 had been confined to the United States the defendant was infringing the plaintiffs' trade mark in Newfoundland. It was contended on behalf of the defendant that by virtue of the protection in America the Larus mark had become a trade mark in Newfoundland and that no user in the latter country need be proved. It was argued that the plaintiffs had committed an offence under Sec. 1 of the Newfoundland Act which dealt with offences relating to forging and falsely applying trade marks and that the plaintiffs could not, in such circumstances, be entitled to any injunction. This contention was accepted by the court and judgment was given for the defendant with costs. The decision was affirmed by the Appeal court of Newfoundland, but was reversed by the Privy Council on further appeal. Their Lordships of the Privy Council said that they "were unable to accede to the argument that in using in Newfoundland their own trade mark, the appellants are so acting as to commit any offence within Sec. 1 of Chap. 112. The appellants are not forging the respondents' Trade Mark; they are using their own. They are not falsely applying to goods any trade mark so as to be calculated to deceive." Their Lordships added:—"The definition in Sec. 2 confers no rights in respect of a Trade Mark. The rights are to be found elsewhere."

**Section 478 explained.**—Section 478, I.P.C., is undoubtedly ill-drafted.' But, the decision of the Privy Council in the above

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(7) As the definition of a trade mark stands at present, a situation of the following nature may arise which will be difficult to decide. The representative of an American firm in India may request the Collector of

case removes any ambiguity regarding its interpretation. The rights accruing from user in India are not affected in any manner by prior user or registration of the same or a similar mark abroad. The reference to foreign marks in the section is merely intended to extend to them the protection which is available for Indian marks under the Merchandise Marks Act. But, in effect the foreign marks are placed in a position of distinct advantage as compared with Indian marks. In the case of a foreign mark it is not necessary to prove actual user in India or even in the country of origin. The mere production of the certificate of registration in the foreign country will be sufficient for the courts to take judicial cognisance of the mark. This is not possible in the case of Indian marks.

In *Gobinda Chandra Roy v. Abdul Rashid*,<sup>8</sup> the court said that in the case of an Indian mark one has to prove under Sec. 478 Indian Penal Code that "the goods which are the subject of the mark are manufactured and sold by himself and that such goods are known in the market as being of his manufacture alone." In this case their Lordships held that there was no offence under Sec. 478 I.P.C. as it was not established that the mark was exclusively associated with the complainant's goods. The enactment of a Trade Marks Registration Act in India will facilitate actions under the Merchandise Marks Act by enabling the aggrieved person to satisfy the court by merely producing a certificate of registration that the mark in question is a trade mark and that he is the owner of the mark. An amendment of Sec. 478 I.P.C. may then be necessary.

The question, what constitutes a trade mark, has been discussed at length in an earlier chapter.<sup>9</sup> We need only point out here that the definition of a trade mark as given in this section excludes a trade description which is dealt with in Sec. 6 of the Merchandise Marks Act.

**Get-up.**—Where there is an infringement of the get-up associated with the merchandise of the plaintiff an injunction and

Customs to detain goods imported from Japan on the ground that the Japanese trade mark on the goods is a counterfeit of his American trade mark. The trade mark may not have been used at all in India, but each may contend that the mark is protected under law in his respective home country.

(8) A.I.R. 1928 Cal. 235. See also *Anookool Chunder Nundy v. Queen Empress*, (1900) 27 Cal. 776.

(9) See Chapter IV.

other relief may be obtained by filing a suit for passing-off. Action may also be taken under the Indian Merchandise Marks Act in such cases of fraudulent imitation of get-up. Thus in *Nilmoney Nag v. Durga Pado Banerjee*<sup>10</sup> the alleged counterfeiting consisted in the close imitation of the design and the label of the complainant's box of tooth powder. It was held that the expression "trade mark" as defined in Sec. 478 Indian Penal Code, covered the whole design and the label on the box. The same view was taken in *Sirumal v. Emperor*<sup>11</sup> by Mehta, A. J. C.

### Property Mark.—

"479. A mark used for denoting that movable property belongs to a particular person is called a property mark."

The distinction between a trade mark and a property mark is not found in the English Act of 1887. The same person A. B. may be engaged in manufacturing and selling different classes of goods. The marks used to designate any particular class of goods as his manufacture would be his trade mark. But if he chooses to use a common mark to designate all his manufactured articles irrespective of the class of goods to which they belong, this mark would constitute his property mark.

In *Emperor v. Dahyabhai Chakasha*<sup>12</sup> the National Bank of India was importing and selling bars of gold of uniform size with the words "National Bank of India" impressed in Guzerati characters. These gold bars were known in the market as "Nasranna Bak." The accused who placed on the market other gold bars with the words "Nasranna Bak" impressed on them in Guzerati was held guilty of counterfeiting the property mark of the complainants.

The term "property mark" in Sec. 479 was explained by Chandavarkar, J., in the above case thus: "A property mark is intended to denote ownership over all movable properties belonging to him whether it is all of one kind or different kinds. So long

(10) (1915) 19 C.W.N. 957.

(11) A.I.R. 1932 Sind 94; 26 S.L.R. 241; 139 I.C. 335. See also the cases of *Emperor v. Ganapat Sitaram Mukadam*, (1914) 16 Bom.L.R. 78; *Palli Ram v. Emperor*, A.I.R. 1931 Oudh 277; 134 I.C. 477; *Faqir Chand v. Emperor*, (1934) 16 Lah. 114; 155 I.C. 270; A.I.R. 1934 Lah. 687; *Emperor v. Tapidas Durlabdas*, 9 Bom.L.R. 732. Cf. *Petley & Son v. Sahkyun*, (1903) 2 L.B.R. 159, and *Stephen Abkyum v. Petley*, (1903) 19 Bur.L.R. 1284, where it was held that "get-up" does not constitute a trade mark under section 478, Indian Penal Code.

(12) (1904) 6 Bom.L.R. 513.

as the person owned movable properties his property mark which has been or may be impressed upon them remains his though any particle out of it may after such impression pass out of his hands and cease to be his. I think that the term 'movable property' in Sec. 479 was intended by the Legislature to include a class or category of properties falling under one ownership, not merely portions of it which may pass from the hands of the owner into other hands. The class is stable though the units are ambulatory. A class may be likened to a chain with a multitude of links, some of which from time to time drop off, but there are others left or those extinct or replenished by fresh links to keep the chain going. So long as the chain remains the movable property represented by it is there, though its component parts fluctuate. The term "movable property" as used in Sec. 479 was intended to include collective class of nouns, (i.e.), nouns that express the number of objects of the same class collected together. . . . The property mark which the National Bank claims as theirs is intended to denote all the movable property as theirs. Their property consists not merely of the gold they import and sell as theirs, but all other movable properties also. . . . In that sense they must be assumed to have always actual existing property denoted or capable of being denoted by their mark. The mere fact, therefore, that at the time the counterfeiting occurred the Bank had sold parts of that collective mass or class does not divest them of their ownership over the marks or class itself."

#### Using a false trade mark.—

"480. *Whoever marks any goods or any case, package or other receptacle containing goods, or uses any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.*"

This section was explained by Mehta, A.J.C. in *Sirumal v. Emperor*,<sup>13</sup> thus:—Not only whosoever marks any goods or package or receptacle containing goods but also whosoever uses any such package or receptacle with any such mark thereon is said to use a false trade mark, if the whole thing is done in a manner reasonably calculated to cause it to be believed that the goods are of a certain



manufacturer whereas they are not of that manufacturer. In that case it was contended that the actual place of manufacture of the goods bearing the counterfeit mark was not Karachi where the suit was instituted. The learned judge, however, rejected this plea as in his opinion not only marking goods with false marks, but also offering such goods for sale would constitute an offence under Sec. 480, I.P.C. His Lordship expressed the opinion that even the mere act of advertising goods bearing a false trade mark might amount to infringement of the mark. Sec. 480 is thus wide in its application.

The ingredients of an offence under Sec. 480, I.P.C. were enunciated by Otter, J., in *Pakir Mahomed v. Emperor*.<sup>13-a</sup> "In order to establish a case, the prosecution must prove: (1) that the accused marked the goods; (2) that he did so in a manner reasonably calculated to cause it to be believed that the goods so marked are the manufacture or merchandise of some other person; (3) that such goods are not the manufacture or merchandise of such person."

Offences under this section may be classified as follows:—

(1) Marking one's own goods or case, package or receptacle containing such goods with another's mark or one so resembling it as to be calculated to deceive.

(2) Marking with his own mark another's goods or case, package or receptacle containing the other's goods in a manner reasonably calculated to cause it to be believed that the goods so marked or any goods contained in any such receptacle so marked are his own manufacture or merchandise when they are not.

(3) Using any case, package or receptacle with another's mark in a manner reasonably calculated to cause it to be believed that the goods contained in such receptacle so marked are the goods or merchandise of that person when they are not.

(4) Using any case, package or receptacle with his own mark in a manner reasonably calculated to cause it to be believed that the goods contained in such receptacle so marked are his own goods when they are not.

The word "whoever" is not defined in the Act. It may be interpreted as equivalent to the term "any person who" and includes any company or association or body of persons whether

incorporated or not. Sec. 3 (1) of the English Act runs: "Every person who", etc., "shall be guilty of this offence under this Act," and the word "person" is expressly defined in the section so as to include "any body of persons corporate or incorporate."

The question whether a limited company is liable to prosecution under the Merchandise Marks Act was raised in *Seena M. Haniff & Co. v. Liptons, Ltd.*,<sup>14</sup> and it was held that limited companies are not excluded from the operation of Secs. 482 and 486, I.P.C.

The expression "*marks any goods or any case, package or other receptacle containing goods*" has the same meaning as given in Sec. 5 of the Act in respect of the application of trade descriptions (*Vide* Sec. 4 (1) of the Act.). The marks may be applied to the goods themselves or to any covering, label or reel with which the goods are sold or exposed for sale. They need not be actually fixed to the article. A person shall be deemed to apply a trade mark if he places, encloses or annexes any goods which are sold or exposed for sale in, with or to any covering, label, reel or other thing to which the mark is applied (Sec. 5 (1).) The expression "covering" is defined to include any stopper, cork, bottle, vessel, box, cover, capsule, case, frame or wrapper. (Section 5 (3).) It is laid down by Sec. 5 (2) that a trade description shall be deemed to be applied whether it is woven, impressed or otherwise worked into or annexed or affixed to the goods or any covering, label, reel or other thing. The same thing applies to a trade mark also. It is sufficient if the infringing mark is on the cover in which the articles are sold or on circulars and advertisements offering them for sale. A slip or a show card with the false mark kept in a package containing the goods would constitute an infringement.<sup>15</sup>

**Does the expression "goods" cover books?**—It is not clear whether the word "goods" includes books. In *Kanai Das Bairagi v. Radha Shyam Basak*<sup>16</sup> their Lordships O'Kinealy and Bannerjee, JJ., said that books were the subject of trade and were "goods" within the meaning of Sec. 2, Cl. 4, of the Indian

(14) (1914) 7 L.B.E. 306; 23 I.C. 689; 7 Bur.L.T. 116. See also *Pakir Mahomed v. Emperor*, A.I.R. 1929 Rang. 322.

(15) See *Chameleon Patents Manufacturing Co., Ltd. v. Marshall's, Ltd.*, (1900), 17 R.P.C. 527.

(16) (1898) 26 Cal. 232.

Merchandise Marks Act, and that, therefore, when a person sold books with a counterfeit property mark he committed an offence under Sec. 486 of the Indian Penal Code. Their Lordships said: "It has been argued that books are not 'goods' under Act IV of 1889. 'Goods' is defined in that Act to be anything which is the subject of trade or manufacture and although it was not argued that in ordinary language books are not the subject of trade, yet it was said they were not the subject of the trade within the meaning of that Act. 'Trade' is not defined, and we must therefore take the ordinary meaning of that word. That being so, there can be hardly any doubt that books are the subject of trade and a very large trade in Bengal; therefore books are covered by the word 'goods' ". The same view was taken in *Raghavulu Naidu v. Sundaramurthi Mudali*.<sup>17</sup>

But in *Radha Krishna Joshi v. Kissonlal Shridar*<sup>18</sup> the Bombay High Court was of opinion that the terms "merchandise", "manufactured" and "goods" should not be applicable to books within the meaning of the Merchandise Marks Act. Fulton, J., said: "Assuming that books are 'goods' as held in *Kanai Das Bairagi v. Radhashyam Basak*, it cannot, I think be said that they are "manufactured" by their authors. The word "manufacture" is not a term usually applied to books, but even if it may be correctly applied to the whole process by which books are prepared, it certainly seems impossible to apply it to that portion of the process known as authorship, which though most important is ineffectual without printing and publication." His Lordship added, "we must construe Sec. 478 in its ordinary grammatical sense, and if this test be applied, it will, I think, be found that the definition of trade mark is not sufficiently elastic to protect the rights of authors. Copyright Acts and the general Civil law may or may not be sufficient to protect them, but however this may be, we cannot distort the language of the Penal Code so as to bring within its provisions literary piracy, as alleged in this complaint." In that case the complainant who was a descendant of Shri Chandu had for several years been preparing a calendar bearing the name "Shri Chandu Panchang" while the defendant published

(17) (1907) 31, Mad. 512. In re *Kanchi Doraisamy Mudaliar*, (1910) 7 M.L.T. 309; 6 Ind. Cas. 683 a conviction under Secs. 482 and 486 I.P.C. could not be sustained as the title pages of the two books were so different that in the opinion of the court no one was likely to be deceived by the book of the accused.

(18) (1901) 26 Bom. 289.

under the same title another calendar prepared under the same system and not differing in text from the complainant's calendar. It was held that there could not be any conviction under Sec. 482 I.P.C. as the title "Shri Chandu Panchang" could not fall under the definition of a trade mark under Sec. 478, I.P.C.

It might be pointed out in this connection that a plaintiff is entitled to an action for passing off where the defendant's book is calculated to mislead the public and is likely to be passed off as and for the plaintiff's work. "The description of the contents of a book" said Maugham, J., "may become so far associated with the book of a particular author that it is capable of proof that the use of it by itself, without explanation or perhaps qualification, by another publisher, would deceive a purchaser into the belief that he was getting a book written by A, when he was in fact getting an entirely different book written by B."<sup>19</sup> In such cases an injunction will be granted although no infringement of the copyright had taken place. It would be legitimate for the plaintiff to expect the protection under the criminal law also in these cases.

The expression "*Manner reasonably calculated to cause it to be believed, etc.*" is used in Secs. 480 and 481, I.P.C. and the expression "*reasonably calculated to lead persons to believe, etc.*" is used in Sec. 4 of the Indian Merchandise Marks Act. The two expressions obviously mean the same thing. In the English Statute of 1887 the expressions used are "so nearly resembling a trade mark as to be calculated to deceive" and "reasonably calculated to lead persons to believe." The former expression is taken from Sec. 72 of the Trade Marks Act of 1883, now replaced by Sec. 19 of the Act of 1905.

Sec. 480 I.P.C. corresponds to Sec. 5 (3) of the English Merchandise Marks Act of 1887. This section states that "a person shall be deemed to falsely apply to goods a trade mark or mark, who without the assent of the proprietor of a trade mark applied such trade mark, or a mark so nearly resembling it as to be calculated to deceive, but in any prosecution for falsely applying a trade mark or mark to goods the burden of proving the assent of

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(19) *Mathieson v. Sir Isaac Pitman & Sons, Ltd.*, (1930) 47 R.P.C. 541. See also *Samuelson v. Producers Distributing Co., Ltd.*, (1932) 1 Ch. 201; 48 R.P.C. 447, 580; *Houghton v. Film Booking Offices, Ltd.*, (1931) 48 R.P.C. 329.

the proprietor shall lie on the defendant." There is no reference to "assent of the proprietor" in Sec. 480, I.P.C.

The court has to decide in every case whether in the circumstances what was done by the accused was calculated to lead the purchasers to buy the goods of the accused under the wrong belief that they were buying the goods of another. In *Farina v. Silverlock*<sup>20</sup> Lord Cranworth held that the defendant who copied the labels of the plaintiff would not be guilty of infringement if he proved to the satisfaction of the court that labels were printed only to replace worn-out labels properly used in connection with the plaintiff's goods. This, however, he failed to do in that case, and the plaintiff was consequently granted an injunction. In *Rose v. Henley*<sup>21</sup> Vice-Chancellor Malins held that the use of marked or stamped bottles for goods other than the genuine goods was an infringement. This case may be compared with the Indian case *Olpadvolla v. James Wright*<sup>22</sup> where the accused who was the owner of a soda water company used the soda water bottles bearing the trade mark of the complainant. It appeared, however, that there was a common practice for various kinds of bottles to be used by the firms indiscriminately and that the accused in this case had acted innocently. The accused was in the circumstances acquitted. In *Emperor v. Po Saing*<sup>23</sup> the accused was selling kerosene oil of his refining in tins used by the Burmah Oil Co. with their oil and having embossed on them the name of the Burmah Oil Company. Only paper labels indicating the name of the actual manufacturer of the oil were affixed. It was held that the accused committed an offence under Secs. 480 and 482, Indian Penal Code. In *Manavala Chetty v. Emperor*<sup>24</sup> where the accused was convicted under Sec. 480, Indian Penal Code, for selling soaps of German manufacture in boxes bearing the trade

(20) (1858) 1 K. & J. 509; 69 E.R. 560; 24 L.J.Ch. 632.

(21) (1877) 47 L.J.Ch. 577.

(22) A.I.R. 1928 Cal. 873; 32 C.W.N. 1115; 117 I.C. 691.

(23) (1907) 4 L.B.R. 192.

(24) (1906) 29 Mad. 569. In *Stone v. Burn*, (1911) 1 K.B. 927 a bottler of beer, having in the course of business come into possession of certain bottles belonging to another brewery company and embossed with that company's name filled them with beer brewed by Bass & Co., placed Bass & Co.'s labels upon them and sold the contents as being Bass & Co.'s beer. It was held that the appellant had applied a false description to the beer.

mark of Messrs. Pears & Co., although the false mark appeared upon the box and not upon the goods themselves.

The application of Sec. 480 is wider than would appear at first sight. Not only does it apply to the false application of another mark to one's own goods but also to the converse case of the owner of a mark selling under his own mark the goods obtained from another, irrespective of the quality of the goods so sold. The case of *Starey v. The Chilworth Gunpowder Co.*,<sup>25</sup> is illustrative of this point and is discussed later.

**Standard of comparison**<sup>25-a</sup>.—It is impossible to lay down any definite test as to the degree of resemblance which would be required in order to determine whether the mark in question is a false mark within the meaning of this section. In *Seixo v. Provezende*<sup>1</sup> Lord Cranworth said: "In order to entitle a party to relief, it is by no means necessary that there should be absolute identity. What degree of resemblance is necessary is, from the nature of things a matter incapable of definition *a priori*. All that courts of justice can do is to say that no trader can adopt a trade mark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled. It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the marks side by side. The rule so restricted would be of no practical use. If a purchaser, looking at the article offered to him, would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the court considers the use of such a mark to be fraudulent." As Lord Herschell's Committee<sup>2</sup> observed, it is possible that notwithstanding many differences which two marks may exhibit when placed side by side, the main idea left by both may be the same. In such cases the public not having the two marks side by side for comparison are likely to be misled. What the court has to decide is, therefore, whether the mark complained of is reasonably calculated to deceive the public in spite of the several differences which may be brought out on a careful comparison of the two marks.<sup>3</sup> The rule was stated by Page, C. J. and Das, J., in

(25) (1889), L.R. 24 Q.B.D. 90.

(25-a) See Chapter VI.

(1) (1866) L.R. 1 Ch. 192; 14 W.R. 357.

(2) Report of 1888.

(3) *Nemi Chand v. Wallace*, (1907) 11 C.W.N. 537; 34 Cal. 495.

*Eastern Asiatic Match Co., Ltd. v. Kemmendine Match Co., Ltd.*,<sup>4</sup> thus: "The main test was that notwithstanding the similarities between the two marks there was contained in the defendants' article such characteristic features as might reasonably lead an unwary purchaser buying the article to believe that he was buying the plaintiffs' article." In the case of word marks the court will judge them both by their look and by their sound.<sup>5</sup>

**Nature of the market and class of goods.**—The nature of the market in which the goods are sold would be an important factor in considering the question of probability of deception.<sup>6</sup> Where the goods are marked in a foreign language the ignorance of the language by the local purchasers has a material bearing on the question. So, in the *Two Elephants'* case<sup>7</sup> Lord Selborne said that, although the defendants' label could not be mistaken in England for the plaintiffs', it might still be calculated to mislead the people of Aden or India unable to read and understand the English language. The same view was also expressed in the Indian cases *Holland Bombay Trading Co. v. Buktcar Mull and Bal Kissen*<sup>8</sup> and *Nemi Chand v. Wallace*.<sup>9</sup>

The class of goods which are sold is also material in considering the question of probability of deception. In the case of goods which are very costly it may be expected that greater care will be taken by the purchaser in examining the genuineness of the trade mark on the goods. The same would be the case where the class of probable purchasers of the goods in question is confined exclusively to educated people. The custom of the trade must also be considered. Where, for instance, a number of more or less similar trade marks are in common use in a particular trade a finer distinction between the marks is possible.<sup>10</sup>

**Class of purchasers.**—It is well settled that in deciding probability of deception it is the interest of the ordinary purchaser

(4) A.I.R. 1931 Rang. 213; 134 I.C. 217.

(5) Per Lord Parker in the *Pianotist Co. Ltd.'s, Application*, (1906) 23 R.P.C. 774.

(6) See Chapter VI.

(7) *Johnston v. Orr Ewing*, (1882) 7 App. Cas. 219.

(8) (1903) 8 C.W.N. 421.

(9) (1907) 11 C.W.N. 537; 34 Cal. 495.

(10) *Malumiar & Co. v. Finlay Fleming & Co.*, A.I.R. 1929 Rang. 345; 7 Rang. 169; 30 Cr.L.J. 882; *Adamjee Hajee Dawood & Co. v. The Swedish Match Co.*, A.I.R. 1928 Rang. 210.

using ordinary caution that should be considered.<sup>11</sup> It is immaterial whether an expert in the trade was aware of the differences between the two marks and was not deceived. The fact that retail purchasers were not deceived would not, for instance, form sufficient ground for defence.<sup>12</sup> In *Badische Aniline and Soda Fabrik v. Maneckji Shapurji Katrak*,<sup>13</sup> Sargant, C. J., said: "The question in a case of this description is not what would be the effect on brokers or even dealers in Bombay; but how the label would be likely to strike incautious or unwary purchasers, such as are to be found more particularly in the mofussil." The rule was stated in substantially similar language in *Nallaya Pillai v. Rangasami Pillai*.<sup>14</sup> In *Aswini Kumar Pal v. Emperor*<sup>15</sup> the court observed that the proper test is not whether a person who is the least on the alert or one who, having the two tins side by side, would be deceived, but it must be considered from the point of view of the unwary purchaser.

In *Pakir Mahomed v. Emperor*<sup>16</sup> the prosecutors were a firm of importers of blankets from Holland. Their mark consisted of a crown while that of the plaintiffs consisted of a fez for the same class of goods. The inscriptions in the two marks consisted respectively of the names of the two companies. It was contended that by long user the prosecuting firm's mark had come to be well known as the "topee" mark, and that as the mark of the appellant firm was known as "Turkish topee" mark, persons requiring a blanket of the 'topee' mark might well be deceived into purchasing the appellants' blankets. The learned judge said that although the mark of the respondents should be correctly described as the 'crown' and that of the appellants as "fez" or "Turkish cap" evidence showed that the respondents' blankets were actually known in the market as "topi" mark blankets and that they were, therefore, entitled to the mark. Otter, J., observed: "It has been said over and over again in decided cases that it is the interest of the purchaser and especially the ignorant purchaser in a country such as

(11) See Chapter VI where this topic is discussed at length.

(12) *Lever v. Goodwin*, (1887) 36 Ch.D. 1; 4 R.P.C. 492; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, (1886) 31 Ch.D. 454; 3 R.P.C. 28.

(13) (1893) 17 Bom. 584. See also *Abdul Salam v. Hamidullah*, (1912) 166 P.W.R. 1912; 15 I.C. 116; *Herbert Whitworth, Ltd. v. Jamnadas Nemichand Mehta*, (1927) 52 Bom. 228; 30 Bom.L.R. 514.

(14) (1895) 1 Weir. 556.

(15) (1930) 34 C.W.N. 524.

(16) A.I.R. 1929 Rang. 322.



this which has mainly to be considered." The same view was held in *Sassoon v. Mills*,<sup>17</sup> *Chwan Swee Bee v. National Carbon Co.*,<sup>18</sup> *Moolji Sicca & Co. v. Ramjan Ali*.<sup>19</sup>

But the probable person should not be taken to be an abnormally stupid person or an idiot. The purchasers should not be taken to be "persons of an ideal character who either are particularly innocent or too easily deceived."<sup>20</sup> It is not the case of an ignorant customer who knows nothing about the genuine mark or very little about it that should be taken in considering whether the customers are likely to be deceived. The customer must be one who knows the distinguishing mark of the plaintiffs' goods and also what is fairly common to the trade.<sup>21</sup>

In *Malumiar & Co. v. Finlay Fleming & Co.*<sup>22</sup> the parties were dealing in cotton *longyis* of cheap quality. The complainants' mark consisted of a "Fez" in gold with floral decorations and inscriptions of their address in English and different vernaculars, while the appellants' mark consisted of a crown with three stars and their address in English. Action was dismissed by Carr, J., who said: "Looking at the two marks together it can be most emphatically said not only that no person seeing the two side by side would confuse the one with the other, but also that no person, who had seen one of the marks and retained the slightest recollection of what it looked like, could by any possibility mistake the other for it." The decisions in *Tatem & Co., (1915) Ltd. v. Gaumont & Co., Ltd.*,<sup>23</sup> and *Byramjee Cowasjee v. Vera Sombhai Motibhai*,<sup>24</sup> were approved and followed.

**Evidence.**—In order that the court can satisfactorily deal with the question as to the likelihood of deception by any given mark the parties should furnish all available evidence regarding the nature of the mark, the conditions under which the goods came into the hands of the purchaser and other circumstances which may

(17) (1899) 1 Bom.L.R. 291.

(18) A.I.R. 1930 Rang. 326; 128 I.C. 581.

(19) A.I.R. 1930 Cal. 678; 129 I.C. 612.

(20) Per Romer, L. J., in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, (1899) 16 T.L.R. 56; 17 R.P.C. 48.

(21) Per Romer, L. J., in *Payton & Co., Ltd. v. Snelling Lampard & Co.*, (1899) 16 T.L.R. 56; 17 R.P.C. 48; See also *Alaska Packers' Association v. Crooks & Co.*, (1901) 18 R.P.C. 129.

(22) A.I.R. 1929 Rang. 345; 7 Rang. 169.

(23) (1917) 34 R.P.C. 181.

(24) (1916) 8 L.B.R. 561; 10 Bur.L.T. 53.

be material to the case. The position is, however, different in the case of "expert evidence" which may be adduced by any party to prove whether in the opinion of these witnesses the mark is, or is not, calculated to deceive the public. Prior to the decision of the House of Lords in the case of *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*,<sup>25</sup> such evidence was constantly produced before the court. It was clearly laid down in that case that a witness was not entitled to say whether the mark in question was calculated to deceive the public and that that question was solely for the court to decide. As Lord Macnaghten observed in another case,<sup>1</sup> "The judge looking at the exhibits before him, and also paying attention to the evidence adduced must not surrender his own independent judgment to any witness whatever."

On the other hand, evidence of experts on the customs of the particular trade in which the mark is used and on other questions of fact may be given. The rule was expressed by Lord Justice Fitzgibbon in *Hennessy & Co. v. Keating*,<sup>2</sup> thus: "Though judges, whether at law or in equity, cannot delegate to so-called experts the pronouncement of the only so-called authoritative opinion upon the question at issue, parties are entitled to give, and judges are bound to consider, wherever it is material, the evidence of those who are better acquainted than they are with the circumstances under which the question arises, before deciding whether either actual deceit has been proved, or whether any particular resemblance is likely to deceive." The same rule is followed in India.<sup>3</sup>

#### Using a false property mark.—

"Section 481.—Whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong

(25) (1899) App. Ca. 83. See Chapter VI.

(1) *Payton & Co., Ltd. v. Snelling Lampard & Co., Ltd.*, (1901) A.C. 308; 17 R.P.C. 628. See also *Schweppes, Ltd. v. Gibbens*, (1905) 22 R.P.C. 113 (Warrington, J.).

(2) (1908) 25 R.P.C. at p. 138.

(3) *Nemichand v. Wallace*, (1907) 11 C.W.N. 537; 34 Cal. 495; *Noorodeen Sahib v. Charles Souden*, (1904) 15 M.L.J. 45; *Imperial Tobacco Co., Ltd. v. Atlantic Tobacco Co.*, A.I.R. 1925 Cal. 220; 40 C.L.J. 230; 84 I.C. 1014.

*to a person to whom they do not belong, is said to use a false property mark."*

This section defines the use of false property mark. The language used in this section is identical with that used in Sec. 480, and the discussions under the latter section apply here. Property marks are restricted to movable property. They may be of one kind or of different kinds. In the case of *Emperor v. Dahyabhai Chakasha*<sup>4</sup> Justice Chandavarkar said: "The term movable property was intended by the legislature to include a class or category of properties falling under one ownership not merely the parts of it which may pass from the hands of the owner into other hands. The class is stable, though the units are ambulatory."

**Punishment for using a false trade mark or property mark.—**

*"Section 482.—Whoever uses any false trade mark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both."*

This section prescribes the penalty for using false trade or property mark. Sections 6 and 7 of the Merchandise Marks Act deal with penalty for applying a false description and selling goods to which a false trade description is applied. The provisions of Sec. 482 are modified by Secs. 8 and 9 of the Merchandise Marks Act which relate to unintentional contravention of the law relating to trade marks and descriptions and to forfeiture of goods in cases of conviction. This section is also modified by Sec. 15 of the Merchandise Marks Act which prescribes the limitation of prosecution. The offence under this section is bailable, and compoundable when permission is given by the court before which the prosecution is pending. It is triable by Presidency Magistrate or Magistrate of the first or second class.

**Departure from criminal jurisprudence—Intent to defraud.**

—The expression "unless he proves that he acted without intent to defraud" occurs in Secs. 482, 487 and 488 I.P.C. and Sec. 6 of the Merchandise Marks Act. There is a departure from ordinary principles of criminal jurisprudence as regards offences under these sections. Ordinarily, the onus of proving that a fraud has been committed is left to the prosecution. The accused must be presumed to be innocent until he is proved to be guilty. For

offences under the Merchandise Marks Act, on the other hand, the law presumes fraudulent intent from a mere imitation of a trade mark, if it is "reasonably calculated to deceive." But this presumption is rebuttable. In *Pakir Mahomed v. Emperor*<sup>5</sup> the learned judge said that for an offence under this section: "It is unnecessary for the prosecution to prove that an accused in such a case had acted with intent to defraud; should the latter, however, prove that he acted without intent to defraud he is entitled to be acquitted." Dr. Gour says in this connection: "it would be observed, that contrary to the general view of crime adopted in the Penal Code these sections provide for the punishment of the accused on the mere proof of infringement of a person's trade mark coupled with the fact that such infringement is calculated to deceive and which is then sufficient to establish a *prima facie* case for conviction, on a presumption made that the infringement was intended to defraud, it being then on the accused to prove that he had acted without such intention." It may, however, be pointed out, that offences under the Merchandise Marks Act do not form the solitary instances where this general principle of criminal law is not followed; *e.g.*, persons found in possession of instruments for forging currency notes or counterfeiting coins.

**Criminal intent presumed.**—The expression "intent to defraud" does not mean "to defraud any particular person." It is immaterial that the buyer was not deceived. Proof of fraud is unnecessary if the court is otherwise satisfied of the probability of deception. In *E. D. Sassoon v. D. L. Mills Co.*,<sup>6</sup> the Court observed that it was not necessary for relief in equity that proof should be given of persons having been actually deceived and having bought goods with the defendants' mark, under the belief that they were the manufacture of the plaintiffs provided that the Court was satisfied that the resemblance was such as would be likely to cause the one mark to be mistaken for the other. The life of a trade mark depends on the promptitude with which action is taken by the owner against infringement of his rights.<sup>7</sup> The complainant need not therefore wait to see whether any purchaser is actually so deceived. The section does not mention anything about actual fraud but only about use of marks which are "reasonably calculated to deceive."<sup>8</sup>

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(5) A.I.R. 1929 Rang. 322.

(6) (1899) 1 Bom.L.R. 291.

(7) *Johnston v. Orr Ewing*, (1880) 13 C.D. 434; (1882) 7 App. Cas. 219.

(8) *Abdul Kareem Sahib v. Abdul Kareem Sahib*, 132 I.C. 650; A.I.R. 1931 Mad. 461. See also *Abdul Salam v. Hamidullah*, 166 P.W.R. 1912.

It is enough if the defendant's trade mark bears such a close resemblance to that of the plaintiff as to be calculated to mislead the ordinary purchasers. In this respect the principle of law relating to trade marks adopted in civil suits is followed. It is sufficient to show probability of deception and an action will lie even though no single case of actual deception has been proved. The earliest English case on this point is *Millington v. Fox*<sup>9</sup> where Lord Cottenham, L.C., held that an injunction could be obtained by the plaintiff restraining the defendant from using the counterfeit mark even though the infringement of the mark was due to ignorance and was without fraudulent intention. In *Seizo v. Provezende*<sup>10</sup> Lord Cranworth, L.C., said: "If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer and would purchase it in that belief the Court considers the use of such a mark to be fraudulent." The same view was taken in the *Singer Case*.<sup>11</sup> In the *Two Elephants*' case<sup>12</sup> Lord Selborne remarked: "It is true that deception in fact is not in this case proved; but there is a large body of trustworthy evidence to the effect that such deception would be liable and very likely to occur, at all events with the more ignorant classes of consumers, particularly in the up-country districts, and with this evidence my own judgment concurs." The same law prevails in this country. In the case of *Lakhan Chandra Basak v. Emperor*<sup>13</sup> it was held that if the mark complained of was likely to deceive the public it was not necessary to bring evidence of any person who was actually so deceived. Greaves, J., said in that case: "There is, it is true, no evidence of any person being actually deceived, but I do not think that this is necessary for a conviction. There is the evidence that the mark used by the accused was likely to deceive and I think from a comparison of the two marks this is clearly so." In *Moolji Sicca & Co. v. Ramjan Ali*<sup>14</sup> the court observed: "There is very little evidence of actual deception; indeed, the evidence of actual deception is so exiguous that I disregard it." The accused was, however, convicted. The matter was fully considered in *Pakir*

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(9) (1838) 3 My. & Cr. 338; 40 E.R. 956.

(10) (1866) 1 Ch. 192; 14 W.R. 357.

(11) *The Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376. See also *Bodega Co., Ltd. and Riviere v. Owens* (1889) 7 R.P.C. 31; *Jay v. Ladler*, (1889) 40 Ch.D. 649. See Chapter VI.

(12) *Johnston v. Orr Ewing*, (1882) 7, App. Cas. 219.

(13) (1924) 25 Cr.L.J. 1098.

(14) A.I.R. 1930 Cal. 678.

*Mahomed v. Emperor*.<sup>15</sup> In that case there was no evidence at all on behalf of the respondent firm to show that the purchasers or dealers had in fact been deceived by the mark of the appellants' firm. "It seems to me, however" said his Lordship, "that when once there is evidence that the mark of the respondents' firm is generally known as the topi mark, it will not be difficult also to come to the conclusion that confusion may arise owing to the appellants' mark." In *Latif Miyan v. Emperor*<sup>16</sup> the complainants had been selling hand made sugar in bags with their name stamped on them as a guarantee that the bags contained hand made and not machine made sugar. The accused who was also a dealer in sugar was found in possession of 40 bags stamped with the name of the complainant firm. Although no case of "using" the false mark was established the accused was convicted under Sec. 482, I.P.C.

In order to convict a person of an offence under this section it is not necessary to prove that the accused had the intention to deceive.<sup>17</sup> "The rule is that a person must be taken to have intended the reasonable and natural consequences of his act." In a recent Indian case<sup>18</sup> the court observed that if the use of a mark was such that a person may be deceived thereby, the presumption was that the accused intended thereby to practise deception or knew it to be likely that deception would thereby be practised. In *Pakir Mahomed v. Emperor*<sup>19</sup> the learned judge said that the state of mind of the accused was a most relevant fact which could have been established by evidence. In the absence of such evidence the accused had not discharged the onus of proving want of intention to defraud which was upon him.

**Starey v. Chilworth Gunpowder Co.**—Under certain circumstances the law does not permit a manufacturer to use his own mark on goods which are not of his manufacture if, thereby, the original signification of the mark is likely to be destroyed. The public have a right to know what goods they are buying and the action of the manufacturer would in such cases constitute a fraud on the purchasers. It is immaterial that the goods are of the same quality as the goods originally manufactured by him and sold under his mark. In *Starey v. The Chilworth Gunpowder Co.*,<sup>20</sup> the respon-

(15) A.I.B. 1929 Rang. 322.

(16) (1916) I.L.R. 39 All. 123.

(17) See Chapter VI.

(18) *Aswini Kumar Pal v. Emperor*, (1930) 34 C.W.N. 524.

(19) A.I.B. 1929, Rang. 322.

(20) (1880) 24 Q.B.D. 90.

dents had contracted to supply the Government with gunpowder. They usually sold gun powder of their own make only, but there was no stipulation in the contract that the gun powder should be of their own or of English manufacture. Owing to some accident they were unable to manufacture the article themselves. Consequently they bought gun powder from Germany and packed it in barrels supplied by Government. The barrels were marked with their own labels and their own mark; but there was no indication that the gun powder was manufactured in Germany and was not of the respondents' manufacture. It was not disputed that the gun powder supplied was as good as that they had contracted to supply. The court, however, held that in the circumstances the Company was guilty of using false trade description.

The law was explained in the above case by Chief Justice Lord Coleridge in the following passage: "In the present case all further controversy is superfluous when once one has ascertained with certainty what 'fraud' means in the Act. I agree that if the word is used in the sense of putting off a bad article on a customer in order to get money unfairly, there is no evidence here of anything of the kind having been done. On the contrary, it is expressly found that the article supplied was as good as that which was contracted for. But that, I think is not the correct meaning of the word 'fraud' as used in this Act of Parliament. The Act is directed against the abuse of trade marks, and putting off on a purchaser of, not a bad article, but an article different from that which he intended to purchase, and believes he is purchasing. It would apply to cases where a particular article manufactured by a particular person had acquired a widespread reputation (as, for instance, happened in the celebrated case of the fish sauce),<sup>21</sup> and some one supplied another, and a different article under that name, so as to make the purchaser take something which he did not know he was taking. That, I think, is the meaning of the word 'defraud' as used in the Act of Parliament, and in that sense only there was in the present case an intent to defraud." In the above case the defendants were themselves manufacturers of gun powder and the natural expectation in the circumstance was that a firm known only as manufacturers would supply only gun powder of their own manufacture. The decision might however have been different if the defendants had been merely dealers in the product.

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(21) *Burgess v. Burgess*, (1853) 3 DeG. M. & G. 896; 22 L.J.Ch. 675; 43 E.R. 35.

**Where similarities are not explained.**—Fraudulent intention will be inferred in cases where the similarities between the two marks are unexpected and when the accused refuses to give information or explanation regarding the counterfeit mark<sup>22</sup> or where the accused's explanation of the origin of his mark is not convincing to the Court.<sup>23</sup> The same may be said in cases where the description, name or get-up is deliberately copied with minor differences. Thus, in *Aswini Kumar Pal v. Emperor*<sup>24</sup> Pearson & Patterson, JJ., said that the facts of that case “would rather go to show that the accused is concerned to see how near the line he can go in trading on the reputation of another manufacturer.” The accused was convicted.

**Where Sec. 482 does not apply.**—Where the differences between the two marks are large and obvious<sup>25</sup> or where the classes of goods are different the courts will hold that there is no probability of deception. So also, in cases where the accused had been using marks which are common to the trade<sup>1</sup> no prosecution will lie even though intention to defraud is established. As the court observed in a recent Indian case<sup>2</sup> “the burden of proving the absence of such intent is indeed upon him (accused) but the question whether the burden had been discharged must be considered on a consideration of the whole evidence in that case.” So in a case<sup>3</sup> where a merchant bought in public auction goods bearing the name of another, on the latter refusing to take delivery of the consignment of the same imported by him, and thereupon sold them in the market without removing the labels, it was held that no offence was committed under Sec. 482, Indian Penal Code. The case of *Abdul Rashid v. Emperor*<sup>4</sup> affords an illustration of some

(22) *Nemi Chand v. Wallace*, (1907) 11 C.W.N. 537; 34 Cal. 495. See Chap. VI.

(23) *Moolji Sioca & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678.

(24) (1930) 34 C.W.N. 524.

(25) *Surja Prasad v. Mohabir Prasad Tribedy*, (1906) 11 C.W.N. 887; *Rasool Khan Saheb v. Emperor*, (1912) M.W.N. 85; 13 I.C. 927; *In re Kanchi Doraisamy Mudaliar*, (1910) 6 I.C. 683; 7 M.L.T. 309; *Malumiar & Co., v. Finlay Fleming & Co.*, A.I.R. 1929, Rang. 345; 7 Rang. 169; *Palli Ram v. Emperor*, A.I.R. 1931 Oudh 277; 8 O.W.N. 827.

(1) *Adamjee Hajee Dawood & Co. v. The Swedish Match Co.*, A.I.R. 1928 Rang. 210; 6 Rang. 221.

(2) *Malumiar & Co. v. Finlay Fleming & Co.*, A.I.R. 1929 Rang. 345; 7 Rang. 169, per Carr, J.

(3) *Matilal Premshuk v. Kanhai Lal Dass*, (1905) 32 Cal. 969.

(4) A.I.R. 1918 All. 109 (2); 16 A.L.J. 476.



of the peculiar circumstances under which the court may hold that there is no intent to defraud on the part of the accused. According to an agreement between the Burma Oil Co., and the Standard Oil Co., it had been provided that the oil tins of one company could be used by the other for marketing their oil provided a distinctive mark showing the manufacturers' name was affixed on the caps of the containers. The accused sold 8 tins of kerosene oil of the brand "Victoria" marketed by the Burma Oil Co., but only two of these tins had the distinctive mark "Victoria" of the Burma Oil Company on the caps. The remaining oil tins had plain caps. The accused had, however, told the purchasers that the oil tins without the distinctive lids also contained the Victoria brand of oil and the price at which he sold the oil was that prevailing in the market for this grade. It was held that although the accused was guilty of using a false trade mark, so far as the oil containers with the plain lids were concerned, the accused had acted without intent to defraud and that he had not committed an offence under this section.<sup>5</sup> So also in *Olpadvolla v. James Wright*<sup>6</sup> Ghose and Gregory, JJ., said that it was clear that there was no intention on the part of the accused to do anything harmful within the meaning of this section and that what had happened had so happened in the usual course of business. In their Lordships' opinion the accused had acted innocently within the meaning of this section and the conviction and sentence were therefore, set aside. The same view was taken in an Irish case<sup>7</sup> where the Master of Rolls (Ireland) held that the defendants had acted innocently under circumstances which were somewhat similar to those reported in *Olpadvolla v. James Wright*. In *Syon Sheeman & Co. v. Solomon*<sup>8</sup> the accused had with him porcelain goods bearing the trade mark of the complainant but not purchased from him. It was shown that certain goods came from Japan and the manufacturers either put the trade mark by mistake or sent the goods by mistake to a third person from whom the accused got them. Chari J., held on these facts that the accused had not com-

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(5) Cf. *Thwaites & Co. v. M'Evilly*, (1904) 21 R.P.C. 397, where it was held that the defendants could not be said to have acted innocently where bottles on which the trade mark of the complainant was embossed were filled with mineral water by the former and sold although they had put their own labels on the bottles.

(6) (1928) 32 C.W.N. 1115; A.I.R. 1928 Cal. 873.

(7) *Donohoe, Ltd. v. Cherry Bros., Ltd.*, (1908) 26, R.P.C. 545.

(8) (1926) 4 R. 16; A.I.R. 1926 Rang. 134.

mitted an offence under Sec. 480 or Sec. 482, I.P.C., because there was no intention to defraud on the part of the accused.

**Non-deception of vendors and middlemen immaterial.**—In considering probability of deception the court will consider the result of the spurious mark on the minds of the probable purchasers of the goods.<sup>9</sup> These may be the immediate purchasers from the manufacturers or the ultimate purchasers from the retail merchants. In *Nemi Chand v. Wallace*<sup>10</sup> Sale, J., said: ‘‘It may be conceded that the intelligent dealer in Calcutta examining these combinations together in the market just as the judge is asked to examine them in Court could not by any possibility be misled. But the evidence shows that the ultimate consumer or purchaser is not the Calcutta dealer or even the up-country dealer but the petty shopkeeper or raiyat who purchases these goods in the different bazars scattered all over the country.’’ So also in *Madhavji Dharamsey Manufacturing Co., Ltd. v. The Central India Spinning Weaving and Manufacturing Co., Ltd.*,<sup>11</sup> the Court held that there was sufficient cause for action if the defendants had put into the hands of middlemen a means whereby ultimate purchasers are likely to be deceived. Sir Basil Scott, C.J., observed: ‘‘It is said that the witnesses for plaintiffs were middlemen or commission agents and not the ultimate buyers and that the witnesses would not be deceived. To this the answer is that their testimony as to the form in which order for the plaintiffs’ cloth is usually given is good proof of the association formed in the minds of ultimate buyers between the figures and the article produced by the plaintiffs.’’ The same view was held in *Pakir Mahomed v. Emperor*.<sup>12</sup> In *Sirumal v. Emperor*<sup>13</sup> it was contended that the bottles bearing the counterfeit trade marks were not sold by the accused directly to the public, and that the firm of chemists and druggists who purchased the bottles from the accused knew very well that there was the versimilitude and yet thought fit to put the bottles up for sale. In rejecting this argument the court observed that the fraud which the accused practised

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(9) See under Sec. 480 and Chapter VI, where this question has been fully considered.

(10) (1907) 11 C.W.N. 537; 34 Cal. 495.

(11) (1916) 41 Bom. 49.

(12) A.I.R. 1929 Rang. 322.

(13) A.I.R. 1932 Sind. 94; 26 S.L.R. 241.

by selling his mixture through the firm was not on the chemist, but on the public at large who were the prospective customers. So also in *Moolji Sicca & Co. v. Ramjan Ali*<sup>14</sup> Page, J., said: "Both the plaintiffs and the defendants sell *biris* to dealers and it might be that a dealer might not be deceived by the defendant's labels. But that does not conclude the case in favour of the defendant; for, the persons whom I have to consider in this connection are the persons sometimes called the unwary or the ignorant ultimate buyers, who for the most part belong to the lower classes of the people, and nearly all of whom are illiterate."

**Mens Rea.**—It is a moot question whether intention to defraud is an essential ingredient in an offence under the Merchandise Marks Act. In *Wood v. Burgess*<sup>15</sup> the Court held that an intent to defraud was not a necessary ingredient of the offence. In this case a mineral water manufacturer had in his possession for sale mineral water contained in bottles stamped with the name and initials of another manufacturer without the latter's consent. He had, however, placed on the bottles labels bearing his own name and had sent out with them invoices bearing his own name. It was further proved that he had no intention to defraud any of the purchasers. On these facts the Magistrate held that the accused had acted innocently within the meaning of the Act, as he had no intent to defraud. On appeal it was, however, held that the intent to defraud was not a necessary ingredient of the offence charged, and that none of the above facts constituted proof that he had acted "innocently" within the meaning of the section. The decision of the Magistrate was accordingly reversed. In *Starey v. The Chilworth Gunpowder Co.*,<sup>16</sup> it was held that, although the gunpowder supplied was as good as the quality contracted for, and although no pecuniary loss or any other injury had thereby been caused to the purchaser, the accused were not entitled to say that they had acted without intent to defraud. And, in another English case,<sup>17</sup> Sir Peter Edlin said: "Fraud was not a necessary ingredient of the offence charged, and it was not suggested that the appellants were cognizant that the mark was false. The mere possession for sale, of such spurious articles was *prima*

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(14) A.I.R. 1930 Cal. 678.

(15) (1889) 24 Q.B.D. 162; 59 L.J.M.C. 11.

(16) (1889) 24 Q.B.D. 90.

(17) *Rex v. Tooth*, reported in *Times* Aug. 7, 1891.

*facie* an offence." Although there was no imputation of bad faith the accused was convicted. Similarly, in an Indian case<sup>18</sup> Mr. Justice Otter said: "The present case is a criminal prosecution and intent to defraud is not an ingredient in the offence." In support of this view it may be urged that unlike any ordinary criminal offence a master may, under the Merchandise Marks Act, be held liable criminally for an offence committed by his servant.

On the other hand, in *Gridley v. Swinborne*<sup>19</sup> the court appears to have held that it was necessary for the prosecution to prove *Mens rea* on the part of the defendant. Coleridge, C.J., said: "This was a criminal charge; a *mens rea* would have to be made out." It is obvious that an extreme view was taken in this case as it is now settled law that the onus of proving *mens rea* does not lie on the prosecution. The question was considered in *Malumiar & Co. v. Finlay Fleming & Co.*,<sup>20</sup> by Mr. Justice Carr. In his Lordship's opinion, on the wording of Sec. 482, I.P.C., an intent to defraud is an ingredient of the offence. But, when it has been proved that a trade mark is a false trade mark, then, it is to be presumed that the accused person had that intent unless and until he rebuts that presumption. If the accused succeeds in establishing his innocence he will be acquitted. "When he is entitled to an acquittal if he can prove the absence of a certain intent it seems to me obvious that that intent is an essential ingredient of that offence." This appears to be the better view. The offences charged under the Act are all criminal offences and *mens rea* or criminal intent forms, therefore, an essential ingredient of these. For the courts to interfere there must be fraud, for where there is no fraud there is no wrong to be redressed. But although *mens rea* is involved in the offence it need not be proved by the prosecution in cases under the Merchandise Marks Act, that the infringer knowingly and wilfully made a fraudulent attempt to appropriate to himself the fruits of another's reputation. *Mens rea* is an element in the offence to the extent that if the accused succeeds in proving that he acted without *mens rea* he will be acquitted, the burden of proof being shifted from the prosecution to the defence. "A provision of that kind" said Channell, J.,<sup>21</sup> "is enacted by the legislature where the legislature desires to prevent the act from

(18) *Pakir Mahomed v. Emperor*, A.I.R. 1929 Rang. 322.

(19) (1888) 5 T.L.R. 71.

(20) A.I.R. 1929 Rang 345; 7 Rang. 169.

(21) *Pearks, Gunston and Tee, Ltd. v. Ward*, (1902) 2 K.B. 1; 18 T.L.R. 538, a case under the Sale of Food and Drugs Act of 1875.

being done, though it is recognised that there may be cases in which the act is done innocently, and in which the person ought, therefore, not to be convicted. In these cases the defendant can prove his innocence; but as it would be difficult for the prosecution to prove *mens rea* if the onus were upon them to do so in the ordinary way, the enactment is consequently framed in this particular way."

**Remedy in civil and criminal courts.**—A person who is aggrieved by the infringement of his trade mark has two remedies open to him:—(1) he can institute proceedings against the infringer under the Indian Merchandise Marks Act and (2) he can take proceedings in the civil courts for injunction, delivery up and damages or account. The legislature does not lay down the circumstances under which an aggrieved person may seek either the one or the other or both of the remedies.<sup>22</sup> It has, however, been ruled by the courts in a number of decided cases that where there is a doubt whether the mark under dispute is a trade mark within the meaning of Sec. 478, I.P.C., or where there is a *bona fide* dispute between the parties as to the right to use a trade mark the adjudication must be done by the civil and not the criminal courts. Thus, in *Emperor v. Bakaulah Mallik*,<sup>23</sup> Ghosh and Stephen, JJ., observed: "We much regret that recourse has been had to the criminal law to settle the matter at issue between the parties. The result is that nothing has in fact been decided and the present proceedings have had no useful result." The appeal was allowed and the conviction under Secs. 482 and 486, I.P.C., and sentence were set aside. The above observations were approved in *Dowlat Ram v. The King Emperor*.<sup>24</sup> In that case the complainant and the accused were ghee merchants in Calcutta who imported ghee from Guntur in canisters marked with their respective trade marks. The complainant's marks consisted of the representation of the sun with some human feature inside and the name "Khatiram" in Nagri. The accused had used as his trade mark the name "Khaliram" inside the picture of the sun. Sir Francis Maclean, C.J., said: "It seems to me that when a case of this class is brought into a criminal court, if the Magistrate is of opinion that there is a *bona fide* dispute as to whether the complainant has any trade mark at all or whether the accused is or, is not entitled to use the mark he is using, I say, if the Magistrate is satisfied that there is this *bona fide* dispute, he should not

(22) *Banarsi Das v. Emperor*, A.I.R. 1928 Lah. 186; 9 Lah. 491.

(23) (1904) 31 Cal. 411.

(24) (1905) 32 Cal. 431.

deal with the matter as a criminal matter, but leave it to the complainant to maintain if he can in a civil court the right which he claims. If after the decision of the civil court it be found that he has a trade mark and that the accused is fraudulently counterfeiting that trade mark, the case could then be properly brought into a criminal court." This decision was approved in *Surja Prasad v. Mohabir Prasad Tribedy*.<sup>25</sup> Again, in *Nemi Chand v. Wallace*<sup>1</sup> Mr. Justice Sale observed: "People know or ought to know that the criminal court is not the proper forum for a purely civil dispute and therefore recourse should not be had to the criminal courts when a *bona fide* dispute as to title exists." In *Anath Nath Dey v. Emperor*<sup>2</sup> the accused was acquitted by Chitty and Richardson, JJ., who observed that the dispute between the parties was one of civil nature and could have been much more satisfactorily dealt with in a civil court. In *Mohammed Raza v. Emperor*<sup>3</sup> a manufacturer of *biris* flagrantly and dishonestly imitated the label and slip of another and the court held that in such cases the party aggrieved was not bound to seek remedy in the civil court rather than in the criminal court, but in cases of *bona fide* dispute as to the right to use a trade mark the complainant shall be directed to establish his rights first in the civil court.

The law was stated in *Mohammad Abdul Kader v. Finlay Fleming & Co.*,<sup>4</sup> by Chari, J., in the following passage: "It is for the person whose trade mark is infringed to complain of the infringement. Such a person has two remedies open to him. He can file a complaint in a criminal court, or he can get an injunction from a civil court. He may choose the former remedy as being the more expeditious. Whatever his reasons may be the choice is entirely his and it is not for the person who is alleged to have infringed on his rights to dictate to the owner or proprietor of the trade mark what remedy he shall seek. In a case of a private prosecution in which a civil or quasi civil right is involved, a Magistrate, naturally and properly is bound to stay his hand till a civil suit in which the same right is in question is adjudicated upon. The judgment of the civil court, whether binding or not, can always be tendered in evidence in the criminal case."

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(25) (1906) 11 C.W.N. 887.

(1) 11 C.W.N. 537; 34 Cal. 495.

(2) (1912) 17 C.W.N. 227; 40 Cal. 281.

(3) A.I.R. 1930 Oudh 360; 6 Luck. 183.

(4) A.I.R. 1928 Rang. 256; 6 Rang. 291.

**Declaration of right to trade mark under Section 42 of the Indian Specific Relief Act.**—Where a person is charged under the Merchandise Marks Act for infringement of a trade mark he cannot evade the trial by filing a suit in the Civil Court under Sec. 42 of the Specific Relief Act for a declaration of his right to use the mark. As Chari, J., said: “The result of entertaining a suit of this description in which an extraordinary negative declaration is sought will be to render the provisions of the Indian Penal Code nugatory and prevent the owners of trade marks from seeking relief in any but a Civil Court. When the aggrieved party files a complaint before a Magistrate his opponent, by the simple expedient of a declaratory suit and at the trifling expense of ten rupees, can drag him out of the Criminal Court. If an injured person has a choice of remedies or tribunals, courts of law never interfere in his choice, except in very special cases and for the most cogent reason. It stands to reason that they cannot lend countenance to legal subterfuges by which his opponent tries to interfere with that choice.”<sup>5</sup> This ruling was followed and the suit was dismissed in *Ganeshi Lal v. Anwar Khan Mahboob & Co.*,<sup>6</sup> where the defendants had lodged a complaint against the plaintiffs under Secs. 482 and 486, I.P.C., for infringing their trade mark and the plaintiffs had thereupon brought a suit for a declaration negating the defendants’ right in the mark under Sec. 42 of the Specific Relief Act. In his judgment in the above case, Mr. Justice Niamatullah pointed out that in certain cases the plaintiff may seek for such a negative declaration. Thus, “a person may in good faith believe that he is at liberty to use a certain trade mark and yet does not wish to run the risk of facing a criminal trial with all the inconvenience and expense involved in it. Before embarking on any extensive use of the trade mark in question, which may entail expenditure, he may have the defendant’s right examined in a Court of law with a view to ascertaining his own position.” The relief of such declaration is however entirely at the discretion of the court.

**Counterfeiting a trade mark or property mark used by another.**—

“483. *Whoever counterfeits any trade mark or any property mark used by any other person shall be punished with impri-*

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(5) *Mohammed Abdul Kader v. Finlay Fleming & Co.*, A.I.B. 1928 Rang. at p. 258; 6 Rang. 291.

(6) A.I.R. 1933 All. 495; 55 All. 702.

*sonment of either description for a term which may extend to two years, or with fine, or with both."*

*Procedure.*—The offence is noncognizable and bailable. Warrant should ordinarily issue in the first instance. It is triable by Presidency Magistrate or Magistrate of the first or second class. Under Sec. 15 of the Merchandise Marks Act no prosecution shall be commenced under this section after the expiration of three years next after the commission of the offence, or one year after the first discovery thereof by the prosecutor whichever expiration first happens.

This section should be read along with Sec. 28, I.P.C., which defines the word "counterfeit." By this section a person is said to "counterfeit" who causes one thing to resemble another thing, intending by means of that resemblance to practise deception, or knowing it to be likely that deception will thereby be practised.

*"Explanation 1.*—*It is not essential to counterfeiting that imitation should be exact.*

*Explanation 2.*—*When a person causes one thing to resemble another thing and the resemblance is such that a person might be deceived thereby, it shall be presumed until the contrary is proved, that the person so causing the one thing to resemble the other thing intended by means of that resemblance to practise deception or knew it to be likely that deception would thereby be practised."*

From the above definition it follows that a counterfeit trade mark may comprise not only a mark which is an exact copy of the original but also an imitation which is reasonably calculated to mislead the purchasers into believing that it was the genuine trade mark. It would appear that such an imitation should more appropriately be termed a false mark as defined in Sec. 480, I.P.C. The act of counterfeiting a trade mark is regarded as a more serious offence than the use of a false mark under Sec. 482, I.P.C. and is punishable with imprisonment for a longer period. The Statute does not specify, however, the circumstances under which a mark should be treated as a counterfeit trade mark and not merely as a false trade mark. Evidently a much closer resemblance is required to constitute an offence under Sec. 483, than under Sec. 482. Besides, Sec. 482 is more general and includes both marking goods falsely and using genuine marks in a false way. On the other hand, Sec. 483 is confined to the application or imitation of another's



mark. It may be mentioned here that usually the prosecution prefers to charge for offences under all the three Secs. 482, 483 and 486, I.P.C. at the same time.

**Comparison with English Act.**—Corresponding to the words “counterfeiting a trade mark” in the Indian Act the expression “forges a trade mark” is employed in the English Statute. Sec. 4 of the English Act of 1887 states:

*“A person shall be deemed to forge a trade mark who either*

*(a) without the assent of the proprietor of the trade mark makes that trade mark or a mark so nearly resembling that trade mark as to be calculated to deceive; or*

*(b) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise;*

*and any trade mark so made or falsified is in this Act referred to as a forged mark. Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.”*

It is important to observe that under Clause (b) of the above section even the assent of the proprietor would form no defence. There is no reference to assent of the proprietor in Sec. 483, I.P.C.

**Forgery of a trade mark at Common Law.**—At Common Law the imitation of a trade mark or trade description could not constitute forgery. Where a trade mark consists of the signature of a person it might be thought at first that an imitation of the mark would amount to forgery. But it is not so. This decision was given in a very early case *Rex v. Closs*<sup>7</sup> where the alleged offence consisted in the imitation of a painter's signature on the copy of a spurious picture. In another early English case<sup>8</sup> where the accused was charged with possession of forged imitation of the labels used by the complainant on Borwick's baking powder and was indicted for forgery the Court decided that the conviction for forgery was not sustainable. Pollock, J., said that the real offence consisted in enclosing the false powder in the false wrappers. In his opinion the issuing of the wrappers without the stuff within them would be no offence but that the real offence was the issuing

(7) (1858) 7 Cox 494; 169 L.R. 1082.

(8) *R. v. John Smith*, (1858) 8, Cox. 32; 169 E.E. 1122. This case was decided in 1858 before the Merchandise Marks Act of 1862 was enacted.

them with fraudulent matter in them. The grounds of the decision in this case were thus stated by Bramwell, J. "I think that this was not forgery. Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuine document, and that the one is not so efficacious for all purposes as the other. In the present case, one of these documents is as good as the other; the one asserts what the other does; the one is as true as the other; but one gets improperly used. But the question is whether the document itself is a false document. It is said that the wrapper is so like one used by somebody, else, that it may mislead; but that is not material to the question we have to decide. The prisoner may have committed a gross fraud in using the wrappers for that which was not the genuine powder, and may possibly be indicted for obtaining money by false pretences but I think he cannot be convicted of forgery."

**Fraudulent intention presumed.**—Explanation (2) under Sec. 28, Indian Penal Code, states that it shall be presumed until the contrary is proved that the person so causing the thing to resemble the other intended by means of that resemblance to practise that deception. In *Sheikh Abdul Sovan v. Jitendranath Datta*<sup>9</sup> the petitioner was charged with counterfeiting the complainant's trade marks consisting of the words "Sree Ramchandra Murti" with the figure of Ram and was further charged with having in possession an iron mould for counterfeiting the above mark. It was argued for the appellants that trade marks should be restricted to the class of goods to which they are applied and that there was no evidence that the petitioner intended the bottles to contain the hair oil or goods similar to that of the complainant and hence there was no infringement. But as the bottles contained not only the trade mark moulded in the glass of the bottles, but the actual name of the hair oil, the learned judge was of opinion that it was clear that the intention should have been to sell this hair oil in these bottles and thereby cause deception. Mr. Justice Jack said: "under the above proviso to Sec. 28, Indian Penal Code, it shall be presumed, until the contrary is proved that the person so causing the one thing to resemble the other thing intended by means of that resemblance to practise deception or knew it to be likely that deception would thereby be practised, and in the circumstances of the present case, the onus was on the accused to show that in making these bottles he had no fraudulent intention, and in the absence

of such evidence it cannot be said that he had no such intention when appearances are so much against him." His Lordship added that counterfeiting should not be regarded as an offence made up of two parts, one, the act of possessing the mould for counterfeiting and the other the act of counterfeiting.

But where it is clearly established that there was no intention to do anything wrongful a conviction under Sec. 483, Indian Penal Code is not sustainable.<sup>10</sup> So, in a prosecution for counterfeiting a trade mark where it appeared that the labels used were not calculated to deceive a literate person or even an illiterate person who had seen the two, it was held that in spite of slight resemblances the accused was not liable to be convicted under Secs. 483 or 486, Indian Penal Code.<sup>11</sup>

**Conviction cannot be set aside on the ground of no local jurisdiction.**—In *Palli Ram v. Emperor*<sup>12</sup> the conviction of the accused under Sec. 483, Indian Penal Code, by the City Magistrate was set aside by the court of the Sessions Judge, Lucknow, on the ground that the Magistrate had no local jurisdiction. But, on appeal it was held by Kisch, J., that under Sec. 531 of the Criminal Procedure Code no finding of the Criminal court could be set aside solely on this ground, unless it appeared that a failure in justice had in fact been occasioned. The order of the Sessions Judge was accordingly set aside.

#### **Counterfeiting a mark used by a public servant.—**

*Section 484: "Whoever counterfeits any property mark used by a public servant, or any mark used by a public servant to denote that any property has been manufactured by a particular person or at a particular time or place or that the property is of a particular quality or has passed through a particular office or that it is entitled to any exemption, or uses as genuine any such mark knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to three years, and shall also be liable to fine."*

The offence is triable by the Presidency Magistrate or a Magistrate of the first class or by the Sessions Court. It is non-

(10) *Olpadvolla v. James Wright*, (1928) 32 C.W.N. 1115.

(11) *Palli Ram v. Emperor*, A.I.R. 1931 Oudh 277; 8 O.W.N. 827; 32 Cr.L.J. 1117.

(12) A.I.R. 1931 Oudh 277; 8 O.W.N. 827.

cognizable and summons should ordinarily issue in the first instance. It is bailable but not compoundable.

The points requiring proof for an offence under this section are :—

- (1) that the mark in question was a property mark or any other mark,
- (2) that such mark was used by a public servant,
- (3) that the mark was used to indicate any of the following :—
  - (a) the property was manufactured by a particular person,
  - (b) it was manufactured at a particular place or time,
  - (c) it was of a particular quality,
  - (d) it had passed through a particular office,
  - (e) it was entitled to some exemption,
- (4) that the accused had either (a) counterfeited such mark or (b) used as genuine any such mark. In the latter case it is necessary to prove that the accused knew at the time of using the mark that it was not genuine and was counterfeit.

As an example of a property mark used by a public servant we may refer to the well-known arrow mark used on all goods belonging to Government.

When goods are purchased by Government it is generally the practice to have them tested in order to determine whether they satisfy the required specification. For instance, engineering materials, chemicals and other goods which are bought in large quantities by the Indian Stores Department are not generally accepted unless they are tested and found to be of the required standard in the Government Test House at Calcutta. In the case of customs authorities the goods are sent for examination to their own laboratories which exist in Calcutta, Madras, Bombay, Karachi and Rangoon.

Chapter V of the Sea Customs Act, 1878 (Act VIII of 1878) deals with the levy of, and exemption from, customs dues. Sec. 20 lays down that customs duties shall be levied at such rates as may be prescribed by or under any law for the time being in force on "goods imported or exported by sea into or from any customs port from or to any foreign port." By Sec. 22 of the Act the Governor-General-in-Council may fix for the purpose of levying duties tariff values of any goods exported or imported by sea on

which customs duties are by law imposed and alter any such values fixed by any Tariff Act for the time being in force. He has also the general power to exempt from the whole or any part of the customs duties by notification in the Gazette any goods imported into or exported from British India. The Local Governments can also authorise in special cases exemption from the whole or any part of the customs duties leviable on such goods. Previous sanction of the Governor-General-in-Council should however be obtained in every such case (Sec. 23). The Act also provides exemption of customs duties on certain class of goods under certain conditions. In the case of re-imported goods produced in British India, the goods may be admitted without payment of duty, provided that such importation takes place within three years after the exportation of such goods and it is proved to the satisfaction of the Customs Collector that the property in such goods has continued in the person by whom or on whose account they were exported (Sec. 25). Military equipment and other articles imported direct by any unit of His Majesty's regular forces serving in India for the use of such unit are exempted from payment of customs duties. Goods which are transmitted in bond through British India to the territories of His Highness The Maharaja of Kashmir and Jammu or through those territories to Russian and Chinese Turkestan are also under certain circumstances exempt from import duty. Refund of the difference between the specific and *ad valorem* duty is admissible on arms purchased by British subjects residing in Native States from an importer also residing in a Native State.

The expression "knowing the same to be a counterfeit" may be noted. This is in contrast with what has been discussed before where the onus of proving want of fraudulent intent has been thrown on the accused. The section may be compared with Sec. 489, Indian Penal Code, which also says that it is incumbent on the prosecution to show that the accused tampered with the property mark "intending or knowing it to be likely that he may thereby cause injury to any person."

**Making or possession of any instrument for counterfeiting a trade mark or property mark.—**

*Section 485: "Whoever makes or has in his possession any die, plate or other instrument for the purpose of counterfeiting a trade mark or property mark or has in his possession a trade mark or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or mer-*

*do not belong shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both."*

The offence is bailable but not compoundable. It is non-cognisable and triable in the Session Court or by the Presidency Magistrate or Magistrate of the First class.

In order to establish that an offence had been committed under this section the prosecution has to establish the following points:—

(a) (1) that the person made any die, plate or other instrument, and

(2) that these instruments were made for the purpose of counterfeiting a trade or property mark;

or

(b) (1) that the person had in his possession the die, plate or other instrument, and

(2) that these instruments were in his possession for the purpose of counterfeiting a trade or property mark;

or

(c) (1) that the person had in his possession a trade mark or property mark, and

(2) that such trade or property mark was for the purpose of denoting that any goods were the manufacture or merchandise of a person whose merchandise or manufacture they were not or that they belonged to a person to whom they did not belong.

The possession of a counterfeiting instrument by itself is not sufficient to constitute an offence under this section. Such instrument may have been for instance kept in a museum or may be in the possession of a curios collector. The instrument must have been in possession for the purpose of counterfeiting a trade or property mark. How this could be proved would depend upon the circumstances of the case. It is not necessary that the counterfeit marks should have been actually applied to goods. Even mere possession of counterfeit labels or marks for the "purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not" would constitute an offence.

The wording of the section makes it clear that a manufacturer shall not use even his own mark on goods in such a way that the purchasers are deceived into believing that the goods belong to him when as a matter of fact they do not, as, for instance, in *Starey v. Chilworth Gunpowder Co.*<sup>13</sup> Such use would, no doubt, come under the definition of the use of a false trade mark in Sec. 480 and be punishable under Sec. 482 but not under Sec. 483.

An offence under Sec. 485 is punishable with imprisonment upto 3 years but offences under Secs. 483 and 486 are punishable with imprisonment only upto two years and one year respectively. One can understand that the making or possession of counterfeiting instruments is a graver offence than counterfeiting itself, but it is difficult to see how the mere possession of counterfeit trade marks or property marks (Sec. 486) can constitute a more serious offence than the actual counterfeiting (Sec. 483) or selling or possessing for sale goods with counterfeit trade or property marks (Sec. 486).

Fraudulent intent will be presumed until and unless it is rebutted. A defence is provided in Sec. 8 of the Merchandise Marks Act which states that where a person is accused under Sec. 485, Indian Penal Code, of making any die, plate or other instrument for the purpose of counterfeiting a trade mark or property mark, he shall be acquitted if he proves that in the ordinary course of his business he is employed in making such dies or instruments for making trade marks, that he took reasonable precautions against committing the offence charged and that on demand by the prosecutor he gave all the information in his power relating to the persons on whose behalf the mark was applied.

**Abdul Sovan v. Ramani Mohan Chatterjee.**—Where a trade mark consists of several features it is not necessary that the complete apparatus required for counterfeiting all the parts of the mark in question should have been found with the accused in order to secure a conviction under this section. In *Abdul Sovan v. Ramani Mohan Chatterjee*<sup>14</sup> the trade mark consisted of an impression moulded in the glass bottles together with a label. The petitioner was found in possession of the mould in question with the

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(13) (1890) 24 Q.B. 90.

(14) 1930 Cr.C. 1104; A.I.R. 1930 Cal. 664.

intention of counterfeiting the trade mark. But no apparatus for counterfeiting the label was found with him. It was contended that the trade mark was a combination of two marks and that the possession of moulds for counterfeiting a part of the mark did not amount to an offence under Sec. 485, Indian Penal Code, but this argument was rejected by the Court. Mr. Justice Jack said: "Under Sec. 485, Indian Penal Code, whoever has in his possession any die for the purpose of counterfeiting the trade mark is liable under the section. There can be no doubt in this case that the mould in question was intended for the purpose of counterfeiting this trade mark although the apparatus for counterfeiting the label which would complete the trade mark has not been found, and inasmuch as this mould was certainly meant to be used in order to counterfeit this trade mark the petitioner has rightly been held liable under Sec. 485, Indian Penal Code."

**No offence where complainant's ownership is not established.**

—The section presupposes the existence of the complainant's exclusive right in the trade mark in question. Where such a right in the mark is not established there will be no conviction. The question arose in *Anookool Chunder Nundy v. Queen Empress*<sup>15</sup> where the accused was convicted by the Presidency Magistrate under Secs. 485 and 486, Indian Penal Code of having in his possession (1) instruments for the purpose of counterfeiting the trade or property mark of the Mercantile Bank of India and (2) for sale or trade a gold bar bearing the counterfeit impression of the trade or property mark of the Mercantile Bank. The conviction was, however, set aside on appeal, as the court held that the prosecution had not proved that the mark in question was the trade mark of the complainants, and that the mere fact that the latter imported and sold gold bars with the mark impressed on them was not sufficient to establish their exclusive title to the mark.

**Selling goods marked with a counterfeit trade mark or property mark.—**

*Section 486: "Whoever sells, or exposes or has in his possession for sale or any purpose of trade or manufacture, any goods or things with a counterfeit trade mark or property mark affixed to or impressed upon the same or to or upon any case, package or other receptacle in which such goods are contained, shall, unless he proves—*



- (a) *that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and*
- (b) *that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or*
- (c) *that, otherwise he had acted innocently,*

*be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both."*

The offence is non-cognisable. It is bailable and compoundable when permission is given by the court before which the prosecution is pending. It is triable by Presidency Magistrate, or Magistrate of the first or second class.

The section is restricted in its application to selling goods marked with a 'counterfeit' trade mark or property mark. While the use of a 'false' trade mark or property mark is punishable under Sec. 482, Indian Penal Code, the act of selling goods bearing 'false marks' is not specifically referred to as an offence in any of these sections. A reading of Secs. 482 and 483, Indian Penal Code, suggests that the two expressions 'false mark' and 'counterfeit mark' are not meant to be synonymous within the meaning of the Act as already pointed out. Some difference in the meaning between these terms was evidently contemplated by the Legislature in framing the Act. But whatever it was it has not been pointed out in the statute itself.

**Counterfeit and false trade marks distinguished.**—It would appear that a closer similarity might be expected in the case of a counterfeit mark than for a false mark, although a difference between the two is only a question of degree. There is, however, at present no rule by which one can say whether the mark is a counterfeit mark or whether it amounts to only a false mark without being a counterfeit one. The question is thus left entirely to the discretion of the courts and has perhaps resulted in a certain amount of confusion. The position is unfortunate, because a mark might be held by one court as a counterfeit one while the same mark with equal justification might be held by another court to be only a false mark and not a counterfeit one. The distinction between the two offences is

important as one of them is regarded as of graver nature than the other and may entail a higher punishment.

The decided cases are not very clear on this point and deal generally with questions of fact only. In *Holland Bombay Trading Co. v. Buktcar Mull and Bal Kissen*<sup>16</sup> the complainants had been selling white shirtings marked "H.B.T.C. 40,000," with a label containing the picture of a lion and a snake and an oval design with the words "Sole importers to the *Holland Bombay Trading Co., Ltd.*" The shirtings of the accused had the mark "H.P.F.C. 40,000" and a label with two lions and two snakes and an oval stamp with the words "Sole, importers, Holland Export Company." The letters in the two labels were printed in similar types, size and colour. It was held that the accused were guilty under Secs. 482, I.P.C., and 486, I.P.C. Again in *Emperor v. Ganapat Sitaram Mukadam*<sup>17</sup> where the accused was convicted under Sec. 486, I.P.C., the two labels were almost identical. And, in *Faqir Chand v. Emperor*<sup>18</sup> the complainant firm had been selling "Horse Brand Shining Black Hair Dye", the prominent feature of this label being a horse, and the accused commenced selling "Arabie Horse Shining Black Hair Dye". The design of the latter was also a horse but with a rider on the horse and the colours were different. The conviction under Sec. 486, I.P.C., was upheld.

In *Palli Ram v. Emperor*,<sup>19</sup> Kisch, J., held that where in a prosecution for counterfeiting trade mark it appeared that the labels used were not so similar as to deceive a literate person or even an illiterate person who had an opportunity of comparing the two, the accused was not liable to be convicted under Secs. 483 and 486, I.P.C., in spite of the slight resemblances. So also, in a Sind case<sup>20</sup> the court held that where the marks used by the accused were likely to deceive an ignorant and unwary purchaser but still did not resemble each other sufficiently closely to deceive a person of ordinary observation comparing the two marks side by side, there was no offence under Secs. 483 or 486, I.P.C., although the act constituted an offence under Sec. 482, I.P.C., for using a false mark. In *Emperor v. Bakaullah Mallik*<sup>21</sup> the prosecutors

(16) (1903) 8 C.W.N. 421; 1 Cr.L.J. 300.

(17) (1914) 16 Bom.L.R. 78; 24 I.C. 834.

(18) A.I.R. 1934 Lah. 687; 16 Lah. 114.

(19) A.I.R. 1931 Oudh 277; 32 Cr.L.J. 1177; 8 O.W.N. 827.

(20) *Lokumal v. Emperor*, (1914) 8 S.L.R. 199; 16 Cr.L.J. 230; 27 I.C. 902.

(21) (1904) 31 Cal. 411; 8 C.W.N. 307.

were selling fish-hooks in packets labelled with the design of two fish crossed with their heads, and tails pointing upwards, and their fish hooks were known as "Mash Marka." The defendant's fish-hooks were marked "Mash Mark" and had a design of one fish with head and tail turned upwards. It was held that the essential feature of the design was too common and too apt for application to fish-hooks and that the defendant had not committed an offence under Secs. 482 and 486, I.P.C. In *Surja Prasad v. Mohabir Prasad Tribedy*<sup>22</sup> the court held that the selling of rose water in bottles with labels, which although similar to the complainant's showed differences on closer examination, did not constitute an offence under Sec. 486, I.P.C.

In *Aswini Kumar Pal v. Emperor*<sup>23</sup> Pearson and Patterson, JJ., said that for an offence under Sec. 486, I.P.C., the proper test was whether an ordinary unwary purchaser would be deceived. The charge against the accused was that he had in his possession for sale certain tins of corn flour bearing a trade mark or property mark which was the counterfeit of the mark of Messrs. C. & E. Morton, Ltd., and the conviction under Sec. 486, I.P.C., was upheld. Their Lordships observed that no one could possibly mistake the labels of the complainants' and the accused's if he were in the least alert and knew the original at all well. "It is equally clear that the purchaser (if literate) would not be deceived if he had the two tins side by side. But that is not the proper test; it must be considered from the point of view of the ordinary unwary purchaser." It would appear from the above passage that the test proposed by their Lordships in the case of a 'counterfeit' mark can equally well apply in the case of a 'false' mark and that the Judges did not contemplate any distinction between the expressions 'false mark' and 'counterfeit mark.'

**Complainant's title to the mark must be established.**—The title of the complainant to the trade mark must be established in every case, before the accused can be convicted of an offence under this section. The cases of *Palli Ram v. Emperor*,<sup>24</sup> *Anookool*

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(22) (1907) 11 C.W.N. 887.

(23) (1930) 34 C.W.N. 524; A.I.R. 1930 Cal. 728. See also *Emperor v. Ganapat Sitaram Mukadam*, (1914) 16 Bom.L.R. 78; *Emperor v. Tapidas Durlabhdas*, (1907) 9 Bom.L.R. 732; *Faqir Chand v. Emperor*, A.I.R. 1934 Lah. 687; 16 Lah. 114; *Nallaya Pillai v. Rangasami Pillai*, (1895) 1 Weir 556; *Hargobind v. Ralli Bros.*, (1902) 35 P.R. 1902.

(24) A.I.R. 1931 Oudh 277.

*Chunder Nundy v. Queen Empress*,<sup>25</sup> *Surji Prasad v. Mohabir Prosad Tribedy*,<sup>1</sup> and *Gobinda Chandra Roy v. Abdul Rashid*<sup>2</sup> may be cited in this connection. In *Anath Nath Dey v. Emperor*<sup>3</sup> a manufacturer of umbrellas complained that a rival trader had been passing off his umbrellas as the complainant's by affixing a mark closely resembling his own and containing the name "Butto Kristo Pal." Action under Sec. 486, I.P.C., could not, however, be maintained as the complainant failed to establish his exclusive title to the mark in question.

**Possession of goods for sale.**—It is not necessary to establish that the sale of the goods with the counterfeit mark had actually taken place. It is sufficient if a person has in possession the goods for sale or for any purpose of trade or manufacture. In *Yusuf Mahomed v. Bansidhar Siraogi*<sup>4</sup> the accused was charged at Calcutta with possession of tins of ghee bearing counterfeit trade marks of the complainant with a view to sell them in Rangoon. Although none of the goods complained of had actually been sold in the former place it was held that an offence had been committed under this section. In the same case the question of jurisdiction was also raised and the court observed that the Magistrate at Howrah could try the case although the goods were not for sale or for any purpose of trade in Howrah or any place within its jurisdiction.

**Commission agents and intermediaries not liable.**—The section has no application to persons who may be in possession of the goods for purposes other than for sale, trade or manufacture. It is also inapplicable in the case of commission agents and other persons who act as intermediaries between the manufacturers and the importers. Although these people are concerned with the furtherance of trade they do not directly sell or expose or keep in possession such goods for sale, trade or manufacture. The fact that goods had been received by them for delivery to the actual purchasers would not constitute an offence under this section. Where certain goods ordered by the accused, who acted as commission agents or intermediaries were seized on the way at the instance of the complainants, and never passed into the possession of the

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(25) (1900) 27 Cal. 776.

(1) (1907) 11 C.W.N. 887.

(2) A.I.R. 1928 Cal. 235.

(3) 17 C.W.N. 227.

(4) (1898) 25 Cal. 639; 2 C.W.N. 450.

accused, it was held that the accused could not be convicted under Sec. 486, I.P.C.<sup>5</sup>

**Piracy of books actionable under Section 486, I.P.C.—**

A bookseller offering for sale the pirated edition of any book may be liable for conviction under this section. In *Kanai Das Bairagi v. Radha Shyam Basak*<sup>6</sup> the applicants were found to have sold a large number of counterfeit copies of a well-known Bengali primer by Ram Sunder Basak with a perfect knowledge that the book which they were selling was not the real book but a book purporting to be the real one. They were convicted of offence under Sec. 486, I.P.C., and sentenced to 3 months' rigorous imprisonment.

**Textile designs not covered by Section 486, I.P.C.—**In *Narumal Khemchand v. The Bombay Co., Ltd.*,<sup>7</sup> it was held that a design on the textile goods did not constitute a trade mark or trade description within the meaning of the Indian Merchandise Marks Act. The complainant firm alleged that they had been importing and selling chintz printed with a particular design or pattern and that the accused firm had recently imported for sale chintz printed with similar designs. It was not denied that the accused firm would ordinarily have the right to copy the design in default of protection under the Patents and Designs Act. But it was claimed that the design amounted to a trade mark, and that if it did not amount to a trade mark, at all events it amounted to a trade description. It was contended that copying the design amounted to an offence either under Sec. 486, I.P.C., or under Sec. 7 of the Merchandise Marks Act. The Court observed: "The design or pattern covers the whole body of the goods and appears to us to be part and parcel of the goods, and to fall within the definition of the 'design' given in Sec. 2 (5), Patents and Designs Act, 1911. It does not appear to us to satisfy the ordinary conception of a trade mark. It is not a mark apart and different from the goods, applied to them for denoting the goods to be the manufacture or merchandise of a particular person within the meaning of Sec. 478, I.P.C.<sup>8</sup> The copying of the design or pattern could not, therefore, be treated

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(5) *Hargobind v. Greaves Cotton & Co.*, (1902) P.R. No. 32.

(6) (1898) 26. Cal. 232. See, however *Radha Krishna Joshi v. Kissonlal Shridhar*, (1901) 26 Bom. 289; see also *In re Kanchi Doraisamy Mudaliar*, (1909) 6 Ind. Cas. 683; 11 Cr.L.J. 393.

(7) (1914) 8 S.L.R. 39.

(8) The same view was expressed in *Hafizullah Hamidulla v. Papa*, A.I.R. 1933 Nag. 344; 30 N.L.R. 45.

as a counterfeiting of a trade mark within the meaning of Sec. 486, I.P.C. Nor do we think that the design or pattern can properly be brought within the definition of 'trade description' contained in Sec. 2 (2), Merchandise Marks Act. . . . The design or pattern makes the chintz attractive for sale and is part and parcel of the goods themselves. Whereas what appears to us to be contemplated by the section is the application of some independent marks calculated to lead persons to believe the goods to be the merchandise of some other person. The design or pattern could not, therefore, be treated as a false trade description under Sec. 7, Merchandise Marks Act."

**Defences.**—Where a person is charged with the commission of an offence under this section there are two alternative defences open to the accused; the first being that indicated by Clauses (a) and (b) of the section read together and the other being that indicated by Cl. (c). The accused can show that, having taken all reasonable precautions, he had no reason to suspect the genuineness of the mark complained of, and that in addition he gave all the information in his power with respect to the person from whom he obtained the goods. This presupposes that the person charged believed that the mark was a genuine mark. But there is another alternative. The accused may be unaware that the trade mark in question is the property of any particular person or firm. If in these circumstances, he deals in the goods bearing the mark he will come under the other alternative as a person who has acted innocently.<sup>9</sup>

The onus of proving that the accused acted innocently is thrown on the defence. It is interesting to note that whereas in Secs. 482, 487 and 488, I.P.C., the expression "without intent to defraud" is used, the expression used in the present section is "otherwise he had acted innocently." The distinction between the two expressions arises in the following way. For the commission of an offence under Secs. 482, 487 and 488, I.P.C., the accused is an active participator. The person must either use a false trade mark, or make a false mark on receptacles containing goods or make use of any such false mark. But under Sec. 486, I.P.C., a person who may become passively the possessor for sale of any goods bearing a counterfeit mark can be charged. In this case the defendant has to prove to the court that he acted 'innocently' and

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(9) *Queen Empress v. Ilahi Baksh*, (1897) A.W.N. 99.

explain how he came into possession of the said goods bearing the counterfeit mark. The defendant can establish his *bona fides* by showing to the court that he took all reasonable precautions against commission of the offence, that he could not suspect the genuineness of the mark when he obtained possession of the article and that on demand made by the prosecutor he gave all information in his power with respect to the incriminating article in his possession for sale. The same principles, of course, apply as in the plea that the defendant acted without intent to defraud which has been amply dealt with in an earlier section.

**Illustrative cases.**—A few cases which illustrate some of the circumstances under which the courts have held that the accused had acted innocently may be cited. In *Matilal Premasuk v. Kanhai Lal Dass*<sup>10</sup> the prosecutor had ordered for woollen shawls from Germany but refused to take delivery of the consignment of the same, which were, thereupon, put to auction and bought by the accused. The latter commenced selling the goods without removing from them the original trade mark of the complainants. The conviction under Secs. 482 and 486, I.P.C., by the Magistrate was set aside on appeal. In *Olpadvolla v. James Wright*<sup>11</sup> the complainant had introduced into the market soda water supplied in bottles with frosted appearance bearing the letters *R. and T., Ltd.*, with a special label and a capsule. Some of those bottles were wrongfully filled with mineral water by Messrs. Byron & Co., of which Olpadvolla was the proprietor. It was shown that in Calcutta there was a common practice for various kinds of bottles to be used by different mineral water manufacturing firms indiscriminately and also that the accused had given orders in his factory that bottles of other firms should not be accepted. But, as his men could not read English it was difficult to get the order carried out. The learned judges held that it was clear that there was no intention on the part of the accused to do anything harmful within the meaning of Sec. 486, I.P.C., and that what was complained of had happened in the usual course of business in this trade in Calcutta. Ghose and Gregory, JJ., said: "It is not clear why the accused should be deprived of the benefits of the findings of fact arrived at by the learned Chief Magistrate when considering the words specified in Sec. 486, I.P.C. In our opinion the accused had acted innocently within the meaning of Sec. 486, and that

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(10) (1905) 32 Cal. 969.

(11) A.I.R. 1928 Cal. 873; 32 C.W.N. 1115.

being so the conviction and sentence under Sec. 486, I.P.C., must be set aside." In *Syon Sheeman & Co. v. R. Solomon*<sup>12</sup> the accused was charged with possessing porcelain goods imported from Japan, which were marked wrongly with the complainants' trade mark. The accused proved his *bona fides* and offered to make over the goods to the complainants on receipt of their cost price, but the offer was rejected. The complainants demanded that the goods should either be returned to Japan or destroyed. It was held that the mark was not a counterfeit mark as defined by Sec. 28, I.P.C., which involved an intention to practise deception, and that the accused had not committed an offence under Sec. 486, I.P.C.

**Issue of search warrant for the purpose of inquiry illegal.—**

A search warrant for the search of the premises of the accused and for the production of all goods, bills and books cannot be issued at the instance of the complainant for the purpose of an inquiry as to whether the accused had sold articles with a counterfeit trade mark. "The power of issuing a search warrant" said Fox, C.J., "is not intended to be used for the purpose of giving complainants an opportunity of fishing for evidence. The warrant is intended for use in respect of definite documents believed to exist which must be clearly specified in the warrant, and before issuing it the Magistrate must have before him some information or evidence that the documents are necessary or desirable for the purposes of the inquiry before him. To issue a search warrant for the search of a man's house and for the production of all papers and books in it for the purpose of an inquiry as to whether he had used or sold articles with a counterfeit trade mark, is a gross perversion of the law."<sup>13</sup>

**Corresponding section of English Merchandise Marks Act.—**

The special defence Clauses (a), (b) and (c) of this section have been adopted from Sec. 2 (2) of the corresponding English Statute of 1887. The importance of Cl. (b) was emphasized by Mr. Hindmarch, Q.C., before the Merchandise Marks Committee of 1862 and was specially introduced at his instance. The Act of 1862 went still further. By Sec. 6 of this Act a person who was found with articles bearing a forged or false trade mark could be compelled on demand in writing by or on behalf of the holder of

(12) A.I.R. 1926 Rang. 134; 4 Rang. 16.

(13) *Moideen Bros. v. Eng Thawng & Co.*, (1916) 36 I.C. 591; 10 Bur.L.T. 216. See also *Rajasingh v. Tikamdass*, (1935) 29 S.L.R. 179; A.I.R. 1935 Sind 107 (2).



the original mark to disclose all the information regarding the names and addresses of the persons from whom he obtained the spurious article. The court might order such information to be given and on refusal could fine the person £5. Such refusal to comply with the order was also admitted by the Court as *prima facie* evidence of guilty knowledge at the time when the article was sold.

The present English Act does not contain, however, the above provisions. According to Sec. 2 (2) proof that a person who has been charged gave all information in his power relating to the persons from whom he obtained the spurious goods forms part of his defence as provided by Cls. (a) and (b). But refusal to supply such information is not regarded as an admission of guilt. Nor does such refusal entail any other penalty except that when ordering costs the court under Sec. 14, may take into consideration the information given by and the conduct of the defendant. But as there is an alternative defence provided under this section, it is quite conceivable that a person charged may refuse to supply information as required under Cl. (b) and by still taking shelter under Cl. (c) he may be acquitted. It may be noted that while Cls. (a) and (b) should be read together being connected by the conjunction 'and', Cl. (c) is preceded by the word 'or' and begins with the word 'otherwise.'

**English cases.**—In the case of *Christie, Manson and Woods v. Cooper*<sup>14</sup> the defendants were charged with selling China dishes bearing the forged trade mark "Royal Dresden" belonging to the Royal Porcelain Factory of Saxony. It was shown that the appellants had catalogued to sell those goods as "Dresden China" but on receiving information before the auction which led to suspect the genuineness of the mark they sold the China "for what it is" at the same time scoring out the word "Dresden" as the lot was marked in the catalogue. The conviction by the Magistrate was set aside on the ground specified in defence Cl. (c). Mr. Justice Channel said: "It seems to me quite clear that there may be innocence of any intention to infringe the Act, even although there may be suspicion of the genuineness of the article or trade mark. This is what the word "otherwise" means, I think."

The meaning of Cl. (c) was more fully explained in the case *Coppen v. Moore*<sup>15</sup> which is of great importance and authority

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(14) (1900) 2 Q.B. 522.

(15) (No. 2) (1898) 2 Q.B. 306.

and has been followed in later decisions. In this case Lord Russell, C. J., said: "It seems clear that Cls. (a) and (b) of sub-Sec. 2 apply to cases where goods in question are in the possession of accused for sale, or are sold with the forged trade mark, or false trade description already stamped upon them or otherwise applied to them, and not to a case like the present, where the false trade description is applied upon the occasion and as part of the terms of sale; and in the latter case the accused must rely for his exculpation upon Cl. (c), namely, by showing that he had acted innocently."

A person cannot knowingly apply a false description although he had no intention to deceive the public, but was actuated by merely a desire to save some extra expense. In *Kirshenboim v. Salmon and Gluckstein*<sup>16</sup> the respondents were charged with using some old labels with the description "guaranteed hand made" to machine made cigarettes of equally good quality as hand made ones. It was held by the Court that in utilising an old stock of labels the respondents had not acted innocently. So also, in *Thwaites & Co. v. McEvilly*<sup>17</sup> where the manufacturers of mineral water had refilled bottles belonging to a different manufacturer and embossed with the latter's trade name and sold them it was held that the defendant could not be said to have acted innocently although labels showing his name were also affixed to the bottles. In that case it was not proved or alleged that fraud was intended or that any person had actually been misled. But the plaintiffs had served notice on the defendants cautioning them against using bottles embossed with the plaintiffs' name, notwithstanding which the defendants had persisted in using them and claimed a right to do so. Porter, M. R., (Ireland) said: "Where a man knows that another is the owner of a trade mark, and he intentionally uses it, by applying it to his own goods, from motives of personal convenience or profit, he cannot under the Statute claim immunity on the ground of innocence." On appeal, the decision of the Master of Rolls was affirmed with costs on the authority of *Allen v. Richards*.<sup>18</sup> The Court of Appeal held that the defendants by putting mineral water of their own manufacture into bottles bearing the plaintiffs' trade marks, committed an offence against the Merchandise Marks Act, that the word "innocently" in section

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(16) (1898) 2 Q.B.D. 19.

(17) (1904) 20 R.P.C. 663 and 21 R.P.C. 397; (1901) 1 Ir.R. 310.

(18) (1882) 28 S.J. 658.

2, sub-Sec. 2 (c) of that Act meant innocence of intention to infringe the Act, and that placing labels bearing their own names on the bottles by the defendants was not sufficient.

The explanation of the word “innocently” in this sub-section came again for discussion in *Donohoe, Ltd. v. Cherry Bros., Ltd.*<sup>19</sup> Both the plaintiffs and defendants were manufacturers of mineral waters and were selling to retailers in bottles embossed with their respective trade descriptions. The retailers were in the habit of returning the empty bottles indiscriminately and by mutual agreement among the two manufacturers the bottles were afterwards sorted and returned to the respective firms. The plaintiffs complained that a certain number of their bottles which had thus come into the defendants’ possession, instead of being returned, had been filled with mineral water of the defendants’ manufacture and sold to customers. The bottles, however, had on them the defendants’ labels. Intentional fraud was not alleged but it was contended that the acts complained of were the result of culpable carelessness and neglect of reasonable precaution. It was held that the defendants had taken reasonable precautions, that the acts complained of were accidental, and that the defendants came within the exemption provided by the Act as having “acted innocently.” The facts in *Thwaites v. M’Evilly* were distinguished from this case and injunction was refused with costs.

In *Allard v. Selfridge & Co.*,<sup>20</sup> the Magistrate found that the respondents had sold stockings as of silk which were, in fact, of artificial silk. He held that all reasonable precautions had not been taken, but that the buyer employed by the respondents had acted in good faith, and that in the absence of any intent to cheat or defraud, the respondents had “otherwise acted innocently” and were entitled to an acquittal. The Court, however, observed that Sec. 2 (2) of the English Merchandise Marks Act provides two alternative kinds of defence, one contained in Cls. (a) and (b) together, and the other in Cl. (c), that it was necessary to prove that all reasonable precautions were taken to suspect the genuineness of the trade description, and that the seller was not entitled to say that although he did not take all reasonable precautions, he had no reason to suspect the genuineness of the trade description, and therefore, “otherwise” acted innocently. Such an interpretation, in the opinion of the Court, would in effect omit the word “otherwise.”

(19) (1908) 26 R.P.C. 545.

(20) (1925) 1 K.B. 129.

**Making a false mark upon any receptacle containing goods.—**

“487. Whoever makes any false mark upon any case, package or other receptacle containing goods, in a manner reasonably calculated to cause any public servant or any other person to believe that such receptacle contains goods which it does not contain or that it does not contain goods which it does contain or that the goods contained in such receptacle are of a nature or quality different from the real nature or quality thereof shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to three years or with fine, or with both.”

The offence is non-cognisable. It is bailable but not compoundable and is triable by Court of Session, Presidency Magistrate, or Magistrate of the first or second class.

The definition of ‘false mark’ for the purposes of this section is contained in the section itself. It is a mark upon any case, package or other receptacle which is calculated to mislead a public servant or other person about the contents of the case, etc. It will be noted that the false marking on the actual goods does not come under this section. It may also be remarked that the expression used in this section is ‘false mark’ and not ‘false trade mark’ or ‘false property mark’ as mentioned in the earlier sections.

The primary object of this section is to prevent cases where false marks are put on a case or package with a view to evade payment of customs duty. For instance, imported articles may arrive in packages which are marked in such a way as to indicate falsely to the customs authorities that the goods inside belong to a class for which the scheduled duty is lower than for the class of goods which are actually within the case.

The operation of this section, however, may not be confined to cases of evasion of customs duty. A consignor of goods by railway may become liable if he marked ‘perishable’ on a case which actually contained non-perishable goods with a view to evade payment of a higher freight.

It will be seen that the deception of any person other than a public servant is also actionable. So a vendor may not mark “Rose water” or “Eau de Cologne” on a bottle containing ordinary water. Such cases will no doubt constitute offences under Sec. 6 of the Merchandise Marks Act, but they will also come under Sec. 487, Indian Penal Code. Similarly reference to nature or quality of the goods in this section may bring several cases of false trade description within its scope.

The points requiring to be proved for a charge under this section are—

- (1) the accused had marked upon any case, package or other receptacle containing goods;
- (2) that such mark was false;
- (3) that he did so in a manner reasonably calculated to make a public servant or any other person to believe—
  - (a) that the goods inside the receptacle were different from what they actually were or
  - (b) that the receptacle did not contain the goods which it, in fact, contained or
  - (c) that the goods in the receptacle were of a different nature or quality from what they were.

In defence the accused can plead that he had no criminal intention. As under the earlier sections intent to defraud will be presumed against the accused; but such presumption is rebuttable. If the accused succeeds in establishing before the court the absence of “mens rea” he will be acquitted.

Where an accused had been prosecuted and convicted under Sec. 61 of the Bengal Excise Act and proceedings had been instituted against him under Secs. 486 and 487, Indian Penal Code and Secs. 6 and 7 of the Merchandise Marks Act, it has been held that the provisions of Sec. 403 of the Criminal Procedure Code did not operate as a bar to the institution of separate proceedings under the Merchandise Marks Act in respect of an offence which was disclosed during the course of the first trial.<sup>20-a</sup>

#### **Punishment for making use of any such false mark.—**

“488. *Whoever makes use of any such false mark in any manner prohibited by the last foregoing section shall, unless he proves that he acted without intent to defraud, be punished as if he had committed an offence against that section.*”

The offence is non-cognisable, and non-compoundable. It is bailable and is triable by Court of Session, Presidency Magistrate or Magistrate of the first or second class.

The points requiring proof are:—

- (1) that the accused made use of any package, case or receptacle containing the goods;
- (2) that such package or case had applied on it a mark, and

- (3) that such mark was a false one and was reasonably calculated to cause any public servant or other person to believe that the goods within the case or package or their nature or quality were different from what they actually were.

The above points establish a *prima facie* charge against the accused who may, however, plead in defence that he acted without intent to defraud.

It may be noted that this section is also primarily intended to prevent persons from evading the payment of customs duties in full or in part by making use of false marks on cases or receptacles.

**Tampering with property mark with intent to cause injury.—**

“489. Whoever removes, destroys, defaces or adds to any property mark, intending or knowing it to be likely that he may thereby cause injury to any person, shall be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.”

This offence is non-cognizable, bailable and is triable by the Presidency Magistrate or a Magistrate of first or second class. Summons should ordinarily issue in the first instance. It is non-compoundable.

The section is limited to offences relating to tampering with property marks.

The points to be proved for establishing an offence under this section are:—

- (1) that the mark in question was a property mark;
- (2) that the accused tampered with it by removing, destroying, defacing or adding to it;
- (3) that the accused did so intending or knowing it to be likely that he may thereby cause injury to any person.

The object of this section is to prevent cases of misappropriation of goods by defacing the property mark which may have been applied on them. It may be noted that for an offence under this section the prosecution has to establish that at the time of tampering with the property mark the accused intended to cause or knew it to be likely that he might thereby cause injury to another person. The onus of proving *mens rea* is thus left to the prosecution without which the accused cannot be convicted.

## 11. Trade Descriptions.

**Section 2 (2) Merchandise Marks Act.**—The expression 'trade description' is defined by Sec. 2 (2) of the Act as follows:—

*"Trade description" means any description, statement or other indication, direct or indirect,—*

- (a) *as to the number, quantity, measure, gauge or weight of any goods, or*
- (b) *as to the place or country in which, or the time at which, any goods were made or produced, or*
- (c) *as to the mode of manufacturing or producing any goods, or*
- (d) *as to the material of which any goods are composed, or*
- (e) *as to any goods being the subject of an existing patent, privilege or copyright;*

*and the use of any numeral, word or mark which according to the custom of the trade is commonly taken to be an indication of any of the above matters shall be deemed to be a trade description within the meaning of this Act:*

The above definition has been adopted from the corresponding Sec. 3 (1) of the English Statute.

**Imitation of 'make up'.**—The indication alluded to in the words "any description, statement, or other indication, direct or indirect," in the definition of trade description must be in the nature of a description or statement and does not include the 'make up' of goods.<sup>21</sup> A person cannot, however, pass off his goods under the imitation of the get-up of a well-known manufacturer even though the goods are not accompanied by any description as belonging to the other person. Such imitations of get-up may come under the supplemental provisions in Sec. 4 (1) of the Act constituting a false description, and may also be dealt with as a false trade mark.

**Verbal trade description.**—According to English case-law a description which is merely verbal cannot constitute a trade description within the meaning of the Act. Much less would it be the case where the description is inferred merely from the conduct of the person selling the article in question. A leading case on the point is *Langley v. Bombay Tea Co., Ltd.*,<sup>22</sup> where the court held

(21) The Merchandise Marks Manual, (1930) p. 13.

(22) (1900) 2 Q.B. 460. See also *Coppen v. Moore*, No. 1, (1898) 2 Q.B. 300.

that trade description meant something written, printed or stamped and that a description expressed in words or implied by conduct was not sufficient to constitute an offence under the Act. False verbal statements even where deliberately made with a view to induce the purchaser to buy certain goods will not constitute a false trade description within the meaning of the Merchandise Marks Act, but in such cases the complainant may sue for cheating.

. But words which are unintelligible would constitute a trade description if at the time of sale, they were explained orally. The case of *Cameron v. Wiggins*<sup>23</sup> may be cited in this connection. The purchaser asked for New Zealand mutton and was supplied with mutton on which the letters N.M. were marked. At the time of the sale it was explained that the letters stood for New Zealand. Notwithstanding the absence of any trade custom as to the meaning of the letters in question evidence of the verbal description was held admissible and the letters were held to constitute a trade description in these circumstances.

**Words on the goods not constituting trade description.—**

Under certain conditions words which are marked on goods would be regarded as part of the goods themselves and not as trade description, although such words may, in fact, indicate the nature of the goods within the definition of the above section. Some illustrations are given in the Merchandise Marks Manual. Rule 32 says:

“The use of the English language on foreign made goods is admissible as parts of the goods themselves.

*Examples.*—English verses and texts on 'Xmas and birthday cards; words such as “Photographs” and “Stamps” on albums; “Tobacco” on pouches; “Gold,” “Silver,” “Stamps” on the divisions of a purse, the names of hotels or purveyors on crockery intended for use by the establishments or firms whose names it bears; “Fast,” “Slow,” on regulators of Swiss Watches; regulating words such as “Blood heat,” “Boiling,” “Freezing,” on thermometers, or “Fair,” “Rain,” etc., on barometers; Christian names on handkerchiefs. The use on such goods, however, of names of makers, publishers, or dealers in this country, or of any description of the goods or address which would in any way suggest English origin, will involve detention. Expressions such as “Think of me,” “For a good boy,” on foreign goods must bear a statement of foreign origin.”



(a) *Number, quantity, measure, gauge or weight of any goods.*—This clause is directed to description of textile and other goods where the length and number of folds are commonly marked on the goods. Such description is often compulsory in the case of textile goods. For instance, Sec. 12 (1) lays down that all piece-goods which have been manufactured in British India shall not be removed from the factories without having conspicuously stamped in British numerals on each piece the length thereof, in standard yard, according to the real length of the piece. Paragraphs 6 to 10 of Notification No. 1430 of the 6th April, 1891, as subsequently amended prescribe the conditions under which yarn should be tested for the purposes of the Merchandise Marks Act and paragraphs 1 to 5 of Notification No. 1474 of the 13th November, 1891, as subsequently amended declare what variations from the described length, weight or count, make trade descriptions false in the material respect.<sup>24</sup>

(24) TRADE DESCRIPTIONS OF LENGTH AND WIDTH.

*No. 1474, dated the 13th November, 1891, as subsequently amended:—*

In exercise of the powers conferred by Sec. 16 of the Indian Merchandise Marks Act, IV of 1889, and in supersession of all existing orders on the subject, the Governor-General in Council directs that Criminal Courts, in giving effect to the provisions of the Act in respect of trade descriptions of quantity, measure, or weight of the goods specified hereunder shall observe the following instructions:—

I.—A trade description of length stamped on *grey, white, or coloured cotton piece-goods*, shall not be deemed to be false in a material respect, unless—

(a) where a single length is stamped, the description exceeds the actual length by more than—

4 inches in pieces stamped as 10 yards long and under;

5 inches in pieces stamped as above 10 yards and upto 23 yards long;

7 inches in pieces stamped as above 23 yards and up to 36 yards long;

9 inches in pieces stamped as above 36 yards and up to 47 yards long;

18 inches in pieces stamped as above 47 yards long;

Provided that the average length of the goods in question shall not be less than the stamped length;

(b) where a maximum and a minimum length are stamped, the described maximum length is greater than the actual length by more than—

9 inches in piece-goods under 35 yards long;

18 inches in piece-goods 35 yards and up to 47 yards long;

36 inches in piece-goods above 47 yards long;

Provided that no such piece shall measure less than the minimum stamped length.

As an example of trade description relating to "number" the

- II.—A trade description of width stamped on *grey, white, or coloured cotton piece-goods* shall not be deemed to be false in a material respect, unless the description exceeds the actual width by—
- half an inch in pieces stamped as 40 inches or less in width;
  - three-quarters of an inch in pieces stamped as over 40 inches or under 59 inches in width;
  - one inch in pieces stamped as 59 inches or more in width;
- Provided that the average width of the goods in question shall not be less than the stamped width.

#### TRADE DESCRIPTIONS OF COUNT.

III.—A trade description of count or number, length or weight, applied to *grey or bleached cotton yarn*, shall not be deemed to be false in a material respect, unless—

- (a) the described count or number is greater or less than the actual count or number by more than 5 per cent., provided that the average count of the whole of the yarn in question is not greater or less than the described count; or
- (b) (i) in a bundle of *grey yarn*, the average length of the whole number of single hanks is less than 840 yards and of double hanks is less than 1,680 yards; or
- (ii) in a bundle of *bleached yarn*, the average length of single hanks is less than 819 yards and of double hanks is less than 1,683 yards; or
- (c) (i) in a bundle of yarn of any count under 50, described as being 10 lbs. in weight, the number of knots of 20 hanks each is not half of, or the number of knots of 10 hanks each is not the same as, or the number of knots of 5 hanks each is not double the described count or number of the yarn; or
- (ii) in a bundle of yarn of any count under 50, described as being 5 lbs. in weight, the number of knots of 20 hanks each is not a quarter of, or the number of knots of 10 hanks each is not half of, or the number of knots of 5 hanks each is not the same as, the described count or number of the yarn; or
- (iii) in a bundle of yarn of any count from 50 upwards, the number of knots of 20 hanks each is not half, or the number of knots of 40 hanks each is not a quarter, when the described weight is 10 lbs., or is not a quarter or an eighth, when the described weight is 5 lbs., of the count or number of the yarn; or
- (d) in the case of *bleached yarn*, the described weight exceeds the actual weight by more than—
  - 10 per cent. in counts up to 24;
  - 8½ per cent. in counts from 25 to 40;
  - 7½ per cent. in counts of 41 and upwards;

the allowance being 1 per cent., less than that specified in each of the above cases if the bleached yarn in the bundle is two-fold:

Provided that for the purposes of applying any of the sub-clauses of Clause (c) to importations of single yarn in double hanks and of two-fold yarn in single and double hanks, one single hank of two-fold yarn, one double

case of *Rex v. Ananiadi*<sup>25</sup> may be cited. The practice in the cotton trade is that yarn is made up into "hanks," each hank measuring 840 yards. The number of hanks which make up one pound represents the fineness of the yarn in 'counts.' The defendant, for the purposes of his export trade had caused bundles of yarn containing fortyfive hanks to the pound to be made into bundles containing sixty hanks to the pound by "short reeling." A double fraud was thus committed since the yarn was made to appear of finer quality than what it actually was and each hank contained only 640 yards instead of the normal length, namely, 840 yards. It was held by the Magistrate that there was misrepresentation both as to the length and fineness of the yarn and it was immaterial whether or not the number of the count was described on the bundles of yarn. The defendant was convicted for causing false trade description to goods.

**Invoices are trade descriptions**—An invoice sent in connection with the goods whether it comes just before or after the goods will constitute a trade description in connection with the goods. In *Budd v. Lucas*<sup>1</sup> the respondent supplied six barrels of beer with an invoice in which the casks were described as "barrel." In the beer trade the term "barrel" indicated a cask containing 36 gallons but one of the casks delivered contained considerably less than this quantity. Although the invoice was not physically attached to any of the casks it was held that it was a false trade description within the meaning of the Act. So also in *North Eastern Breweries, Ltd. v. Gibson*<sup>2</sup> the respondent having ordered

hank of single yarn, and one double hank of two-fold yarn shall be taken respectively as two, two and four hanks of single yarn, but the described count or number shall contain a definite indication that the yarn in the bundle is two-fold or in double hanks or both, as the case may be.

IV.—A trade description of count or number applied to a bundle of *dyed, cotton yarn* shall be accepted as indicating length, only, the hank being taken to measure 840 yards, and it shall be deemed to be false in a material respect if the average length of the hanks in a bundle is less than 819 yards.

V.—A trade description of length applied to *thread of any kind* (of cotton, wool, flax or silk) shall not be deemed to be false in a material respect, unless it exceeds the actual length by more than 1 per cent.

(25) Manchester Police Court, 30th July, 1889, (Manchester Guardian, 31st July, 1889). See also *Rex v. Manoukian*. Manchester Police Court, 10th May, 1898; (Manchester Guardian, 11th May, 1898.)

(1) (1891) 1 Q.B. 408.

(2) (1904) 20 T.L.R. 496; 48 Sol. Jo. 476.

one Kilderkin of ale received a cask of ale together with an invoice. The cask held 17 gallons 1 quart and 1 pint while a Kilderkin was a cask holding 18 gallons. It was found as a fact that the appellants knew that the process of coopering casks had the effect of diminishing their holding capacity. It was held that the appellants were rightly convicted of applying a false trade description. The section also extends to cases where a description which although made orally was added to the invoice at the request or suggestion of the person who purchased the goods.<sup>3</sup>

**Star Tea Co. v. Whitworth.**—In *Star Tea Co., Ltd. v. Whitworth*<sup>4</sup> the respondent alleged that the description of a packet of tea as containing quarter pound was false trade description under the following circumstances. The packet of tea was wrapped in a piece of leadpaper wrapper having the words “quarter pound gross weight.” The packet was tied up with a string and inserted under the string was a ticket on which were printed “Given with 1¼ lb. of tea” on one side and on the other a notice to the effect that every purchaser of tea from 1¼ lb. and upwards would receive a valuable present. The packet together with the wrapper weighed slightly over 1¼ lb., but it contained 3¾ oz. only of tea. The Magistrate held on these facts that the ticket under the string constituted a false trade description and this decision was upheld on appeal by the Division Court.<sup>5</sup> Where, however, the description applied to goods clearly indicated that the weight of the goods supplied was less than what the purchaser asked for, there would be no offence. For instance, if a purchaser asked for half pound of tea and was supplied with a packet with a description clearly showing that only the gross weight of the packet was half pound, there would be no commission of offence.<sup>6</sup>

(b) *Place or country in which or the time at which any goods were made or produced.*—This is an important sub-section and corresponds to Sec. 3 (1) (b) of the English Statute. Any description, statement or other indication that the goods to which they are applied were made or produced in one country when such goods were really made or produced in another, would constitute a false trade description.

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(3) *Coppen v. Moore* (No. 1), (1898) 2 Q.B. 300.

(4) (1904) 20 T.L.R. 539; 91 L.T. 87.

(5) Lord Alverstone, C. J., Wells and Kennedy, JJ.

(6) *Langley v. Bombay Tea Co., Ltd.*, (1900) 2 Q.B. 460.

Three principal classes are to be distinguished under this head.<sup>7</sup>

(1) goods made or produced beyond the limits of the United Kingdom and British India and bearing or purporting to bear the name or trade mark of a manufacturer or trader in these two countries;

(2) goods made or produced beyond the limits of the United Kingdom and British India, and having applied on them a false trade description or indication, other than the name or the trade mark of a manufacturer or trader in British India or the United Kingdom, indicating that the said goods were made or produced in either of these countries; and

(3) goods made or produced in one country, but bearing a false trade description indicating that they were made or produced in another.

The importation of goods falling under any of these clauses is prohibited under Sec. 18 (*d* and *e*) of the Sea Customs Act. (Sec. 10 (1) of the Indian Merchandise Marks Act).

Since unmarked goods may be imported without any indication as to the country of origin, the question may arise whether the marking of such goods with trade marks or descriptions in English after their importation into India will constitute the offence of falsely applying trade marks or descriptions. A similar thing happened in the English case *Watson v. Dr. Jaeger's Sanitary Woollen System Co.*,<sup>8</sup> where the accused was charged with the offence of unlawfully causing to be applied a false trade description, namely, a mark purporting to be an English mark under the following circumstances. The respondent had imported unmarked vests of German manufacture and had applied on them after their importation into England the words "Dr. Jaeger's Sanitary Woollen System Co., Sole Concessionaries, pure wool, Warranted." He was charged under Sec. 2 (1) of the English Merchandise Marks Act for applying a false trade description to goods. The Lord Mayor dismissed the case on the ground that the imposition of the mark on the goods was not such a use of a "mark" as defined by Sec. 3 (1) of the English Act, as to constitute its application to such goods a "false description" as defined therein. He also held that the evidence as to whether according to the custom of the trade the imposition of English words on unmarked goods of

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(7) See *Merchandise Marks Manual*, p. 17.

(8) (1897) 13 T.L.R. 150.

foreign manufacture indicated that the goods which were so marked were made in England was not admissible. The Divisional Court held that the evidence sought to be given was admissible. Wright, J., said: "The case must go back with the direction that the evidence sought to be given was admissible. The trade mark may be a false trade description, and the appellant may call any evidence he likes to show that it is so." But the respondent failed to establish the alleged custom of the trade.

**Goods made partly in one country and partly in another.—**

The chief difficulty in connection with the application of this section lies in respect of goods which are not wholly made in any one country. Certain instructions in this connection are contained in the Indian Merchandise Marks Manual.<sup>8-a</sup> "In the case of goods with distinguishable parts or constituents manufactured or produced in different countries, an indication of origin in any country on one part should be taken, in the absence of anything to the contrary, as applicable to the whole." As examples it is mentioned "that a British or German hall-mark on the case of silver watch should be held to include the works and dial plate also and if the works and dial plate are not of British or German make, as the case may be, a counter indication should be required on the latter."<sup>9</sup> In the case of goods with indistinguishable parts or constituents made in different countries, a general statement such as 'produce of different countries' is permissible.

*Example.*—Brandy blended in the United Kingdom from the produce of France or Italy.

In the case of goods with indistinguishable parts or constituents made in the United Kingdom and other countries, the above counter-indication will be sufficient even when the goods bear the name or trade mark of a British or British Indian trader or dealer. The names of provinces or towns cannot ordinarily be substituted for those of countries except in those cases where they are so extensively known that the Indian consumer is not likely to be misled, (*e.g.*) Paris, Bohemia, Berlin."

**Bischof v. Toler.**—In *Bischof v. Toler*<sup>10</sup> the person had in his possession for sale margarine packed in cardboard boxes marked with the words "French Factory." The margarine consisted of a

(8-a) See p. 20 of the Manual.

(9) Special Secs. 7 & 8 for marks on watch cases are provided in the English Statute.

(10) (1895) 65 L.J.M.C. 1; 73 L.T. 402; Referred: *Williamson, Ltd. v. Tierney*, (1900) 83 L.T.N.S. 592.

substance called "Le Densk" obtained from animal fat made in a French factory and thence sent to England where it was mixed with Danish butter and English milk and made into the finished product which was sold. Lord Russel, C. J., and Cave, J., held that the circumstances in which "Le Densk" was sold to the public represented that the article was of foreign manufacture and that as the margarine became the finished product for the first time in England the words "French Factory" constituted a false trade description.

In *Williamson, Ltd. v. Tierney*<sup>11</sup> certain parts of a watch were imported into England in a more or less unfinished state and the watch was assembled in England. The value of the imported pieces was about 8*d* and the watch was sold for £2-5*sh*. with the description "English lever." The Magistrate held that the finishing operations in England were not of such a character as to destroy the foreign character of the imported parts and convicted the appellants of applying a false trade description to the watch. On appeal to the Court it was held that if the Magistrate had come to that conclusion as one of fact on the evidence the Court would not disturb his decision; but if he decided upon the view that the inclusion of certain parts partly manufactured abroad compelled him as a matter of law to hold that "English lever" was a false trade description, then his decision could not be supported.

**Geographical names.**—A trade description which in indicating a particular class of goods includes the name of a place or country, must be regarded *prima facie* as suggesting that the goods are the produce of that country. This rule should however be applied subject to the following interpretations.<sup>12</sup> Geographical names in trade descriptions may be classified under three groups:—

(1) those which retain their geographical significance (*e.g.*) Jamaica Rum, Scotch Whisky, etc.,

(2) those which have lost their geographical significance, but are still calculated to mislead (*e.g.*) Munich beer, Carrara marble, Damascus steel, Egyptian cigarettes, Kidderminster carpets, Paris garters, Amritsar shawls, Shetland wool; Windsor soap, etc., and

(3) those which have by common usage been accepted as devoid of geographical significance and are not calculated to mislead (*e.g.*) Balsam Peru, Balaclava caps, Brunswick black, Cash-

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(11) (1900) 17 T.L.R. 174; 83 L.T. 592.

(12) The Merchandise Marks Manual, Part III, Rule 27.

mere when applied to woollen goods, Eau de Cologne, French Polish, French chalk, German silver, India rubber, Indian ink, Manilla rope, Morocco leather, Plaster of Paris, Prussian blue, Russian leather, Turkish towels.

The customs officers are instructed that in the case of geographical descriptions falling under the first group if the goods are not actually made or produced in the country referred to, no counter indication should be accepted. Where the name has lost its geographical significance, though still calculated to mislead, a counter indication of origin may be accepted as removing any misapprehension. In the case of descriptions falling under the third category the goods may be passed without any counter indication; but such counter indication would be necessary where other English words are used along with these geographical names.

In *Homes v. Pipers, Ltd.*,<sup>13</sup> the respondents sold a bottle bearing the label "Fine British Tarragona wine." The bottle did not, however, contain Tarragona wine but a mixture of 85 per cent. of an English wine and 15 per cent. of Mistella, a heavy form of Tarragona wine made and used solely for blending purposes and not suitable for consumption by itself. It was held that the label on the bottle was a false trade description within the Merchandise Marks Act.

In *Sandeman v. Gold*,<sup>14</sup> the respondent sold a bottle of Spanish wine as "Tarragona Port", "Tarragona" being not port, and the wine sold being "Tarragona". It was held that a false description had been applied, as under the Anglo-Portuguese Commercial Treaty Acts, 1914 and 1916, the description "port" applied to any wine other than wine produced in Portugal should be deemed to be a false trade description within the Merchandise Marks Act.

In *R. v. Butcher*,<sup>15</sup> the defendant sold British made cigars from Havana tobacco in boxes bearing Spanish words "Flor de Creanso" and the picture of a Spanish lady. It was shown that British made cigars had for many years been sold under a similar get-up. It was held that a false description had been applied and that it was not necessary to prove that the purchaser was

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(13) (1914) 1 K.B. 57; 83 L.J.K.B. 285. Cf. *Hooper v. Riddle & Co.*, (1906) 95 L.T. 424.

(14) (1924) 1 K.B. 107; 40 T.L.R. 31; 68 Sol.Jo. 140.

(15) (1908) 99 L.T. 622; 24 T.L.R. 797; 52 Sol. Jo. 716.



misled. Similarly, in another case<sup>16</sup> cigars not made in Cuba were described as "Bella de Cuba" and sold in boxes labelled with Spanish names, and the picture of a Spanish lady. It was held that a false description had been applied within the meaning of the Merchandise Marks Act, notwithstanding that the boxes were stamped with the words "guaranteed British Make."

**Mode of manufacturing or producing any goods.**—An article cannot be described as having been manufactured in a manner which is different from the actual mode of its manufacture. Reference may here be made to the recent Khaddar Act of 1934 (Act 8 of 1934.) The Act is directed to regulate the use of the words "Khaddar" and "Khadi" when applied as trade description of woven materials. By Sec. 2 of the Act, "the words 'khaddar' and 'khadi' whether in English or in any Indian Vernacular language, when applied to any woven material shall be deemed to be a trade description within the meaning of the Indian Merchandise Marks Act, IV of 1889, indicating that such material is cloth woven on handlooms in India from cotton yarn handspun in India."

It is immaterial whether the article produced is of the same quality or not. In *Kirshenboim v. Salmon and Gluckstein*<sup>17</sup> the respondents were charged with selling machine made cigarettes as 'guaranteed, hand made' and the Court held that the description was false in a material respect although the cigarettes were of equally good quality as what was asked for.

**As to the material of which any goods are composed.**—A mere commendatory description of quality does not come under this clause. For instance, statements that a thermometer measure temperature in one minute when it requires five minutes or that a common watch is a chronometer will not constitute a trade description within the meaning of this section. Rules 49, 50 and 54 in Part III of the Merchandise Marks Manual contain specifications for certain goods.<sup>18</sup> A qualifying description will be

(16) *R. v. Phillips (J), R. v. Phillips (P). and R. v. Phillips (D)*, (1909) 25 T.L.R. 764.

(17) (1898) 2 Q.B. 19.

(18) Rule 49. (1) In the case of (a) white zinc, red lead, white lead and similar substances, (b) linseed oil and (c) turpentine, which are described as such, no qualifying description need be required when the percentage of impurities is less than 5 per cent,

necessary where the goods do not satisfy the respective specifications. Rules 52 and 53 contain some examples of trade descriptions which should be treated as false trade descriptions

(2) When the percentage of impurities exceeds 5, but is less than 50, an adequate qualifying description such as "adulterated" or "reduced" should be required.

(3) When the percentage of impurities is 50 or exceeds 50, the actual percentage of adulteration must be marked in addition to the adequate qualifying description.

The marking where required under either of the two preceding clauses should be conspicuous and accompany every application of the description.

Rule 50. (1) In the case of white zinc, white lead, red lead and similar substances, the adulteration should be calculated on solid pigment alone and not on the solid pigment and oil together. In the case of these articles, a margin of 5 per cent. may be allowed before requiring a description of marking already applied to be altered. For example, a keg of red lead is marked 50 per cent. reduced and the chemical analysis shows 42 per cent. red lead, 8 per cent. oil and 50 per cent. other matter. According to this analysis the keg should be marked 54·3 per cent. reduced. As, however, the difference between this percentage and that contained in the description already applied is less than 5 per cent., the marking need not be objected to.

(2) In the case of turpentine this margin may be increased to 10 per cent.

Rule 52. Descriptions like "Star silver", "Art silver", "Potosi silver", "Aluminium gold", "Arcadian gold", "Real gold beads" and the like, when applied to articles not made of silver or gold, should be treated as false trade descriptions. "German silver" and "Nickel silver" may, however, be passed without objection as these descriptions are well-known to all classes likely to be affected, and have been in use for a sufficiently long period to render it improbable that a purchaser would be deceived by their use. No objection should be taken to the use of such marks as "Potosi," "Nevada," etc., provided the words "silver" and "gold" are omitted.

Rule 53. The terms such as "Superfine", "Spanish stripes", and "Flannel" which denote pure woollen material should be treated as constituting a false trade description when used in connection with mixed or cotton fabrics made up in imitation of woollen goods unless accompanied by the word "Mixed" or "Cotton" as a counter-indication. No objection should, however, be taken to the application of the term "Merino" to hosiery or underwear made of cotton and wool mixed, or of the term "Velvet" or "Velveteen" to material made wholly or in part of cotton; nor should any objection be taken to the application of the description "All wool" on woollen hose of which the heels and toes are cotton and wool mixed, in cases in which the amount of cotton used is inconsiderable and is added only for the purpose of strengthening the heels and toes.

Rule 54. Unconcentrated milk should contain not less than 3 per cent. of butter fat. Concentrated milk of any sort so described or described as condensed milk, evaporated milk and so forth, requires an adequate qualifying description such as "Prepared from skimmed milk", if the milk on being restored to its original volume or diluted according to the directions prescribed on the label yields a product containing less than 3 per cent. of butter fat.

*Note.*—The percentage of butter fat in sweetened concentrated milk should be calculated on the whole product as in the case of unsweetened milk and not merely on the actual milk constituents of the product.

when applied to certain articles. In case of false trade descriptions falling under this clause customs officers will detain goods on their own initiative. Goods may be tested in the Customs laboratories in order to find out whether the impurities present are within the permissible limits.

**Fowler v. Cripps.**—A leading English case bearing on this section is *Fowler v. Cripps*.<sup>19</sup> The question was whether a product called "Soda crystals," but containing 18 per cent. of sulphate of soda and the rest carbonate of soda could be honestly sold under the description "Soda crystals." The term "soda crystals" was applied commonly in the trade to washing soda consisting principally of sodium carbonate. But in the preparation of this product it was usual to add a small percentage (which was always less than 2 per cent.) of sodium sulphate in order to make the former less sticky during crushing and drying. A practice had thus grown up of adulterating soda crystals with a very small amount of sulphate of soda. The latter was a much cheaper product and was useless for washing purposes. It was contended that crystallised sodium sulphate was a species of soda crystals and that the description was therefore true. But the Divisional Court held that the description under the circumstances was a false one within the meaning of the Act.

In *R. v. Bryan*,<sup>20</sup> the accused was convicted in the lower court of obtaining money from pawn brokers by fraudulently representing that his spoons were *silver spoons* as good as a well-known brand (Elkington's "A" spoons.) The conviction was quashed on appeal on the ground that as the spoons did, in fact, contain a very small percentage of silver the misrepresentation was as to quality and not in respect of the substance of the article. This interpretation of the section was unfortunate as it permitted frauds of a like nature; for instance, a person could sell his brass wares as of gold and escape conviction if he showed that they contained some traces of gold. It was, however, laid down in *R. v. Ardley*<sup>21</sup> that the ruling in the above case was only of limited application.

**R. v. Ardley.**—The whole question was fully discussed and the matter was set at rest in *R. v. Ardley*.<sup>22</sup> The prisoner was

(19) (1906) 1 K.B. 16.

(20) (1857) 7 Cox. 312; 169 E.R. 1002.

(21) (1871) 12 Cox. 23; L.R. 1 C.C.C. 301; 24 L.T. 193.

(22) (1871) 12, Cox. 23; L.R.I.C.C.R. 301; 24 L.T. 193.

charged with selling a watch chain by fraudulently representing it to be of fifteen carats gold when it was in fact only of 6 carats, knowing at the time of sale that such representation was false. A distinction was drawn between what is mere trade puff or praise as to quality of the goods, even if untrue, and a deliberate misrepresentation of quality, knowing the same to be false with intent to defraud. In the former case it becomes a matter of opinion and *R. v. Bryan* would apply, while in cases of the latter type conviction would lie. In the course of his learned judgment, Bovill, C.J., said: "The case which has been most pressed upon us is *R. v. Bryan*. The representation in that case was that certain plated spoons were equal to "Elkington's A." *Prima facie* the representation would seem to be a matter of opinion, and the Court held it was not sufficient to support the conviction. But many of the Judges expressed the opinion that there might well be cases in which misrepresentations, though as to quality, would be within the statute. Cockburn, C.J., says: "If the prisoner had represented these articles being of Elkington's manufacture, when in point of fact they were not, and he knew it, that would be an entirely different thing." Pollock, C.B., says: "I think if a tradesman or a merchant were to concoct an article of merchandise expressly for the purpose of deceit, and were to sell it as and for something very different even in quality from what it was, the statute would apply." It is plain that these learned judges considered that a specific representation of quality, if known to be false, would be within the statute. Coleridge, J., expressly concurs in the observations of Pollock, C.B. Erle, J., at the close of his judgment, says: "No doubt it is difficult to draw the line between the substance of the contract and the praise of an article in respect of a matter of opinion; still it must be done, and the present case appears to me not to support a conviction, upon the ground that there is no affirmation of a definite triable fact in saying the goods were equal to "Elkington's A," but the affirmation is of what is mere matter of opinion, and falls within the category of untrue praise in the course of a contract of sale, where the vendor has in substance the article contracted for, namely, plated spoons." Crompton, J., also considered that the statute applies 'where the thing sold is of an entirely different description from what it is represented to be.' Willes, J., who dissented from the judgment of the court, goes the whole length of saying that a representation as to quality, if known to be false, is enough to support a conviction. And Bramwell, B., leans to the same

opinion. "Applying these observations to the present case, the statement here made is not in form an expression of opinion or mere praise. It is a distinct statement, accompanied by other circumstances, that the chain was fifteen-carat gold. That statement was untrue, was known to be untrue, and was made with intent to defraud. How does that differ from the case of a man who makes a chain of one material and fraudulently represents it to be of another? Therefore, whether we look at the whole of the evidence, or only at that which goes to the quality of the chain, the conviction is good. The case differs from *R. v. Bryan*, because here there was a statement as to a specific fact within the actual knowledge of the prisoner, namely, the proportion of pure gold in the chain." It follows from the above decision that where a misrepresentation is made with intent to defraud and when a person is defrauded by such misrepresentation, then conviction will lie. Where, therefore, a person deliberately misrepresents by applying to goods of an inferior quality a label applicable only to goods of a superior quality, though both the goods are made by the same manufacturer, the principle laid down in *R. v. Ardley* will apply and the person would be liable for conviction under the Act.

In *Davenport v. Apollinaris Co., Ltd.*,<sup>23</sup> the respondents sold bottled mineral water as "natural mineral water." The water was taken from a spring and conducted into tanks for the purpose of bottling. While in the tank a small proportion of common salt was added in order to neutralise the effect of the sulphur contained in the water on the corks of the bottles and carbonic acid which escaped from the water on storing was reintroduced into the water in the process of bottling under similar pressure as would prevail in the spring. There was no evidence that the word "natural" had any special trade signification in connection with the sale of mineral waters. It was held that the Magistrate had come to a correct conclusion that the water as sold was in all essentials identical with the water as it existed in the spring and that the label was not a false trade description.

(e) *goods being the subject of any existing patent, privilege or copyright.*—Sub-Section (e) is taken from the corresponding Sec. 3 (1) (e) of the English Merchandise Marks Act. The improper use of the word "patent" is also dealt with under

Sec. 89 of the English Patents and Designs Act, 1907, which replaces Sec. 105 of the Act of 1883.

Section 89 reads:—

“(2) *If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding £5.*

(3) *If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word “patent”, “patented”, “registered”, or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.*

(4) *Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word “registered”, or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding £5.*

It will be seen that it cannot be pleaded in defence that the patent or copyright was once obtained; it must be in force at the time of applying the trade description. Again, a person cannot deliberately continue the use of the original labels containing the word “patent” or “patented” or “registered” after such patent or copyright had expired. Nor can a person claim the privilege of retaining the words “patent”, “patented”, etc., on the ground that they form part of his trade mark; the retention of these words when the patent or copyright is no longer in force would constitute a false trade description under the Merchandise Marks Act.

The distinction between a trade mark and a patent was stated by Vice-Chancellor Wood as follows:—“There is the difference between the case of a trade mark and that of a patent; in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say ‘Don’t sell any goods under my mark.’ He may find his customers fall off in consequence of the defendant’s manufacture; but it does not necessarily follow that the plaintiff can claim

damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee.’<sup>24</sup> In the case of a patented article, during the period when the patent is in force the public are restrained from manufacturing any article according to the invention covered by the patent, while in the case of an article not protected under an existing patent any person may openly manufacture the article, and tell the public that he is manufacturing and selling those articles. The court will therefore not allow the prolongation of a patent by means of a trade mark.<sup>25</sup> The law was clearly explained in *Cheavin v. Walker*.<sup>1</sup> The plaintiff manufactured filters on a principle patented by his father, but which patent had lapsed in 1865. The filters were marked with the words “G. Cheavin’s improved patent gold medal self cleaning Rapid filter, Boston, England.” The defendants also manufactured filters on the same principle and placed on them a tablet containing the same description with the name of their firm. Injunction was granted by the lower court but was dissolved by the Court of Appeal and the action was dismissed. Jessel, M. R., said: “No doubt a man may use the word “patent” so as to deceive no one. It may be used so as to mean that which was a patent, but is not so now. In other words, you may state in so many words or by implication that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade mark. Protection only extends to the time allowed by the statute for the patent, and if the court were afterwards to protect the use of the word as a trade mark, it would be in fact extending the time for protection given by the Statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade mark. Further, no man can claim a trade mark in a falsehood. It is a falsehood to represent that the patent is still subsisting.” And James, L. J., said: “It is impossible to allow a man to

(24) *Davenport v. Rylands*, (1865) 1 Eq. 302.

(25) *Singer Manufacturing Co. v. Wilson*, (Mellish, J.), (1875) 2 Ch. D. 434, 456.

(1) (1877) 5 C.D. 850; 46 L.J.Ch. 686. See also *Flavel v. Harrison*, (1853) 10 Hare 467; 68 E.R. 1010; 22 L.J.Ch. 866; *Morgan v. McAdam*, (1866) 36 L.J.Ch. 228.

prolong his monopoly by trying to turn a description of the article into a trade mark. Whatever is mere description is open to all the world." So also, in the case of *Leather Cloth Co., Ltd. v. American Leather Cloth Co., Ltd.*<sup>2</sup> Lord Kingsdown observed: "If a trade mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement, *prima facie*, amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade mark to a relief in a court of Equity against any one who pirated it."

There would, however, be no commission of offence by the use of the word "patent" as a generic term to describe goods of a particular and well known kind, for instance, "patent leather" "patent medicines," etc. So, in *Marshall v. Ross*<sup>3</sup> it was held that the word "patent" as part of the description of a particular class of thread was not a false trade description, though not protected by any patent, as it was established that the goods had acquired this designation in the market from long usage and that the expression 'patent thread' was generally used in the trade to describe a particular kind of linen thread. It is seen, therefore, that the use of the word 'patent' to an article which has not been patented would constitute a false trade description only when it indicates or is likely to indicate that the article is protected by an existing patent.

**Gridley v. Swinborne.**—In special circumstances the court may exercise its discretion and acquit the accused on the ground that there was no *mens rea*. In *Gridley v. Swinborne*<sup>4</sup> the original patentee continued to use his old packets containing the words "Swinborne's patent Refined isinglass" and on the back the words "Swinborne's patent. Warranted pure and free from adulteration." On analysis the product contained gelatine and not isinglass, which is a particular form of gelatine obtained from the bladder of the sturgeon and other fishes. Swinborne's patent disclosed a method of preparing gelatinous matter from hides and skins, cod sounds and other fishy matters. The patent was taken out in 1847 and had long since ceased. It was shown that isinglass and gelatine were chemically the same product, though not physically, and that the word "isinglass" was frequently used in the trade to describe gelatinous matter. Chemical analysis showed that the article sold

(2) (1865) 11 H.L.Cas. 523; 11 F.R. 1435.

(3) (1869) 8 Eq. 651.

(4) (1888) 5 T.L.R. 71.



by the respondent's firm was a more concentrated and purer form of isinglass. In these circumstances the court held that there was no false trade description. Lord Coleridge, C. J., said: "There might be circumstances which would point to fraud if an article was said to be a patent substance when it was not, but where the original patentee, carrying on the patent process as before, merely continued his old labels, which gave a description of the goods as being "patent" goods, there was not any necessary inference, of fraud, and the tribunal, whether Lord Mayor or Jury, could decide on that fact." His Lordship further observed: "This was a criminal charge; a *mens rea* would have to be made out. It was not admitted that isinglass was scientifically not the same as gelatine. But there was quite enough evidence for the Lord Mayor to be justified in holding that there had been no false trade description."

It has been held that where an application for patent has not been accepted the applicant is not entitled to put the term "patent" on his goods. In *R. v. Wallis*<sup>5</sup> the defendant was charged under Sec. 105 of the Patents and Designs Act of 1883 with selling a lamp as a patented article when no patent had been granted, although a provisional specification had been filed. It was held that the burden lay on the defendant to prove that his use of the term "patent" on the goods was justifiable. The defendant failed to show that he was entitled to use the term in the circumstances and was accordingly fined. So also in *R. v. Crompton*<sup>6</sup> where the defendant sold several electric bells stamped with the word "patent" before the patent had been granted, the defendant was fined, notwithstanding that the application for patent had already been made. But in *R. v. Townsend*<sup>7</sup> where the defendant was charged with selling chairs marked with the word "patent" before the patent had actually been granted, but after the complete specification had been accepted by the Comptroller, it was held that he was entitled to use the word "patent" on his goods. It has been held in England that the use of the word "Registered" in reference to a trade mark, not registered in the United Kingdom constituted a false trade description, although the mark has been registered in a foreign country and that this is not affected by the fact that the place

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(5) (1886) 3 R.P.C. 1.

(6) (1886) 3 R.P.C. 367.

(7) (1896) 13 R.P.C. 265.

of manufacture is also marked on the goods.<sup>8</sup> But it has been held that the use of the term "Trade Mark" referring to a common law mark did not necessarily represent that the mark was registered and that such use of the words did not constitute a misrepresentation disintitling the plaintiff to relief.<sup>9</sup>

**"Use of any numeral, word or mark which according to the custom of the trade, etc."**—The practice must be prevailing at the time and be recognised generally in the trade. Expert evidence may be called to prove the existence or otherwise of any particular usage of the trade. The practice may be an old one or may be one of only recent origin. The case of *Fowler v. Cripps*<sup>10</sup> has already been referred to. In that case it was held that the addition upto 2 per cent. of Glauber's salt (sodium sulphate) to washing soda was a recognised practice in the trade and that such product was known as "soda crystals."

It will be seen that this clause is very wide in its scope, as it covers cases where the marks may not be trade marks. The corresponding clause was inserted in the English Act mainly for the protection of marks used in the cotton trade. Under the English Trade Marks Act line headings were excluded from registration as trade marks for the cotton classes. This caused general dissatisfaction among the Lancashire merchants who complained that infringements of several of their well-known line headings had taken place and that their trade had greatly suffered from such fraudulent use of their marks. The question was carefully considered by Lord Herschell's Committee, who came to the conclusion that although desirable, it would not be possible to give to line headings the protection under the Trade Marks Act. They felt strongly, however, that the fraudulent trade in goods bearing line headings ought not to remain unchecked and accordingly recommended the insertion in the Merchandise Marks Act of a clause to bring these frauds within the penalties of the criminal law.

The word 'custom' does not refer to the custom of the merchants which forms part of common law but to the existing

(8) *Wright Crossley & Co. v. William Dobbin & Co.*, (1898) 15 R.P.C. 21.

(9) *Sen Sen Co. v. Britten*, (1899) 1 Ch. 692; 16 R.P.C. 137; *MacSymons, Stores, Ltd. v. Shuttleworth*, (1898) 15 R.P.C. 748.

(10) (1906) 1 K.B. 16.

practice or usage of a trade whether old or recent. In deciding this question all the circumstances of the trade should be taken into consideration and evidence of persons in the trade is admissible for this purpose. In *Watson v. Dr. Jaeger's Sanitary Woollen System Co.*,<sup>11</sup> evidence was tendered as to whether according to the custom of the trade the imposition of a trade mark or description in English on unmarked goods imported from abroad indicated that the goods so marked were made in England. The Lord Mayor refused to admit the evidence but the Divisional Court held that the evidence sought to be given was admissible. The case was accordingly remitted to the Lord Mayor. The custom must be so well established and understood that the courts will take judicial cognizance of it. As Mr. Justice Cave said the question was "whether it amounted to a custom of the trade of so notorious a character that any one making inquiry of persons cognizant of the trade might ascertain that it was a custom."<sup>12</sup>

**Titles of books not included under trade descriptions.**—In *Radha Krishna Joshi v. Kissonlal Shridhar*<sup>13</sup> it was contended on behalf of the complainant that the name "Sri Chandu Panchang" was a trade description indicative of the mode in which the calendars were manufactured. The court said: "Title of a book, doubtless often indicates the author, but does not usually suggest the mode of production. . . Here it is not alleged that the defendant's calendars differ as to text from the complainant's or are compiled on different principles. All that is asserted is that they are unauthorized. This defect, however, does not seem to me to bring the case within the definition under consideration, for I think that if the Legislature had intended to include the unauthorized publication of books in the section relating to the application to goods of false trade descriptions, it would have used language more clearly appropriate for the purpose. If the facts alleged by the complainant are true, the law may give him redress, but his remedy does not appear to be contained either in Sec. 482, Indian Penal Code or in Sec. 6 of Act IV of 1889."

**False Trade description.**—By Sec. 2 (3) of the Act—

(11) (1897) 13 T.L.R. 150.

(12) *Ex parte Nassau*, (1886) 2 T.L.R. 339.

(13) (1901) 26 Bom. 289. In *Mathieson v. Sir Isaac Pitman & Sons, Ltd.*, (1930) 47 R.P.C. 541, the court observed that the plaintiff is entitled to an action for passing-off where the title of the defendants' book is calculated to deceive, but that there is no property or copyright in titles in themselves.

*“False trade description” means a trade description which is untrue in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement or otherwise, where that alteration makes the description untrue in a material respect, and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being a false trade description within the meaning of this Act:*

The above definition of a false trade description is supplemented by the provisions contained in Sec. 4 of the Act.

(1) *“The provisions of this Act respecting the application of a false trade description to goods or respecting goods to which a false trade description is applied, shall extend to the application to goods of any such numerals, words or marks or arrangement or combination thereof, whether including a trade mark or not, as are or is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are, and to goods having such numerals, words or marks, or arrangement or combination, applied thereto.*

(2) *The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means as applied to any goods any name or initials—*

- (a) *not being a trade mark, or part of a trade mark, and*
- (b) *being identical with, or a colourable imitation of, the name or initials of a person carrying on business in connection with goods of the same description and not having authorized the use of such name or initials.*

(3) *A trade description which denotes or imports that there are contained in any goods to which it is applied more yards, feet or inches than there are contained therein standard yards, standard feet or standard inches is a false trade description.*

A false trade description under the Act, therefore includes the following:—

(1) A trade description which is untrue in a material respect as regards the goods to which it is applied.

(2) An alteration of a trade description whether by way of addition, effacement or otherwise such as to make the description untrue in a material respect.

(3) Numerals, words or marks or arrangement or combination thereof as are or is reasonably calculated to lead persons to believe that the goods to which they are applied are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

(4) A false name or initials of a person applied in like manner as if such name or initials were a trade description.

(5) A trade description which denotes that there are contained in any goods to which it is applied more yards, feet or inches than there are contained therein standard yards, standard feet or standard inches. (Sec. 4 (3).)

It is important to note the words "untrue in a material respect". The corresponding expression in the English section is "false in a material respect." But the word "false" is construed by the Customs Authorities in England to mean, not "misleading" but merely "untrue," as in the Indian Act. So that, there is no difference in this respect between the English and Indian sections. The innocence of the owner of the goods is therefore immaterial in considering whether a particular description constitutes a "false trade description." But it was pointed out in *Gridley v. Swinborne*<sup>14</sup> by Chief Justice Coleridge, that a description should be something more than a mere inaccurate or mistaken description in order to constitute a false trade description within the meaning of the Act, and that there must be "mens rea" or criminal intent in the Act. Nor is this interpretation inconsistent with the Act, for under Secs. 7 and 8, it is provided that if the accused person proved that he had "acted innocently" he shall be acquitted.

The description must be "false in a material respect." This provision is inserted in order to meet cases of description which may be false only in minor respects. In many cases it is difficult to test the exact percentage of a particular material of which an article is made and the name of which is assigned to the article. In the case of woollen goods, for instance, a negligible portion of cotton may be admixed to strengthen certain parts of the goods.

It would not be a false description if such goods are described as all wool. Chemicals as supplied in commerce often contain a small percentage of other impurities. In the case of textile goods a small variation in the length or width or in the count of the yarn is permissible provided the variation is within specified limits. So also in a description of weight of an article a very small difference in the weight might not make the description false within the meaning of this section. Metals or alloys as sold ordinarily in the market are not chemically pure. They always contain a small percentage of other metals as impurities. But it is essential that the amount of such impurities should be negligible or be within the limits allowed by commercial usage. Each case will have to be decided on its own merits, the question being whether or not the trade description is false in a "material respect." The courts have, however, interpreted this section somewhat stringently as is seen from the decision in the case of *Starey v. Chilworth Gunpowder Co.*<sup>15</sup> Although the substituted gunpowder was of equally good quality as the gunpowder which they had contracted to supply, the fact that it was packed in barrels supplied by the Government without a counter-indication that the powder was of German manufacture was held to constitute a false trade description. So also in *Kirshenboim v. Salmon and Gluckstein*<sup>16</sup> the fact that machine made cigarettes supplied were of equally good quality as the hand made cigarettes did not afford any defence to the accused.

**Limits of variations permissible.**—In the Indian Merchandise Marks Manual certain limits in regard to measure and quality of certain classes are set down, within which a variation is permissible; but if the variation is outside those limits the description should be regarded as a false description within the meaning of the Act. Notification No. 1474, dated, the 13th November, 1891, as subsequently amended, contains the permissible variations from the described lengths, weight or count of textile goods, and the limits outside which such variations would make the trade descriptions false in a material respect. Rules 49 and 50 of the Instructions to the Customs Authorities set forth in the Manual specify the percentage of impurities allowable in paints.

**Trade descriptions which may be false, although literally true.**—A description which is true scientifically may be false as a trade description, and a description which may be scientifically

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(15) (1889) 24 Q.B.D. 90.

(16) (1898) 2 Q.B.D. 19.

incorrect may convey a true impression.<sup>17</sup> In the latter case the description must acquire a conventional or secondary meaning. In the words of Darling, J., it should be an erroneous term "consecrated by common use." "There are many such erroneous terms consecrated by common use. . . . A glaring instance is the term "Bombay ducks" as applied to an Indian fish, and it is agreed that if anybody ordered "Bombay ducks" and somebody supplied him with ducks from Bombay, the contract to supply "Bombay ducks" would be broken and not fulfilled. Another obvious instance is Eau de Cologne. Now, whatever Eau de Cologne may be, it is certainly not water from the Rhine. If Eau de Cologne were ordered, and you simply supplied a gallon of water from Cologne, that would not fulfill the contract. Another instance where anybody would understand what was meant is if you speak of "Roman pearls." They are not pearls with which any oyster has had anything to do, nor do I know that they are Roman. . . . One other instance occurs to me of a term consecrated, if I may say so, by common user which does not indicate the true fact, and that is when people speak, as they commonly do, of the judicial ermine, meaning thereby any white fur when worn by a judge. These have become conventional terms."<sup>18</sup> Rule 57 in Part III of the Merchandise Marks Manual gives some examples of descriptions which may amount to false trade descriptions although literally true; thus "lavendar water" "Kananga water" and "Florida water" or the term "extract," "extrait" or "essence" applied to an imitation of scent containing no spirit would amount to a false trade description, because spirit is one of the ingredients of these preparations in the ordinary acceptance of these terms.

**Fictitious name.**—The sub-Clause 3, (3) (c) of the English section has been omitted in the Indian Statute. This sub-section

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(17) "The fact that a description as applied to particular goods is scientifically correct will not prevent it from being a false trade description and the converse is equally true. Many trade names are of very old standing and it may be that with the advance of science some of them will become scientifically incorrect, but proof of that incorrectness will not cause them to be false trade description if they continue to be understood in the trade as indicating the same substances which they did when those terms first came into use." Wills, J., in *Fowler v. Cripps*, (1906) 1 K.B. 21. A well-known example of such incorrect use of scientific term is Sodium hyposulphate (photographer's hypo).

(18) *Lemy v. Watson*, (1915) 3 K.B. 731; 32 R.P.C., at p. 522, Darling, J. The term "Norwegian Sardines" for Norwegian brisling or sprats was held to be a false trade description,

states that a false trade description includes the names or initials which "are either those of a fictitious person or of some person not *bona fide* carrying on business in connection with such goods." This sub-section is useful as affording a means of preventing the use of "blind names," that is to say, names of persons which are of a fictitious character and which are calculated to induce people to believe that the goods are the manufacture or merchandise of a *bona fide* firm of that name when no such firm exists. The principle has been accepted by the Indian courts in civil cases. In *Sen v. Oakes*<sup>19</sup> an importer of cycles misrepresented that the goods were manufactured by a firm which actually did not exist. The court held that as the plaintiff's trade reputation was acquired by using a fictitious name he was not entitled to an injunction. An express provision forbidding the use of fictitious names is desirable in the Indian Merchandise Marks Act.

**Not being trade mark, etc.**—The name and initials of a person or firm are frequently used as trade marks. These have, however, been already dealt with under the head 'false application of a trade mark' (Sec. 3 of the Act) and are therefore expressly excluded in the present section.

**Application of trade descriptions.**—Section 5 of the Act states:—

"(1) *A person shall be deemed to apply a trade description to goods who—*

- (a) *applies it to the goods themselves, or*
- (b) *applies it to any covering, label, reel or other thing in or with which the goods are sold or are exposed or had in possession for sale or any purpose of trade or manufacture, or*
- (c) *places, encloses or annexes any goods which are sold, or are exposed or had in possession for sale or any purpose of trade or manufacture, in, with or to any covering, label, reel or other thing to which a trade description has been applied, or*
- (d) *uses a trade description in any manner reasonably calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade description.*



(2) *A trade description shall be deemed to be applied whether it is woven, impressed or otherwise worked into or annexed or affixed to the goods or any covering, label reel or other thing.*

(3) *The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame or wrapper and the expression "label" includes any band or ticket.'*

This section follows Sec. 5 of the British Statute. The section is exceedingly general in its terms, and covers the use of any trade description in a manner reasonably calculated to lead to the belief that the goods in connection with which it is used are designated or described under that trade description. There need not be any physical connection between the trade description and the goods to which it is applied. For instance, an invoice sent, with, or immediately after the despatch of, the goods<sup>20</sup> or a description which was verbally given, but which at the request of the purchaser was included in the invoice has been held to come under the operation of this section.<sup>21</sup> The insertion of the name of *Chilworth Gunpowder Co.*,<sup>22</sup> upon the barrels supplied by Government in the place where the name of the contractor had to be filled in was held to be application of a trade description within the meaning of this section.

**Penalty for applying a false trade description.—PENALTY.—**Section 6 of the Act enacts:—

*"If a person applies a false trade description to goods, he shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be punished with imprisonment for a term which may extend to three months or with fine which may extend to two hundred rupees, and in the case of a second or subsequent conviction with imprisonment which may extend to one year, or with fine, or with both."*

The expression 'without intent to defraud' has already been commented upon in an earlier section.

The penalty for selling goods to which a false trade description is applied is laid down in Sec. 7 of the Act.

**Penalty for selling goods to which a false trade description is applied.—**

*"If a person sells, or exposes or has in possession for sale or*

(20) *Budd v. Lucas*, (1891) 1 Q.B. 408.

(21) *Cameron v. Wiggins*, (1901) 1 K.B.1. *Coppen v. Moore* (No.2), (1898) 2 Q.B.D. 306.

(22) *Starey v. The Chilworth Gunpowder Co.*, (1880) 24 Q.B.D. 90.

any purpose of trade or manufacture, any goods or things to which a false trade description is applied, he shall, unless he proves—

(a) that, having taken all reasonable precaution against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade description, and

(b) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or

(c) that otherwise he had acted innocently,  
be punished with imprisonment for a term which may extend to three months or with fine which may extend to two hundred rupees, and in case of a second or subsequent conviction with imprisonment which may extend to one year, or with fine, or with both.”

The grounds of defence provided under this section are the same as those under Sec. 486, Indian Penal Code (Sec. 3 of the Merchandise Marks Act). The interpretation of the three sub-clauses discussed under the earlier section applies here. It has been suggested that the word “innocently” is not applied in the sense ordinarily attaching to it as in that case proof by the accused person that he was ignorant of the fictitious character of the description would suffice to exonerate him. The practical effect of that construction, it is argued, would be to render the immediately preceding paragraphs in the sub-section of no force.<sup>23</sup> According to this view Cl. (c) must, therefore, be read in conjunction with Cls. (a) and (b) and not as entirely apart from them. But this view is not supported by the wording of the section. It will be noticed that while sub-Cls. (a) and (b) are connected by the conjunction “and”, Cl. (c) is immediately preceded by the word “or” and begins with the words “that otherwise.” It is, therefore, reasonable to assume that in framing this section the legislature had intended that Cl. (c) should be an alternate form of defence. This latter interpretation is supported by the rulings given by Mr. Justice Channel in *R. v. Christie, Manson & Woods*<sup>24</sup> and by Lord Russell, C. J., in *Coppen v. Moore*.<sup>25</sup> As the learned Chief Justice pointed out in the latter case, Cls. (a) and (b)

(23) See judgment of Sir Peter Edlin in *R. v. Tooth*, ‘Times’, Aug. 7, 1891.

(24) (1900) 2 Q.B. 522.

(25) No. 2, (1898) 2 Q.B. 306; 14 T.L.R. 416.

apply to cases where goods in question are in the possession of the accused for sale or are sold with the false trade description already stamped upon them or otherwise applied to them, whereas Cl. (c) applies to a case where false trade description is applied upon the occasion and as part of the terms of sale.

**Application to corporations.**—The question arises whether the word “person” includes a corporation. In *R. v. Tyler*<sup>1</sup> Bowen, J., said: “Where a statute creates a duty upon individual persons, it would be a strange result if the duty could be evaded by those persons forming themselves into a joint stock company.” There is, however, a difficulty in the application of this section to corporations; for, a corporation cannot be imprisoned and can only be punished with a fine. Wherever the persons actually implicated in the offence are found and convicted they may, no doubt, be punished with fine as well as imprisonment, whether such persons are members or merely agents of the corporation. But the doctrine of “mens rea” is obviously inapplicable in the case of a corporation. So, Bramwell, L. J., said “Offences of commission are offences of individuals, not of corporations. A corporation cannot have the ‘Mens rea’; the individual offender must be got at.”<sup>2</sup> If *mens rea* is an essential element of an offence under the Merchandise Marks Act<sup>3</sup> it may be objected that a corporation not being capable of *mens rea* cannot be convicted. The general question of liability of a corporation to criminal offences need not be discussed here. It may be stated at once that the courts do not find any difficulty in interpreting the statutes so as to make a corporation responsible under the criminal law notwithstanding the above objection. Section 3 of the English Merchandise Marks Act, however, expressly states that the expression “person” includes “any body of persons corporate or incorporate.” According to the letter of this statute a corporation is therefore liable for the offence under this section. In many cases corporations have been convicted under this section and have been fined although a specific criminal intent cannot be attributed to a corporation. The usefulness of the Act would be considerably curtailed if a corporation cannot be got at even by the pecuniary penalties under the Act. For, it may often

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(1) (1891) 2 Q.B. 592.

(2) *Pharmaceutical Society v. London and Provincial Supply Association*, (1888) 5 Q.B.D. 310.

(3) *Gridley v. Swinborne*, (1888) 5 T.L.R. 71, (Lord Coleridge, C.J.); *Malumiar & Co. v. Finlay Fleming & Co.*, 7 R. 169; A.I.R. 1929 Rang. 345. (Carr, J.).

happen that the Act would be powerless to stop the mischief if the criminal proceedings which are taken are confined to employees who had actually participated in the offence charged. In a number of cases charged under the Sale of Food and Drugs Act, which in many respects is analogous to the law of Merchandise Marks, it has been held that a company registered under the Companies Act can be convicted of an offence under this Act.

• The expression "person" has not been defined in the Indian Merchandise Marks Act. But by Sec. 3 of the General Clauses Act, 1897, a 'person' shall include any company or association or body of individuals whether incorporated or not. This definition is applicable for the purposes of the Merchandise Marks Act and is quoted in the Merchandise Marks Manual. The point whether a corporation is within the Indian Merchandise Marks Act was expressly raised in *Pakir Mahomed v. Emperor*<sup>4</sup> where Otter, J., said that a body corporate such as a firm could be prosecuted for offences under Sec. 3 of the Act. In a leading English case<sup>5</sup> under the Sale of Food and Drugs Act of 1879, the question was discussed by Channell, J., who said: "By the general principles of the common law, if a matter is made a criminal offence, it is essential that there should be something in the nature of a "mens rea" and therefore in ordinary cases a corporation cannot be guilty of a criminal offence, nor can a master be liable criminally for an offence committed by his servant. But there are exceptions to this rule in the case of quasi-criminal offences, as they may be termed, that is to say, where certain acts are forbidden by law under a penalty, possibly even under a personal penalty, such as imprisonment, at any rate in default of a fine; and the reason for this is, the legislature has thought it so important to prevent the particular act from being committed that it absolutely forbids it to be done; and if it is done the offender is liable to a penalty, whether he had any "mens rea" or not, and whether or not he committed a breach of the law. Where the act is of this character then the master, who, in fact, has done the forbidden thing through his servant is responsible and is liable to a penalty. There is no reason why he should not be, because the very object of the legislature was to forbid the thing absolutely. It seems to me, that exactly the same principle applies in the case of a corporation. If it does the act which is forbidden, it is liable. Therefore, when a question arises, as in the present case, one has to consider whether

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(4) A.I.R. 1929 Rang. 322.

(5) *Pearks, Gunston & Tee, Ld. v. Ward*, (1902) 2 K.B. 1.

the matter is one which is absolutely forbidden, or whether it is simply a new offence which has been created to which the ordinary principle as to "mens rea" applies. Applying this to Sec. 6 of the Sale of Food and Drugs Act, 1875, I think the matter is quite clear, for it has already been decided in at least two cases that there is an absolute prohibition of the particular sale mentioned in the section, and consequently, there is no reason why the section should not apply to a corporation. In other words, the word person in the section includes a corporation, because no contrary intention appears." His Lordship added, "If Sec. 6 had simply provided that imprisonment should follow a breach of the section, there might have been some difficulty in applying the section to a corporation."

A commission agent who in executing the orders of a third party gets goods having false trade description may not be liable for an offence under this section."

### *III.—Unintentional Contravention of the Law Relating to Marks and Descriptions.*

**Unintentional contravention of the law relating to marks and descriptions.—By Sec. 8 of the Act—**

*"Where a person is accused under Sec. 482 of the Indian Penal Code of using a false trade mark or property mark by reason of his having applied a mark to any goods, property or receptacle in the manner mentioned in Sec. 480 or Sec. 481 of that Code, as the case may be, or under Sec. 6 of this Act of applying to goods any false trade description, or under Sec. 485 of the Indian Penal Code of making any die, plate or other instrument for the purpose of counterfeiting a trade mark or property mark, and proves—*

- (a) that in the ordinary course of his business he is employed, on behalf of other persons, to apply trade marks or property marks, or trade descriptions, or, as the case may be, to make dies, plates or other instruments for making, or being used in making, trade marks, or property marks, and that in the case which is the subject of the charge he was so employed and was not interested in the goods or other thing by way of profit or commission dependent on the sale thereof, and*

(b) *that he took reasonable precautions against committing the offence charged, and*

(c) *that he had, at the time of commission of the alleged offence, no reason to suspect the genuineness of the mark or description, and*

(d) *that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons on whose behalf the mark or description was applied,*

*he shall be acquitted.*

The section corresponds to Sec. 6 of the English Statute. The latter however lays down that even where the person is discharged from the prosecution, he "shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence." The Indian and the English sections differ also materially in another respect. The words "on demand made by or on behalf of the prosecutor" are inserted in sub-Clause (d) of Sec. 8 of the Indian Act so that this defence clause agrees with Secs. 3 (486, Indian Penal Code) and 7 of the Act. These words are however omitted in the sub-Clause (d) of Sec. 6 of the English Act. It would therefore appear that under the corresponding English section the party charged should volunteer to give the information at any time before the hearing of the charge, even though no demand had been made by or on behalf of the prosecutor. This explains the insertion of the special provision as regards payment of costs in the English section. Thus, under the English Act the accused is required to establish his *bona fides* by conforming to a more rigorous test of innocence.

The purpose of this section is to exempt from criminal prosecution persons who while engaged in their ordinary course of business of applying trade marks or trade descriptions to goods on behalf of others had unwittingly committed offences under Secs. 480, 482 and 485, Indian Penal Code, or under Sec. 6 of the Merchandise Marks Act. Such a person has to prove—

(1) that his ordinary course of business is to apply trade marks or property marks or trade descriptions to goods, or make dies, plates or other instruments for making or being used in making such marks,

(2) that the application of such trade marks or descriptions to goods or the making of such instruments is undertaken by him on behalf of others,

(3) that in the case of the offence for which he is charged he was employed in the above manner,

(4) that in the case which is the subject of the charge he was not interested in the goods or other things by way of profit or commission dependent on the sale thereof,

(5) that he took reasonable precautions against committing the offence charged,

(6) that at the time of the commission of the alleged offence he had no reason to suspect the genuineness of the mark or description, and

(7) that, on demand by the prosecutor he gave all the information in his power in respect of the persons on whose behalf the mark or description in question was applied.

All these clauses are to be taken conjointly. It should be noted that the exception provided by this section in respect of persons employed in the ordinary course of business does not apply to the offences under Secs. 483 and 484 of the Indian Penal Code, namely, (a) counterfeiting a trade mark or property mark used by another, (b) counterfeiting a mark used by a public servant. The section is limited in its application to offences under Secs. 480, 481, 482 and 485 of the Indian Penal Code, and to Sec. 6 of the Merchandise Marks Act. The wording of this section in respect of the reference to Sec. 485, Indian Penal Code, may be specially noted. Under the latter section the making of die, plate, etc., for the purpose of counterfeiting a trade mark as well as the possession of such instruments constitute an offence. The making of a die, place or other instrument for counterfeiting may be either for one's own use or another's. Section 8 of the Merchandise Marks Act, however, refers only to the making of any die, plate or other instrument under Sec. 485, Indian Penal Code, for another's use. The omission of the reference to the words "or has in his possession," etc., occurring in Sec. 485, Indian Penal Code, is significant. Obviously the exemption provided by Sec. 8 of the Merchandise Marks Act is not applicable in cases where the person is charged with possession of instruments for counterfeiting a trade or property mark. This interpretation is in agreement with the English law. In the corresponding section of the English statute (Sec. 6) a similar exception is created in the case of (1) making instruments for the purpose of forging or being used for forging, (2) falsely applying to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive, (3) applying to goods

any false trade description and (4) or causing any of the above mentioned things to be done. But the provisions of this section do not apply in the case of offences under Cls. (a) and (e) of Sec. 2 (1), namely, forging any trade mark and disposing or having in possession any die, block, machine or other instrument for the purpose of forging a trade mark. This distinction between the two offences, namely, (1) of making an instrument for the purpose of counterfeiting a trade mark and (2) having in possession such an instrument appears to lie in the fact that in the former case the person charged has made the instrument for another man and had himself no further interest in the matter, while in the latter case, there is a natural presumption that he might himself have actually used the instrument for counterfeiting the mark or has at least the intention of using the instrument for this purpose.

It may be emphasised here that Sec. 8 indicates the form of defence open to the accused when charged with any of the offences referred to in the section. What form the defence should take in other cases to establish absence of *mens rea* would depend upon the circumstances of each case.

#### IV.—FORFEITURE OF GOODS.

Section 9 of the Act lays down that—

(1) *When a person is convicted under Sec. 482 of the Indian Penal Code of using a false trade mark, or under Sec. 486 of that Code of selling, or exposing or having in possession for sale or any purpose of trade or manufacture, any goods or things with a counterfeit trade mark applied thereto, or under Sec. 487 or Sec. 488 of that Code of making, or making use of, a false mark, or under Sec. 6 or Sec. 7 of this Act of applying a false trade description to goods, or of selling, or exposing or having in possession for sale or any purposes of trade or manufacture, any goods or things to which a false trade description is applied, or is acquitted on proof of the matter or matters specified in Sec. 486 of the Indian Penal Code or Sec. 7 or Sec. 8 of this Act, the court convicting or acquitting him may direct the forfeiture to Her Majesty of all goods and things by means of, or in relation to, which the offence has been committed or, but for such proof as aforesaid, would have been committed.*

(2) *When a forfeiture is directed on a conviction and an appeal lies against the conviction, an appeal shall lie against the forfeiture also.*



(3) *When a forfeiture is directed on an acquittal and the goods or things to which the direction relates are of value exceeding fifty rupees, an appeal against the forfeiture may be preferred, within thirty days from the date of the direction, to the Court to which in appealable cases appeals lie from sentences of the Court which directed the forfeiture.*

Besides the provisions of this section as to forfeiture Sec. 12 (2) provides further that when a person removes or attempts to remove from the premises of any factory in British India piece-goods manufactured therein, without conspicuously stamping on each piece the length thereof, such goods shall be forfeited to Government.

Goods are liable to forfeiture in the following cases:

1. When a person is convicted under Sec. 482, I.P.C. of using a false trade mark.

2. When a person is convicted of an offence under Sec. 486, I.P.C., of selling or exposing or having in possession for sale or any purpose of trade or manufacture goods bearing counterfeit trade marks.

3. When an offence is committed against Sec. 487, I.P.C., by making a false mark upon any receptacle containing goods.

4. When an offence is committed under Sec. 488, I.P.C., by making use of any such false mark in any manner prohibited by Sec. 487, I.P.C.

5. When an offence is committed against Sec. 6 of the Merchandise Marks Act for applying a false trade description to goods.

6. When an offence is committed against Sec. 7 of the Indian Merchandise Marks Act for selling or exposing or having in possession for sale or any purpose of trade or manufacture goods bearing a false trade description.

7. When piece-goods manufactured in a factory in British India are removed from the factory without being stamped as required under Sec. 12 (1) of the Act.

In *re F. G. De Thiballier Mandley* an Indian customer placed an order with a firm in England for the supply of goods bearing a certain trade mark. It was held that the mark was a false trade mark under Sec. 482, I.P.C., and that the seizure and confiscation of the goods by the customs authorities under Sec. 9 of the Act

were legal and proper. It was also held that as the importation of the goods bearing a false trade mark was prohibited by Sec. 18 of the Sea Customs Act the property in the confiscated goods vested in the Crown.

Goods bearing the false trade mark or description may be forfeited although the person charged with the offence may be acquitted on proof of the defence clauses provided in Sec. 486, I.P.C., or Sec. 7 or 8 of the Merchandise Marks Act. When a forfeiture is directed on conviction an appeal shall lie against both the conviction and the forfeiture. When a forfeiture is ordered, but the person is acquitted, an appeal against the forfeiture may be preferred within thirty days from the date of the order, provided the value of the goods forfeited exceeds fifty rupees.

#### V. AMENDMENT OF THE SEA CUSTOMS ACT.

By Sections 10 and 11 of the Merchandise Marks Act certain provisions of the Sea Customs Act are amended.<sup>8</sup> These sections read as follows:—

10. (1) *For Clause (d) of Section 18 of the Sea Customs Act, 1878, the following shall be substituted, namely:—*

(d) *goods having applied thereto a counterfeit trade mark within the meaning of the Indian Penal Code, or a false trade description within the meaning of the Indian Merchandise Marks Act, 1889;*

(e) *goods made or produced beyond the limits of the United Kingdom and British India and having applied thereto any name or trade mark being, or purporting to be, . . .<sup>9</sup> the name or trade mark of any person who is a manufacturer, dealer or trader in the United Kingdom or in British India unless—*

(i) *the name or trade mark is, as to every application thereof, accompanied by a definite indication of the goods having been made or produced in a place beyond the limits of the United Kingdom and British India, and*

(ii) *(the country in which that place is situated is) in that indication indicated in letters as large and conspicuous as any letter in the name or trade*

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(8) See Appendix II for these sections of the Sea Customs Act.

(9) The words "or being a colourable imitation of" were repealed by the Sea Customs (Amendment) Act, 1904 (XVI of 1904).

*mark, and in the same language and character as the name or trade mark.'*

(2) *To Section 18 of the Sea Customs Act, 1878 as amended by sub-Sec. (1), the following shall be added, namely :—*

(f) *piece-goods, such as are ordinarily sold by length or by the piece, which—*

(i) *have not conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece, and*

(ii) *have been manufactured beyond the limits of India, or,*

(iii) *having been manufactured within those limits have been manufactured beyond the limits of British India in premises which, if they were in British India, would be a factory as defined in the Indian Factories Act, 1881.*

11. The following shall be added after Sec. 19 of the Sea Customs Act, 1878, namely :—

“19A. (1) *Before detaining any such goods as are or may be specified in or under Sec. 18 or Sec. 19, as the case may be, or taking any further proceedings with a view to the confiscation thereof under this Act, the Chief Customs officer or other officer appointed by the Local Government in this behalf may require the regulations under this section, whether as to information, security, conditions or other matters, to be complied with and may satisfy himself in accordance with those regulations that the goods are such as are prohibited to be imported.*

(2) *The Governor-General in Council may make regulations, either general or special, respecting the detention and confiscation of goods the importation of which is prohibited, and the conditions, if any, to be fulfilled before such detention and confiscation, and may by such regulations determine the information, notices and security to be given, and the evidence requisite for any of the purposes of this section and the mode of verification of such evidence.*

(3) *Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in the United Kingdom or British India, that name, unless accompanied in equally large and conspicuous letters, and in the same language*

*and character, by the name of the country in which such place is situate shall be treated for the purposes of Secs. 18 and 19 as if it were the name of a place in the United Kingdom or British India.*

(4) *Such regulations may apply to all goods the importation of which is prohibited by Sec. 18 or under Sec. 19, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.*

(5) *The regulations may provide for the informant reimbursing any public officer and the Secretary of State for India in Council all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.*

(6) *All regulations under this section shall be published in the Gazette of India and in the Calcutta, Fort St. George, Bombay and Burma Gazettes."*

These two sections deal with the prohibition and detention by Customs authorities of imported goods bearing false trade marks, false trade descriptions, or false marks of origin.

**Powers of the Collector of Customs.**—The provisions of these two sections and the powers of the Collector of Customs under them were explained in *Nemi Chand v. Wallace*<sup>10</sup> by Harrington J., in the following passage: "By Sec. 18 of the former Act (VIII of 1878) as amended by Sec. 10 of the latter Act (IV of 1889) the importation of goods having applied to them a counterfeit trade mark is forbidden.

By Sec. 19-A (1) of the Sea Customs Act it is provided that before detaining such goods as are referred to under Sec. 18 of the Sea Customs Act or taking further proceedings with a view to confiscation thereof, the Chief Customs Officer may require the regulations under this section to be complied with "and may satisfy himself in accordance with those regulations that the goods are such as are prohibited to be imported." Section 19-A (2) empowers the Governor-General-in-Council to make regulations either general or special respecting the detention and confiscation of goods,<sup>11</sup> the importation of which is prohibited and the condi-

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(10) (1907), 11 C.W.N. 537; 34 Cal. 495.

(11) In *Nemi Chand v. Secretary of State for India*, 34 Cal. 511, it was held that the Collector had power to detain goods bearing counterfeit trade mark or false trade description although no regulations had then been framed by the Governor-General-in-Council under Sec. 19-A of the Sea Customs Act.

tions, if any, to be fulfilled before such detention and confiscation and the Governor-General-in-Council may by such regulations determine the information, notice and security to be given and the evidence requisite for any of the purposes of this section and the mode of verification of such evidence. The regulations provide for the informant reimbursing any public officer and the Secretary of State for India in Council all expenses and damages incurred in respect of any detention made on his information and of any proceedings consequent on such detention. By Sec. 167 (8) goods imported in breach of Sec. 18 are liable to confiscation, and any person concerned in the offence, is liable to penalty. By Sec. 182 cases falling under Sec. 167 (8) may be adjudged by a Customs Collector and by Sec. 188 any person aggrieved by any decision or order passed by an officer of Customs under the Act may appeal to the Chief Customs authority and that authority may confirm, alter or annul the decision or order appealed against. By the same section it is provided that every order passed in appeal under this section shall be final subject to a power of Revision conferred on the Local Government under Sec. 191." The legal effect of the Collector's decision in cases heard by him under these two sections came also for consideration in that case. It was observed that the finding of the Customs authority was not a judicial act and was "not binding upon the plaintiff in the sense that any duty is cast upon him to move the higher executive authorities to set aside. The plaintiff has the right of disregarding this finding altogether so far as his civil rights are concerned and may proceed to sue for redress in a civil court against such parties as the law holds responsible for the injury done to him."<sup>12</sup>

**General exemptions.**—The following classes of goods are exempt from the operation of the Act<sup>13</sup>:—

(a) Goods not having applied to them any trade mark, trade name or trade descriptions or other indications whatever of the nature contemplated in the Act, with the exception of piece goods which require to be stamped under Sec. 10 (2) (f);

(b) "goods imported for the personal use of individuals or private associations of individuals and not for trade purposes. Thus, cloth imported by an individual for his own use or band

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(12) Per Justice Sale in *Nemi Chand v. Wallace* (in the appeal), (1905) 10 C.W.N. 107.

(13) The Merchandise Marks Manual, p. 13.

instruments by a regimental band for the use of the members, are exempt but not rails imported by a railway company, or cutlery and glassware by a hotel.”

(c) Unstamped cotton and woollen piecegoods imported for the personal use of individuals or private association of individuals and not for trade purposes. (Notification No. 1430, dated 6th April 1891).

(d) Goods having applied to them a counter-indication of origin accompanying the name of trade mark. Sec. 18 (c) of the Sea Customs Act.)

**Classification of goods affected by the Act.**—The importation of the following goods is prohibited by Sec. 10 of the Act. (18 (d), (e), (f), of the Sea Customs Act.)

(1) Goods having applied thereto a counterfeit trade mark to indicate that they are the manufacture or merchandise of a person whose manufacture or merchandise they are not.

(2) Goods having applied thereto a false trade description which indicates or is likely to indicate that the goods so marked are those of some other person whose goods they are not.

(3) Goods having applied to them trade descriptions or other indications that are false in respect of the country in which they were made or produced. Under this head three principal classes may be distinguished. (a) Goods made or produced beyond the limits of the United Kingdom and British India and bearing or purporting to bear the name or trade mark of any person who is a manufacturer, dealer or trader in the United Kingdom or British India. Such goods, may, however, be admitted if there is applied to them a counter-indication of origin accompanying the name of the trade mark. (b) Goods made or produced beyond the limits of the United Kingdom and British India, to which is applied a false trade description or indication (other than the name or trade mark of a manufacturer, dealer or trader in the United Kingdom or British India) indicating thereby that they are made or produced in the United Kingdom or British India. (c) Goods made or produced in one foreign country, but bearing a false trade description indicating that they are made or produced in another. In the case of classes (b) and (c) the law does not specifically prescribe that a counter-indication of origin shall remove the restriction as regards importation. Where the description is false by implication only, for instance by the use of

English words, on foreign goods, a counter-indication of the place of origin of the goods may remove the misapprehension and the description may not then constitute a false trade description within the meaning of the Act. Where, however, the description is false in a material respect, for instance when goods are described as the produce of one country of which they are not, no counter-indication can make the description a true one.

(4) Goods having applied to them trade descriptions that are false in other respects.

(5) Piece goods which have not their length properly stamped on each piece.

**Detention of goods.**<sup>14</sup>—Imported goods falling under any of the above classes may be detained by the Customs authority ordinarily on complaint received by the aggrieved party and in rare cases even on their own initiative. The informant is required to furnish the Collector or Chief Customs Officer in writing all necessary details with a notice in Form A.<sup>15</sup> Rule 5 states:—“Upon arrival of the goods, if the Collector or Chief Customs Officer is of opinion that there is clearly no reasonable cause for detention he will permit delivery to the consignee. Otherwise he will detain the goods provisionally and require the informant either:—

(a) to furnish him with an indemnity bond in the form B<sup>16</sup> appended within twenty four hours; or

(b) to deposit security in cash or currency notes to the amount of ten per cent. on the estimated value of the goods to reimburse any expenses incurred or damages awarded in respect of the detention, or of any proceedings consequent thereon, pending the execution of the bond, which in such cases should be furnished within four days.”

“Upon receipt of the bond duly executed the security deposit may be returned. If the indemnity bond or the security as the case may be, be not furnished within twenty four hours, or if the bond following the security be not furnished within four days the Collector will release the goods. If the bond be furnished the Collector will detain the goods for one month from the date of the request for the detention in order to allow of the applicant filing a suit or taking other proper proceedings to have his rights in respect of them declared or ascertained, provided that if he insti-

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(14) Rule 5, Merchandise Marks Manual, p. 15.

(15) See Appendix VII.

(16) See Appendix VIII.

tute a suit or take other proper proceedings for the purpose stated within the period named the goods should be detained until a final decree in the suit or order in the proceedings has been obtained, such decree or order in the case of an appeal being that of the highest Appellate Court to which the appeal is taken. If the applicant does not file a suit or take other proper proceedings as above stated within the period named the goods will be released."

' When information of any definite case of importation or contemplated importation is not available, but the complainant has reason to believe that his marks are being infringed, he may apply to the Customs authorities to keep a watch for possible infringements and orders may be passed by them with a view to take necessary action. Such orders should only have effect for three months but may be renewed on the expiry of the period if the Collector is satisfied that there is reasonable ground for such an extension.

The Customs Officers should not ordinarily detain goods on their own initiative, but may do so only when on examination of the goods it is apparent that an attempt has been made to counterfeit some established mark or other indication such as is well-known to the officers concerned. In such cases the Collector may detain goods for a period not exceeding four days and intimate the local representative of the person whose name or mark appears to be counterfeited with the request that he should take the necessary action as in Clauses (a) and (b) of Rule 5 above, if he desires the detention to continue.

**Procedure upon detention.**—In *Nemi Chand v. Wallace*<sup>17</sup> Mr. Justice Sale observed "In my opinion the provisions of the Sea Customs Act as amended by the Merchandise Marks Act, make it quite clear that the Collector had no power to deal with the question raised by the defendant when once it became apparent that the plaintiffs desired to contest the defendant's claim. It was his duty then to have held his hand and to have detained the goods on being properly indemnified until the question was properly disposed of in a competent civil court. Sec. 19-A doubtless impliedly vests the Collector with a certain power of enquiry where it is alleged that goods are being imported bearing a counterfeit trade mark. But this enquiry is to be made in accordance with the regulations made by the Governor-General in Council respecting the detention and confiscation of goods the importation of which is

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(17) (1907) 11 C.W.N. 537; 34 Cal. 495.



prohibited. . . . The enquiry which the Collector is to make must necessarily be of a most limited character, for the Act does not empower him to summon witnesses or to take evidence. . . . it is clear that the Collector's power of enquiry is intended only, to enable him to satisfy himself that the counterfeit is plain and manifest and that there can be no real contest in the matter. For any purpose beyond this the Collector's duty is to detain the goods until the question of title is settled by a competent civil court." Ordinarily the Collector should not, therefore, take proceedings under the Sea Customs Act "for the confiscation of goods detained under the above rules, or for the imposition of a penalty, upon his own responsibility, except in the following cases, namely, when the marks on the goods are admitted by the importer to be objectionable either as counterfeit trade marks, or as being of the description stated in Sec. 4 (1) and (2) of the Indian Merchandise Marks Act, or when the Collector or Chief Customs Officer is satisfied by the production of a duly certified copy of an order by a competent court that they have been declared by such a competent court either in British India or in the United Kingdom to be so objectionable, and provided that in this case no claim is made on behalf of the importer of a right to use the marks upon grounds not covered by the order cited. If such a claim be made the procedure laid down in Rule 5 should be followed in respect of the importation."<sup>18</sup>

**Counter-indication of origin on goods.**—The nature of the counter-indication required in order to enable certain goods to be imported is specifically provided under Sec. 18 (a) of the Sea Customs Act. The section lays down that the name or trade mark must be accompanied by a definite indication of the goods having been made or produced in a place beyond the limits of the United Kingdom and British India. Also, the country in which that place is situated must be indicated in letters as large and conspicuous as any letter in the name or trade mark and in the same language as the name or trade mark. Rule 25 states, however, that the size of the letters need not be rigidly insisted upon, provided that they are sufficiently conspicuous to catch the eye along with the trade mark or false trade description. The counter-indication should be adjacent on the same label to which the false trade mark or trade description is applied. It should not be on a separate label nor otherwise detachable from the trade mark or description itself. Where the trade mark or trade description is in different languages

or characters the counter-indication should be repeated in each of the languages employed.

The following classes of goods are, however, exempt from the above provisions requiring a counter-indication of the place of origin.

(a) "Indian produce and manufactures imported by sea from foreign Indian ports into British India and bearing the name or trade mark of a British Indian trader or dealer."

(b) "Goods bearing the name or trade mark of a British Indian trader or dealer which are known or proved to be the produce of Africa, Arabia, Persia, or Turkey in Asia with the exception of manufactured articles such as carpets, earthen ware, shawls, and silken or woollen goods."<sup>19</sup>

(c) "Coverings or labels (as defined in Sec. 5 (3) of the Indian Merchandise Marks Act) made in a foreign country bearing the name of a British Indian manufacturer, dealer or trader, where the name is intended to refer not to the covering or label, but to the goods to be covered or labelled, and is the name of a firm who have ordered the covering for their own goods. Examples:—Cardboard boxes made in Germany bearing the name, trade mark or advertisements of, and imported by, a British Indian Soap Manufacturing Company to hold soap of their own manufacture; labels made outside the United Kingdom or British India bearing the name of, and imported by, a British Indian Chemist to be attached to phials, boxes, etc., for dispensing purposes; photograph mounts made in a foreign country bearing the name and imported by a photographer in British India to be attached to his own photographs."<sup>20</sup>

**Use in a trade description of Indian vernaculars.**—By Rule 33 (1) "words in any Indian language, or letters or numerals in Indian character, or marks or devices, such as representations of Indian deities or emblems, which are reasonably calculated to lead persons to believe that the goods were made or produced in British India require counter-indications on the same principle when applied to goods made or produced beyond the limits of British India.

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(19) A list of such goods will be found in Appendix IX.

(20) The Indian Merchandise Marks Manual, (1930) Rule 15.

Note (1):—An indication of the country of origin should not be insisted on when the only vernacular characters employed are the equivalent of numerals used as quality numbers.

Note (2):—British goods, (*e.g.*), piece-goods bearing trade descriptions such as “very good quality,” “Best-cloth” “Very best borders,” “Fast colour,” etc., in vernacular characters, or bearing tickets with representations of Indian deities and mythological scenes with their names in vernacular characters, in conjunction with the name or trade mark of a British or British Indian firm, should be passed without any counter-indication of origin. Such counter-indications should be insisted on only where such expressions as “Swadeshi,” “Bande Mataram” “Cawnpore shoes” are used, which apart from being in a vernacular character definitely indicate from their meaning that the goods were manufactured in India.”

**Identical names of places.**—Where there is on any goods a name which is identical with or a colourable imitation of a place in British India or the United Kingdom, the name should be accompanied by a counter-indication in large and conspicuous letters of the country in which the place is situate. Otherwise the name shall be taken for the purposes of these sections as if it were a place in British India or the United Kingdom. Example:—Cambridge United States should be accompanied by “United States” or “U.S.A.”

**Laws relating to marks of origin on goods in other countries.**—It may be instructive in this connection to examine the Laws in foreign countries which deal with the prohibition of goods bearing false marks of origin. The measures adopted for these purposes in various countries are not uniform and may be considered under the following heads:—(1) Countries where there is statutory enactment prohibiting false marks of origin:—In some of these the law is applicable only against direct indication of a false place of origin, while in others even marks which are likely to mislead the customers regarding the place of origin of the goods are dealt with. In these countries no mark of origin is, however, necessary in the case of goods which do not bear any description at all. Some examples of countries belonging to this class are Denmark, Germany, Great Britain, India, Italy, Norway, Austria, and Switzerland.<sup>(21)</sup> (2) Countries where the law is directed to prohibition of goods bearing marks wrongly suggesting that such goods

(21) Memorandum on “Marks of origin” published by the Economic and Financial organisation of the League of Nations, Geneva, 1927.

are of domestic origin :—In these countries it is not obligatory that all imported goods should have marked on them their country of origin. Goods without any description may be imported without any mark of origin. The law is applicable only in the case of goods which bear a mark wrongly suggesting that they are of *home manufacture* as in cases where the trade mark or name of a home manufacturer appears on the goods or where the description on the goods is in the home language. We have already pointed out the state of law in India in this respect. Some examples of countries having regulations of this nature are the Australian Commonwealth, France, Roumania and Sweden. It may be pointed out that in some of these countries a false indication of a foreign origin does not matter. In France, for example, the law does not prohibit the importation of goods manufactured in Japan but shown as made in Germany. Such description would be however, a false trade description in India. (3) Countries where indication of the place of origin of imported goods is compulsory :—In certain countries such as the United States of America and the Argentine Republic, the law requires that all imported goods should be marked with their place of origin. The only exceptions are in cases where such marking is impossible for technical reasons, or where the value of the goods may be detrimentally affected by such marking or where such marking is contrary to trade practice. (4) Countries where the compulsory indication of the place of origin is restricted to certain classes of goods, such as medicines, food-stuffs, etc. (5) Countries where the place of origin should be indicated even on home made goods, and (6) Countries where the marking of the place of origin is restricted to home-made goods intended for export.

Before concluding this section reference may also be made to the efforts which have been made to secure uniformity of regulations relating to marks of origin. These led to the International Convention of Paris of 1883 and the Madrid Agreement of 1891. The Conventions provide for the seizure by the Customs authorities on importation into any of the contracting states goods bearing false marks of origin. Unfortunately, India is not a member of either of these Conventions.

#### VI.—*Stamping of Length of Piece-Goods Manufactured in British India.*

By Section 12 of the Act—

(1) *Piece-goods, such as are ordinarily sold by length or by the piece, which have been manufactured in premises which are*

*a factory as defined in the Indian Factories Act, 1881, shall not be removed from those premises without having conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece.*

*(2) If any person removes or attempts to remove any such piece-goods from any such premises without the length of each piece being stamped in the manner mentioned in sub-Sec. (1), every such piece, and everything used for the packing or removal thereof, shall be forfeited to Her Majesty and such person shall be punished with fine which may extend to one thousand rupees.*

Section 19 of the Act defines piece-goods—

*“For the purposes of Sec. 12 of this Act and Clause (f) of Sec. 18 of the Sea Customs Act, 1878, as amended by this Act, the Governor-General in Council may, by notification in the Gazette of India, declare what classes of goods are included in the expression ‘piece-goods such as are ordinarily sold by length or by the piece’.”*

By Section 10 (2) of the Act, (Sec. 18 of the Sea Customs Act) the Customs authorities may detain unstamped piece-goods which have been manufactured beyond the limits of India or having been manufactured within those limits have been manufactured beyond the limits of British India in premises, which, if they were in British India would be a factory as defined in the Indian Factories Act of 1881.

A factory is defined in Sec. 2 of the Indian Factories Act as follows :—

*“Factory” means any premises (other than indigo factories or premises situated on, and used solely for the purposes of, a tea or coffee plantation) wherein is carried on, for not less than four months in the whole in any one year, any process for, or incidental to, making, altering, repairing, ornamenting, finishing or otherwise adapting for use, transport or sale, any article or part of an article; and*

*(a) wherein steam, water or other mechanical power is used in aid of any such process, and*

*(b) wherein subject to the provisions of Sec. 20, not less than fifty persons are on any day simultaneously employed in any manual labour in, or incidental to, any such process; and every part of a factory, except any part used exclusively as a dwelling.”*

Clause (b) was substituted by the Indian Factories Act, 1891 (XI of 1891), for the original clause which ran as follows:—

“Wherein not less than one hundred persons are on any day simultaneously employed in any manual labour in, or incidental to, any such process.”

By Section 20 of the Indian Factories Act, the Local Government is empowered to extend the definition of factory. The section runs:—

“Section 20. (1) Notwithstanding anything in Clause (b) of the definition of the word ‘factory’ in Sec. 2, the Local Government may from time to time, by notification in the official gazette, declare any premises, or premises of any class, which fulfil the other conditions of the said definition, to be a factory for all the purposes of this Act, or for such of those purposes as may be specified in the notification, if the number of persons simultaneously employed in the premises on any day in any manual labour in, or incidental to, any such process as is referred to in the said Clause (b) is less than fifty and not less than twenty.

(2) The Local Government may, by such notification, fix any number below fifty and not below twenty as the number of persons whose simultaneous employment as aforesaid is to be held to subject premises, as a factory, to all or any of the provisions of this Act and of the orders and rules made thereunder.”

Piece-goods made in foreign countries shall be detained on importation by the Customs authorities unless such goods have conspicuously stamped in English numerals on each piece the length thereof in standard yards. By notification No. 430, dated 6th April, 1891, the prohibition extends to “piece-goods such as ordinarily sold by length or by the piece.” These are defined as including cotton and woollen piece-goods of all kinds, excepting certain descriptions such as blankets, blind cloth, book-binding cloth, cloth cut in pieces, carpets (in rolls), dusters in woven pieces, filter cloth, hand-kerchiefs in woven pieces, Madras muslin cloth, pillow calico (tubular) quilts, rugs, shawls (finished) with ends hemmed or fringed imported singly or in pieces containing two or more shawls, towels in woven pieces, woollen knitted cloth, etc. The Collector shall not detain any unstamped piece-goods which, though not included in this list of exemptions, would be liable, if stamped, to serious depreciation in value. Unstamped piece-goods imported for personal wear are also exempted.

Goods which are not made of cotton or woollen material, such as silk or velvet are not classified as piece-goods and are exempt from the application of Sec. 18 of the Sea Customs Act. "Alpaca should be treated as wool, and cotton mixed with silk, or wool mixed with silk, as cotton and woollen respectively, provided that the cotton or the wool is in each case a material constituent of the fabric. Cotton remnants or cut lengths measuring less than 15 yards are not in current ordinary practice sold by length or by the piece. Sec. 18 (f) of the Sea Customs Act does not therefore apply to them. Similarly, that clause does not apply to "fents" regardless of their length, which are so defective owing to accidents in the weaving, dyeing or printing that they are not ordinarily capable of being sold by length or by the piece. . . . Goods to be liable to stamping must have been manufactured either beyond the limits of India or if in India, then in territories beyond the limits of British India, and on premises which, if in British India, would be a factory under the Factories Act. Thus goods manufactured in a factory at Bhavnagar, one of the Native States of Kathiawar, might be liable, whereas those manufactured on a handloom in the same place would be exempt."<sup>22</sup> The stamping should be conspicuous and in a different colour from that of the fabric. It should not be on a removable label or ticket, but should be on the fabric itself. The marking should be such as will not ordinarily be removable except by washing the fabric, or, in the case of goods that are not ordinarily washed, it should be of such a nature that it is not likely to be obliterated in the ordinary course of handling before the goods reach the purchaser. Marks which are stitched on the fabric and are easily removable by cutting are not permitted.<sup>23</sup>

## VII.—SUPPLEMENTAL PROVISIONS.

### (i) *Evidence.*

Section 13 of the Act deals with evidence of origin of goods imported by sea, and corresponds to Sec. 10 (2) of the British Statute. It runs:—

*"In the case of goods brought into British India, by sea, evidence of the port of shipment shall, in a prosecution for an offence against this Act or Sec. 18 of the Sea Customs Act, 1878,*

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(22) Rule 59, Merchandise Marks Manual, 1930.

(23) Rule 60, Merchandise Marks Manual, 1930.

*as amended by this Act, be prima facie evidence of the place or country in which the goods were made or produced."*

This section is explained by Rule 12 of Part III of the Merchandise Marks Manual, which states:—"This ruling, however, should be applied with discretion when the port of shipment is a place of transit from some inland country like Rotterdam or Antwerp with respect to Germany, or Trieste with respect to Italy or Switzerland. In the case of goods shipped from these ports, the statement that the goods are the make or produce of an inland country may be accepted if there is no reasonable ground to suspect the country of origin."

(ii) *Costs of defence or prosecution.*

Section 14 of the Act reads:—

*"(1) On any such prosecution as is mentioned in the last foregoing section, or on any prosecution for an offence against any of the sections of the Indian Penal Code, as amended by this Act, which relate to trade, property and other marks, the Court may order costs to be paid to the defendant by the prosecutor or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively.*

*(2) Such costs shall, on application to the Court, be recoverable as if they were a fine."*

In ordinary criminal cases the accused is not entitled to costs when acquitted nor is he required to pay costs to the prosecutor if he is convicted. But in respect of these special offences the court may order costs to be paid to the defendant by the prosecutor or to the prosecutor by the defendant.

(iii).—*Limitation of prosecution.*

Section 15 of the Act prescribes the period of limitation of prosecution, and corresponds to Sec. 15 of the English Statute of 1887. The section reads:

*"No such prosecution as is mentioned in the last foregoing section shall be commenced after the expiration of three years next after the commission of the offence, or one year after the first discovery thereof by the prosecutor, whichever expiration first happens."*



The purpose of this section was clearly explained in an early Madras case<sup>24</sup> by Sir Arthur Collins, C. J., and Benson, J. Their Lordships observed: "Ordinarily the infringement of a trade mark is rather a civil than a criminal wrong, but as civil proceedings may require much time and expenditure to bring them to a conclusion, the Legislature, in its anxiety to protect traders, has allowed resort to the criminal courts to provide a speedy remedy in cases where the aggrieved party is diligent and does not by his conduct show that the case is not one of emergency. If, therefore, the person aggrieved fails to resort to criminal courts within a year of the offence coming to his knowledge, the law assumes that the case is not one of urgency, and it leaves him to his civil remedy by an action for an injunction."

The construction of this section is not free from difficulty. The particular point which has been the subject of discussion by several of the courts is whether the word "offence" as used in the section means the specific offence alleged in the charge or the first of a series of offences where the offence is a continuing one. A number of cases dealing with this section are discussed below.

**Ruppel v. Ponnusami Tevan.**—In *Ruppel v. Ponnusami Tevan*<sup>25</sup> the complainants (McDowel & Co., Madras) were selling cigars since 1886 under the trade mark "Bahadur". They discovered in 1893 that the accused had been selling cigars with the trade mark "Rai Bahadur" packed in a manner and box similar to theirs. The accused were then called upon to discontinue the use of the said alleged counterfeit trade mark and to render an account of the sales. The right to proceed further was reserved by the complainants but no action was taken. In 1898, upon its being ascertained that the counterfeit trade mark was still being used, the prosecution was commenced. The prosecution was held to be time-barred as the petitioners knew of the infringement of their mark by the accused for five years and had not taken any effective steps to stop it. Sir Arthur Collins, C. J., and Benson, J., said: "It is perfectly clear that the petitioners were aware of the alleged infringement so long ago as 1893, and there is nothing to lead us to conclude that they believed that the manufacture was discontinued and was lately revived."

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(24) *Ruppel v. Ponnusami Tevan*, (1899) 23 Mad. 488.

(25) *Loc. cit.*

**Mahomed Jeva v. Wilson.**—*Ruppel v. Ponnusami Tevan* was followed in *Mahomed Jeva v. Wilson*.<sup>1</sup> The accused had been twice before prosecuted in 1908 and 1910 under Sec. 482, Indian Penal Code, for selling oil not manufactured by the Burma Oil Co., in second hand tins of that company and was acquitted on both occasions. A third complaint was then filed alleging the commission of a fresh offence by the accused in July 1910. It was held that the complaint was barred under Sec. 15 of the Act. Twomey, J., said: "If criminal proceedings are not taken within the time limited by the section the owner of the trade mark shall be left to the ordinary civil remedy of an injunction. The intention of the Legislature will be frustrated if it is held that the owner of a trade mark can stand by for several years while his trade mark is being infringed continuously and then bring a criminal complaint in respect of some recent instance in which there has been infringement. To interpret the section in that way would reduce its provisions to a nullity for it would entirely remove the bar of limitation except in cases where the series of infringements has actually ceased." His Lordship laid stress on the words "first discovery" in the section. "The words 'first discovery' cannot reasonably be applied to the last of a long series of similar offences extending without interruption throughout several years to the knowledge of the prosecutor. In my opinion, they can refer only to the first offence of the series which comes to his knowledge."

**Akhoy Kumar Dey v. Emperor.**—In *Akhoy Kumar Dey v. Emperor*<sup>2</sup> the accused was convicted under Sec. 486, Indian Penal Code, for selling gold bars with a counterfeit trade mark. The prosecution was launched within a month after the first discovery of the fraud by the National Bank of India who were the complainants. It was contended that the sale of gold bars under the counterfeit mark had continued for many years, and that no action should lie as the bank had not taken any action within the statutory period of limitation from the first infringement. Chotzner, and Gregory, JJ., held that the words "first discovery" meant when the complainant first discovered that offence and that action might be taken within a year from that time. As regards the meaning of the word "offence" used in this section, their Lordships were of

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(1) (1911) 4 Bur.L.T. 83; 10 I.C. 787; 12 Cr.L.J. 246. See also *Abdul Majid v. Emperor*, A.I.R. 1917 L.B. 149; 17 Cr.L.J. 488.

(2) A.I.R. 1928 Cal. 495; 32 C.W.N. 699.

opinion that it meant the specific offence charged, and that it could not refer to the first infringement. "If it had meant only the infringement of the trade mark we think that the section would have said so." It therefore makes no difference at all whether the original infringement took place "three or five or ten years ago."

**Muhammad Ahmad v. Venkanna.**—The above interpretation has been approved in *Muhammad Ahmad v. Venkanna*.<sup>3</sup> The accused was charged under Sec. 486, Indian Penal Code, for selling counterfeit "Otto Dilkush Ranjam" scent, and it was admitted by some of the prosecution witnesses that the accused had been using the mark in question for over four years. Referring to the judgment of the Lower Court Mr. Justice Jackson said: "The learned Sessions Judge . . . reads Sec. 15 as saying that the starting point for limitation is the termination of three years from the date of the first offence; meaning thereby the first of a series of offences, or, in this case the first sale of a bottle of this scent. But there is nothing about a series in Sec. 15, of Act IV of 1889 nor in Sec. 486, Indian Penal Code. In fact Sec. 486 specifically confines the offence to selling a thing, "goods or thing." The prosecution is within time if launched within three years of the specific offence complained against."

**Nagendra Nath Saha v. Emperor.**—In *Nagendra Nath Saha v. Emperor*<sup>4</sup> the complainant first came to know of the infringement of his star brand for "biris" by the accused in September 1927. The latter gave an undertaking that he would cease using the counterfeit mark, but nevertheless continued to use the mark. The complainant proved to the satisfaction of the court that he did not become aware of a fresh infringement before June 1928. The present case was brought in March 1929. It was contended that the limitation must run from the original discovery in September 1927. On behalf of the Crown it was argued that if that contention was right, then the first undertaking given by the accused would be meaningless, and that the complainant would be put upon his watch to see whether there was going to be another infringement within one year of the first discovery. It might then be that if the subsequent infringement was committed one year after the original discovery, the second offence would not be punishable at all. Ghosh, J., distinguished this case from *Ruppel v. Ponnusami*

(3) (1930) A.I.R. 1931 Mad. 276.

(4) (1929) A.I.R. 1930 Cal. 274; 57 Cal. 1153.

*Tevan*, where the complainant had not shown that he believed that the alleged counterfeit trade mark had been discontinued after the first discovery in 1893. The meaning given by the court in *Akhoy Kumar Dey v. Emperor*<sup>5</sup> for the word "Offence" in this section as the offence charged was accepted as the only common sense view. The prosecution, therefore, was held to be clearly within the time and the appeal was dismissed.

The interpretation of Sec. 15 of the Merchandise Marks Act again came up for consideration in *Aswini Kumar Pal v. Emperor*.<sup>6</sup> In that case Pearson, and Patterson, JJ., observed that this section was designed to prevent stale claims from becoming the subject-matter of criminal prosecution and could not apply to a case where the offence was a continuing one.

**Sind cases.**—In *Jugan Nath v. Emperor*<sup>7</sup> the conviction of the accused under Secs. 452 and 456, Indian Penal Code, was set aside on appeal on the ground that the suit was time-barred under Sec. 15 of the Act. Pratt, J. C., observed: "The Magistrate has dealt with the question of limitation within one year of the first discovery, but has not considered whether the prosecution has been filed within three years of the first offence. The expression 'first offence' must be construed as the first offence of the series..... If the words 'first offence' were applied to the most recent instance of the use of a false trade mark it would be open to the party aggrieved to stand by for years and then take action and this construction would render the provision of law as to limitation entirely nugatory."

The decision in the above case was discussed in *Sirumal v. Emperor*<sup>8</sup> by Mehta, A. J. C., who observed that the ruling given by Pratt, J. C., was not in accordance with the correct interpretation of Sec. 15 of the Act. "Had the Legislature intended that the period of three years should determine the limitation for a prosecution as from the very first use of a false trade mark we would have expected to find the word 'offence' qualified by the word 'first' just as in the case of the discovery of the offence by the prosecutor." The interpretation of the word 'offence' in the section as meaning the very first of the series of the offences was accordingly rejected. "If such an interpretation of the section be good law a person infringing another's trade mark may merely do once clande-

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(5) A.I.R. 1928 Cal. 495; 32 C.W.N. 699.

(6) (1930) A.I.R. 1930 Cal. 728; 34 C.W.N. 524.

(7) 10 S.L.R. 45.

(8) (1932) A.I.R. 1932 Sind 94; 26 S.L.R. 241.

stinely, sit quiet for three years and then make a public use of it without any fear of a criminal prosecution. In that case the provision in the section about the first discovery of the use by the prosecutor would be meaningless."

**Bombay cases.**—In *re Abdul Satar Khan Kamruddin Khan*<sup>9</sup> the accused was convicted by the Magistrate under Sec. 482, Indian Penal Code, for using falsely the property mark of the complainant. The prosecution was launched within a year of the discovery of the specific offence charged, but in the course of the trial it was admitted by the complainant that he had come to know of the infringement of the property mark by the accused more than a year before that particular offence. It was alleged by the complainant that after discovering the infringement of his property mark he sent a notice to the accused and that the accused promised to discontinue the use of it. But there was no proof of such discontinuance and there was no documentary evidence to show that there was any discontinuance by the accused at all. It was held that the prosecution was time barred. Broomfield, J., said that "where the offence of infringement of a trade or property mark is a continuing one, and no discontinuance is proved, time runs under Sec. 15 from the first instance of infringement, or from the first discovery of infringement." The above interpretation has been held to be wrong by the full Bench of the Bombay High Court in a recent case.<sup>9a</sup> A manufacturing chemist was charged with selling "Sanghavi's Gripe Mixture", the bottle, wrapper and label of which were a colourable imitation of "Woodward's Celebrated Gripe Mixture". The prosecution was launched within a year from the discovery of the offence charged, but the accused contended that he had been using the getup complained of for over three years and that the suit was accordingly time-barred. It was ruled by the full Bench that in all cases the starting point of limitation under Sec. 15 was the date of the offence charged.

**Section explained.**—The above decisions show that there is an apparent conflict of opinion among the Courts regarding the construction of the word 'offence' in this section, where the infringement is a continuing one. The two interpretations which have been suggested for this word are: (1) the first of the series of offences and (2) the specific offence charged. The words 'thereof' in the section makes it clear that the words "commission"

(9) A.I.R. 1935 Bom. 359; 59 Bom. 551.

(9a) *Chhotalal Amarchand v. Griffiths & Co.*, "The Times of India", 3rd Sep. 1936; "The Statesman", 4th September 1936.

and "discovery" refer to the same offence. It is submitted that the correct interpretation is that where the offence of infringement of a trade mark is a continuing one the word 'offence' as used in the section means the specific offence alleged in the charge. The period of limitation should apply from the date on which the offence charged was committed, or was first discovered by the complainant, whatever be the date on which the infringement of the complainant's mark was first committed by the accused. Action may be taken within a year from such discovery of the offence, provided three years have not elapsed after the commission of the offence charged. But for prosecutions under the Act the complainant is expected to show that he had acted with due diligence as soon as the infringement of his mark came to his notice. The recourse to the criminal courts is provided only because it is a speedy remedy, and the person aggrieved is entitled to such remedy only if he seeks this protection within a reasonable time after the infringement. The owner of a mark, for instance, cannot stand by for several years although he is aware that his mark is being continuously infringed and then bring a criminal case in respect of any particular recent infringement whenever it suits him to do so. As soon as he becomes aware of any infringement of his trade mark he must take effective steps to stop the infringement, though it is not necessary that he should always charge the infringer under the Merchandise Marks Act. Without going to the Court he may obtain an undertaking from the infringer that he would cease using the counterfeit mark. If there is a fresh infringement after the accused had given such an undertaking the complainant can prosecute the accused under the Merchandise Marks Act, provided the prosecution is commenced within a year after the complainant's discovery of the fresh offence and provided three years have not elapsed from the commission of the offence charged. The fact that the complainant was aware of the first infringement of his mark by the accused more than a year ago would not in such cases constitute a valid defence.

For the sake of convenience the important types of cases under this section may be classified as follows:—

(1) Where there is a single case of infringement of the mark the prosecution must be commenced within three years next after the commission of the offence and one year after the first discovery thereof by the prosecutor, whichever expiration first happens.

(2) Where there is a series of cases of infringement by the accused, time will run under Sec. 15 from the first discovery of

the offence by the prosecutor, and not from the date of the first infringement of the mark. The prosecution may be commenced within a year after such discovery, provided three years have not elapsed from the commission of the offence charged.

(3) Where the complainant has had knowledge of the continuing infringement of his mark by the accused and had not taken any effective steps to stop the infringement the period of limitation for prosecution under Sec. 15 will count from the date of the first discovery of the infringement by the prosecutor. Where more than a year after such discovery has elapsed, the prosecution will be barred and the complainant cannot bring a charge against the accused in respect of any specific instance of infringement which might have happened recently and commence the prosecution within a year from the commission of that recent infringement.

(4) Where the complainant satisfies the court that he had taken effective steps, legally or otherwise, to stop the infringement as soon as he became aware of it, and that he had sufficient cause to believe that the accused had ceased to infringe his mark as a result of those measures, the period of limitation will commence, in case of a fresh infringement by the accused, from the first discovery of the fresh offence. The prosecution will not be barred if started within a year after the discovery of the subsequent infringement and if within three years after the commission thereof.

It may be noted here that the period of limitation laid down in Sec. 15 applies only to criminal cases under the Act. The fact that one year had already elapsed since the discovery of the offence charged is no bar to a civil suit for claiming compensation. The period of limitation as regards civil cases is prescribed by the Indian Limitation Act (Act IX of 1908). Where there is a series of infringements of the trade mark the owner of the mark can sue in respect of every infringement of the mark, provided the mark has not become *publici juris*.<sup>10</sup>

(iv) *Instructions as to administration of the Act.*

By Section 16—

“(1) *The Governor-General in Council may, by notification in the Gazette of India and in local official Gazettes, issue instructions for observance by criminal courts in giving effect to any of the provisions of this Act.*

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(10) *Aga Mahmood v. Edward Peltzer*, (1903) 2 L.B.R. 113; *Abdul Salam v. Hamidullah*, (1912) 97 P.R. 1913; 15 I.C. 116.

(2) *Instructions under sub-Sec. (1) may provide, among other matters, for the limits of variation, as regards number, quantity, measure, gauge or weight, which are to be recognized by Criminal Courts as permissible in the case of any goods."*

In exercise of the powers conferred by this section these instructions were published in order No. 1474, dated the 13th November, 1891. The permissible limits of variations according to these instructions have already been mentioned under Sec. 11 (2). Such instructions facilitate the administration of the Act and give traders and dealers precise ideas as to offences under the Merchandise Marks Act.

(v) *Implied warranty on sale of goods.*

Sec. 17 of the Act reads:—

*"17. On the sale or in the contract for the sale of any goods to which a trade mark or mark or trade description has been applied, the seller shall be deemed to warrant that the mark is a genuine mark and not counterfeit or falsely used, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the seller and delivered at the time of the sale or contract to and accepted by the buyer."*

When any goods to which a trade mark or mark or trade description is applied the seller shall *prima facie* be deemed to warrant that the mark or description which is applied is genuine. The section requires that where the mark or description is not genuine the fact should be expressed in writing at the time of the sale or contract by the seller or his duly authorized agent. Such written statements should further have been delivered to and accepted by the buyer. A mere verbal statement regarding the falsity of the marks at the time of the sale or contract would not suffice.

This section corresponds to Sec. 17 of the English Act. The statutory warranty is in addition to what is already available under the common law. If a man is a manufacturer and not a mere vendor it is presumed that he supplies goods of his manufacture and not those of others. Thus, in *Starey v. Chilworth Gunpowder Co.*,<sup>11</sup> the presence of the name of the company on the barrel was an implied warranty. The company could have expressed the contrary by stating to the purchaser in writing at the

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(11) (1880) 24 Q.B.D. 90.



time of the sale that the powder supplied was not of their manufacture.

The provision of implied warranty will enable an innocent purchaser to recover damages from a vendor when the goods are subsequently forfeited or their possession has resulted in criminal prosecution under the Merchandise Mark Act. Conversely, a manufacturer can recover damages from his customer when in pursuance of a contract the goods are supplied with a mark which afterwards turns out to be a false mark resulting in forfeiture of the articles and criminal prosecution for false marking.

The proprietors of a trade mark "Cathedrale" for herrings brought an action against B.B. & Co., and one W. Bruce for infringement of their mark. It appeared that W. Bruce had supplied B.B. & Co., with cases of herrings bearing the infringing trade mark "Cathedrale." In the action an injunction was ordered against both defendants with costs. B.B. & Co., served a third party notice on William Bruce claiming an indemnity from him in respect of the action. In the third party proceedings it was held that W. Bruce had warranted that the trade mark was genuine and had not been falsely applied and was under an obligation to indemnify B.B. & Co., against the costs of the action under Sec. 17 of the English Merchandise Marks Act.<sup>12</sup>

#### (vi) Savings.

By Section 18 of the Act—

"(1) *Nothing in this Act shall exempt any person from any suit or other proceeding which might, but for anything in this Act, be brought against him.*

(2) *Nothing in this Act shall entitle any person to refuse to make a complete discovery or to answer any question or interrogatory in any suit or other proceeding, but such discovery or answer shall not be admissible in evidence against such person in any such prosecution as is mentioned in Sec. 14.*

(3) *Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in British India who in good faith acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master and as to the instructions which he has received from his master."*

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(12) *Pidoux & Cook v. Benekendorff Berger & Co., and Bruce; Benekendorff Berger & Co. v. Bruce*, (1913) 31 R.P.C. 65. (The false description was applied after sale and before delivery).

A person whose trade mark has been infringed can institute criminal proceedings against the infringer under the Merchandise Marks Act and he may also proceed against the same person in a civil court for passing-off action. Sub-Clause (1) provides that a conviction under the Merchandise Marks Act does not relieve the defendant from any civil proceedings for passing-off action. Sub-Clause (3) is important, and should be read in conjunction with Sec. 8, of the Act. The purpose of this clause is to exempt from criminal liability a servant who in obedience to the instructions of his master carries out in good faith acts which would ordinarily constitute an offence under the Merchandise Marks Act. The person should in such case have given full information as to his master and as to the instructions which he has received from his master.

**English Act compared.**—It may be noted here that there is no clause in the Indian Act corresponding to Sec. 2 (1) (f) of the English statute which lays down that a person who “causes any of the things above in this section mentioned to be done, shall, subject to the provisions of this Act and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.” Section 6 of the English Statute also refers to an offence under the Act by “causing any of the things in this section mentioned to be done,” while the expression “causing, etc.,” is absent in the corresponding Sec. 8 of the Indian Act. It is desirable to insert these clauses in the Indian Act so as to bring it in line with the corresponding English Statute. The absence of a specific reference in the Indian Act to the person causing the offence does not, however, exempt a master from criminal liability for acts done by his servant in contravention of the Indian Merchandise Marks Act.<sup>13</sup> In effect, the law is the same as in England and a person who authorises or procures or abets the commission of a criminal act can be convicted of the offence. Indeed, the master may be liable for the servant’s act even where such acts have been unauthorised or forbidden.

The general principles of law applicable to cases of this nature are stated in Halsbury’s Laws of England<sup>14</sup> thus: “The condition of mind of a servant or agent is not imputed to the master or principal so as to make him criminally liable. A master is not criminally liable because his servant or agent commits a negligent

(13) See for instance, Sec. 22 which deals with punishment of abetment in India of acts done out of India.

(14) Vol. IX, p. 235.

or malicious or fraudulent act. But in cases where a particular intent or state of mind is not of the essence of the offence, the acts or default of a servant or agent in the ordinary course of employment may make the master or principal criminally liable, although he was not aware of such acts or defaults, and even where they were against his orders.”

The principle of “vicarious criminality” has been applied in England in a number of cases under the Merchandise Marks Act, the Sale of Food and Drugs Act, 1875, and in cases under the Licensing Act of 1872. A few of the important English and Indian cases are discussed below.

**Coppen v. Moore.**—The leading English case is *Coppen v. Moore*.<sup>15</sup> The defendant carried on extensive business as provision dealer. In one of the branches of this firm the complainant asked for English ham. The salesman pointed to a number of hams on the shelf, and said they were Scotch hams, though, in fact, they were American hams. The complainant then bought some ham. The assistant at first made out an invoice without the word “Scotch” on it. The complainant did not accept it so written, but asked the assistant to insert the word “Scotch,” ‘as he had bought it as such’. The assistant then did so. Thereupon, the complainant asked the salesman and the assistant whether they still said it was a Scotch ham and both of them admitted that it was not Scotch ham but was an American ham. On the part of the appellant evidence was given that Mr. Coppen had sent a notice to all his branch places of business including the one in question, instructing the assistants most explicitly that the hams described in the list should not be sold under any specific name of place or origin, but simply as “Breakfast hams.” The appellant stated that he had no reason to believe that his instructions were not being carried out. It was held that the appellant was guilty of commission of an offence of using a false trade description under the English Merchandise Marks Act.

The law relating to the criminal liability of the master for acts done by his servant in the course of his employment was very ably

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(15) (No. 1) (1898) 2 Q.B. 300; (No. 2) 1898, 2 Q.B.D. 306. See also *Grierson, Oldham & Co., Ltd. v. Birmingham Hotel and Restaurant Co., Ltd.*, (1901) 18 R.P.C. 158, where a limited company was held responsible for the misrepresentation of its servants, though they were acting contrary to orders. See also *Cusenier fils, Aine, et. Compagnie* and *George Idle Chapman & Co., Ltd. v. Gaiety Bars & Restaurant Co., Ltd.*, (1902) 19 R.P.C. 357; *Havana Cigar and Tobacco Factories, Ltd. v. Tiffin*, (1905), *Ld.*, (1909) 26 R.P.C. 473; *Bovril, Ltd. v. Bodega Co., Ltd.*, (1916) 33 R.P.C. 153.

and fully discussed in the above case by Russell, C. J., in the following judgment: "It was admitted that the description 'Scotch ham' was trade description, and it was found that it was applied to the ham sold by the appellant's employees, and it was admittedly false. It was not contended that it was not material. In these circumstances it is clear that an offence against the Act was committed by the salesman and by the assistant of the appellant. But the question which the court is now called upon to decide is whether the appellant is also not primarily liable to be convicted. . . . The appellant's contention was that the charge here preferred was a criminal charge, and that the general principle of law applied—'*nemo reus est nisi mens sit rea.*' There is no doubt that this is the general rule, but it is subject to exceptions, and the question here is whether the present case falls within the rule or within the exception. Apart from statute exceptions have been engrafted upon the rule; for example, in the case of *R. v. Stephens*<sup>16</sup> the defendant was held liable on indictment for obstructing navigation by throwing rubbish into a river from a quarry owned by the defendant but managed by his son, although it was proved that the men employed at the quarry had been by order prohibited from doing the acts complained of. . . . But by far the greater number of exceptions engrafted upon the general rule are cases in which it has been decided that by various statutes criminal responsibility has been put upon masters for the acts of their servants. Amongst such cases are *Mullins v. Collins*,<sup>17</sup> where a licensed victualler was convicted of an offence under Sec. 16 of the Licensing Act of 1872 for supplying liquor to a constable on duty, although this was done by his servant without the knowledge of his master. Again, in *Bond v. Evans*<sup>18</sup> a licensed victualler was convicted of an offence against Sec. 17 of the same Act where gaming had been allowed in the licensed premises by the servant in charge of the premises, although without the knowledge of his master. The decisions in these and in other like cases were based upon the construction of the statutes in question. The court, in fact, came to the conclusion that, having regard to the language, scope and object of these Acts, the legislature intended to fix criminal responsibility upon the master for acts done by his servant in the

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(16) (1865) 1 Q.B. 702. See also *Parker v. Alder*, (1899) 1 Q.B. 20, *Moussell Bros., Ltd. v. London and North Western Railway Co.*, (1917) 2 K.B. 836; *Allen v. Whitehead*, (1930) 1 K.B. 211.

(17) (1872) 9 Q.B. 292.

(18) (1888) 21 Q.B.D. 249.

course of his employment, although such acts were not authorised by the master and may even have been expressly prohibited by him. The question, then in this case comes to be narrowed to the simple point, whether upon the true construction of the statute here in question the master was intended to be made criminally responsible for acts done by his servant in contravention of the Act, where such acts were done, as in this case, within the scope or in the course of their employment. In my judgment it was clearly the intention of the legislature to make the master criminally liable for such acts, unless he was able to rebut the *prima facie* presumption of guilt by one or other of the methods pointed out in the Act. . . . In the present case there was ample evidence to justify the conclusion of the Magistrate that the appellant was *prima facie* guilty of the offence charged, and that *prima facie* case has not been met with in the manner required by the Act. . . . There was evidence before them that the American hams in question were dressed so as to deceive the public; and this probably explains the reason of the affirmative finding to which I have adverted and the absence of the finding that the appellant had acted innocently within the meaning of Clause (c). In answer, then, to the question which alone is put to us, namely, whether, upon the facts stated, the decision of the Magistrates convicting the appellant was in point of law correct, my answer is that, in my judgment it was. When the scope and object of the Act are borne in mind, any other conclusion would to a large extent, render the Act ineffective for its avowed purposes. The circumstances of the present case afford a convenient illustration of this. The appellant, under the style of the "London Supply Stores" carries on an extensive business as grocer and provision dealer, having, it appears six shops or branch establishments, and having also a wholesale warehouse. It is obvious that, if sales with false trade descriptions could be carried out in these establishments with impunity, so far as the principal is concerned, the Act would to a large extent be nugatory. I conceive the effect of the Act to be to make the master or principal liable criminally (as he is already by law civilly) for the acts of his agents and servants in all cases within the section with which we are dealing, where the conduct constituting the offence was pursued by such servants and agents within the scope or in the course of their employment, subject to this—that the master or principal may be relieved from criminal responsibility where he can prove that he had acted in good faith and had done all that it was reasonably possible to do to prevent the commission by his agents and servants of offences

against the Act. The result, therefore, is that the conviction will be affirmed and with costs."

**Indian cases.**—The principles of law set forth above regarding the criminal liability of the master for acts done by his servant have been followed in the Indian courts. In *Emperor v. Babu Lal*<sup>19</sup> a licensed vendor of opium was held liable for the sale of opium by his servant to a person below 14 years without the knowledge of the vendor. In *Maung Ba Cho v. Emperor*<sup>20</sup> Mr. Justice Dunkley held that under the Burma Forest Act where a servant impressed his master's property mark on unlawfully felled timber, the master was liable for the offence. After citing various authorities his Lordship said: "I do not say that a master would be criminally liable for every act of his servant which amounts to an offence under the Forest Act, but to my mind it is plain from the language, scope and object of the Forest Act, that the legislature intended to fix criminal responsibility upon the master for acts . . . done by his servant in the course of his employment . . . although such acts were not authorised by and were done without the knowledge of the master. . . . If therefore the owner of a mark delegates his duty in respect of the use of the mark to a servant, he does so at his peril."

Where the court is of opinion that the master had adopted all reasonable means to prevent his servants committing a wrong, that the master could not have taken more care, and that the negligence was entirely that of his servants, the master will not be criminally liable. In such cases the servant who has committed the offence against the Act should be got at.<sup>21</sup>

#### (vii) Definition of piece-goods.

Section 19 reads:—

"For the purposes of Sec. 12 of this Act and Clause (f) of Sec. 18 of the Sea Customs Act, 1878, as amended by this Act, the Governor-General in Council may, by notification in the Gazette of India, declare what classes of goods are included in the expression 'piece-goods, such as are ordinarily sold by length or by the piece'."

(19) (1912) 34 All. 319. See also *Queen Empress v. Tyab Ali*, (1900) 24 Bom. 423 (case under Arms Act.)

(20) A.I.R. 1934 Rang. 245; 12 Rang. 300.

(21) See for instance *Montgomerie & Co., Ltd. v. Young Brothers*, (1904) 21 R.P.C. 285.

Rules and orders in respect of piece-goods and yarns are given in The Merchandise Marks Manual. Piece-goods shall be deemed to include cotton piece-goods and woollen piece-goods of all kinds except the descriptions specified under order No. 1430, dated 6th April, 1891, as subsequently amended.<sup>22</sup>

Sections 19 to 22 were added by the Indian Merchandise Marks Act and Sea Customs Amendment Act, 1891.

(viii) *Determination of character of goods by sampling.*

Section 20 runs—

(1) *The Governor-General in Council may make rules, for the purposes of this Act, to provide with respect to any goods which purport or are alleged to be of uniform number, quantity, measure, gauge or weight, for the number of samples to be selected and tested and for the selection of the samples.*

(2) *With respect to any goods for the selection and testing of samples of which provision is not made in any rules for the time being in force under sub-Sec. (1), the Court or officer of customs, as the case may be, having occasion to ascertain the number, quantity, measure, gauge or weight of the goods, shall, by order in writing, determine the number of samples to be selected and tested and the manner in which the samples are to be selected.*

(3) *The average of the results of the testing in pursuance of rule under sub-Sec. (1) or of an order under sub-Sec. (2) shall be prima facie evidence of the number, quantity, measure, gauge or weight, as the case may be, of the goods.*

(4) *If a person having any claim to, or in relation to, any goods of which samples have been selected and tested in pursuance of rules under sub-Sec. (1) or of an order under sub-Sec. (2) desires that any further samples of the goods be selected and tested, they shall, on his written application and on the payment in advance by him to the Court or officer of customs, as the case may be, of such sums for defraying the cost of the further selection and testing as the Court or officer may from time to time require, be selected and tested to such extent as may be permitted by rules to be made by the Governor-General in Council in this behalf or as, in the case of goods with respect to which provision is not made in*

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(22) See Merchandise Marks Manual, p. 7.

*such rules the Court or officer of customs may determine in the circumstances to be reasonable, the samples being selected in manner prescribed under sub-Sec. (1), or in sub-Sec. (2), as the case may be.*

(5) *The average of the results of the testing referred to in sub-Sec. (3) and of the further testing under sub-Sec. (4) shall be conclusive proof of the number, quantity, measure, gauge or weight, as the case may be, of the goods.*

(6) *Rules under this section shall be made after previous publication.*

Rule 43 in Part III of the Merchandise Marks Manual states that for testing yarn the appliances required should be the same as those used in the testing house of the Manchester Chamber of Commerce, and may be obtained on indent through the Local Governments.<sup>23</sup>

(ix) *Information as to commission of offences.*

Section 21 of the Act reads—

*“An officer of the Government whose duty it is to take part in the enforcement of this Act shall not be compelled in any Court to say whence he got any information as to the commission of any offence against this Act.”*

A Government officer whose duty is to take part in the enforcement of the Merchandise Marks Act shall not be compelled to divulge to the court the names of persons who gave the information regarding the commission of the offence. The absence of such a

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(23) “The stove test need only be applied in cases in which weighment by the ordinary methods shows the weight of the yarn to be short, or in which the feel and appearance of yarn indicate that it is abnormally moist or over-conditioned, or in which the importer demands the test. A fee of Rs. 5 (five) will be levied from an importer demanding the test, but will be refunded if the test fails to support the original determination of count and length by the Customs officers. If more than one application of the test is demanded, a further fee of Rs. 5 will be levied for each fresh test, the whole sum charged being retained or refunded according to the final result.

#### *Conditioning.*

The conditioning of yarn is the term applied to the quantity of moisture a given yarn contains.

Under the stove test yarn is reduced to an absolutely dry condition and then weighed. In the case of cotton yarn a regain of  $8\frac{1}{4}$  per cent. is next added, and the figure obtained is regarded as the actual weight under normal conditioning to be adopted for the purposes of determining whether a given length of yarn is of full or short weight.” (Rule 44).



provision would be injurious to public interests and would make the administration of the Act very difficult. While it is perfectly right that all opportunities should be given to discuss the truth of the evidence against the accused, it must be observed that "there is a rule which has universally obtained on account of its importance to the public for the detection of crime, that those persons who are the channel by means of which that detection is made should not be unnecessarily disclosed."<sup>24</sup> Although it is the duty of every citizen to help and co-operate with Government by giving such information as he may have concerning the commission of the offence, it must be confessed that in most cases the informant is unwilling to associate himself publicly in connection with the criminal case and to be cited as a prosecution witness. In such cases unless the informant is assured that his name will not be disclosed to the court he may be reluctant to give any information about the commission of the offence. It is therefore essential that the Act should provide for the exemption from compulsory disclosure of the informant's identity. Otherwise a number of crimes will go undetected and unpunished.

The general principle of law is embodied in Sec. 125 of the Indian Evidence Act, which reads:—

*"No Magistrate or Police Officer shall be compelled to say whence he got any information as to the commission of any offence, and no Revenue Officer shall be compelled to say whence he got any information as to the commission of any offence against the public revenues.*

*Explanation:—'Revenue Officer' in this section means any officer employed in or about the business of any branch of the public revenue.*<sup>25</sup>"

The prosecution is thus privileged and is not bound to disclose the names of the informants as to the commission of the offence. For the same reason the defence is not entitled to elicit from a prosecution witness whether he was a spy or an informer.<sup>1</sup>

The section does not say whether the prosecution witness may be allowed to give the source of his information as to the commission of the offence, if he be willing to do so. But it has been held

(24) *E. v. Hardy*, 24 How. St. Tr. 808, (Eyre, C.J.).

(25) See also Sec. 124 of the Indian Evidence Act: "No public officer shall be compelled to disclose communications made to him in official confidence when he considers that the public interests would suffer by the disclosure."

(1) *Amrita v. King Emperor*, (1915) 19 C.W.N. 676; 42 Cal. 957.

that it is the duty of the judge to exclude such evidence.<sup>2</sup> In *Weston v. Peary Mohan Dass*<sup>3</sup> Woodroffe, J., said: "I will only add as regards Sec. 125 of the Evidence Act that though the section does not in express terms prohibit the witness, if he be willing, from saying whence he got his information, both the English authorities from which the rule is taken and consideration of the foundation of the rule show that the protection should not be made to depend upon a claim of privilege being put forward, but it is a duty of the judge apart from objection taken to exclude the evidence. *A fortiori* if objection is taken, it cannot since the law allows it, be made the ground of adverse inference against the witness." Under this section the court cannot compel the disclosure of the name of the informant even if the court consider such disclosure necessary in order to establish the innocence of the accused.<sup>4</sup>

A distinction has been made in England between private and public prosecutions whereby the above rule does not apply to private prosecutions.<sup>5</sup> No such distinction is however, drawn under the Indian Evidence Act.<sup>6</sup>

(x) *Punishment of abetment in India of acts done out of India*,  
Section 22 reads—

*"If any person, being within British India, abets the commission, without British India, of any act which, if committed in British India, would under this Act, or under any section of that part of Chapter XVIII of the Indian Penal Code which relates to trade, property and other marks, be an offence, he may be tried for such abetment in any place in British India in which he may be found, and be punished therefor with the punishment to which he would be liable if he had himself committed in that place the act which he abetted."*

The section is limited to acts done outside British India.

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(2) *Marks v. Beyfuss*, (1890) 25 Q.B.D. 494; *Hennessy v. Wright*, (1888) 21 Q.B.D. 509.

(3) (1912) 40 Cal. 898.

(4) *Marks v. Beyfuss*, (1890) 25 Q.B.D. 494.

(5) *R. v. Richardson*, 3 F. & F. 693; 176 E.R. 318; *Marks v. Beyfuss*, (1890) 25 Q.B.D. 494.

(6) The distinction made in the English rule was followed in re. *Mohesh Chunder*, (1870) 13 W.R.Cr. 1 (10) an early Indian case decided before the passing of the Indian Evidence Act.

Chapter V of the Indian Penal Code, deals with abetment. The definition of "abet" is given in Sec. 107, I.P.C. which reads:—

*"A person abets the doing of a thing, who—*

*First:—Instigates any person to do that thing; or*

*Secondly:—Engages with one or more other person or persons in any conspiracy for the doing of that thing, if an act or illegal omission takes place in pursuance of that conspiracy, and in order to the doing of that thing; or*

*Thirdly:—Intentionally aids, by any act or illegal omission, the doing of that thing.*

*Explanation 1:—A person who, by wilful misrepresentation or by wilful concealment of a material fact which he is bound to disclose, voluntarily causes or procures, or attempts to cause or procure, a thing to be done, is said to instigate the doing of that thing."*

*Explanation 2:—"Whoever, either prior to or at the time of commission of an act, does anything in order to facilitate the commission of that act, and thereby facilitates the commission thereof, is said to aid the doing of that act."*

Section 108 defines an "abettor" as a person "who abets either the commission of the offence, or the commission of an act which would be an offence, if committed by a person capable by law of committing an offence with the same intention or knowledge as that of the abettor." To constitute the offence of abetment it is not necessary that the act abetted should be committed. Nor is it necessary that "the abettor should concert the offence with the person who commits it. It is sufficient if he engage in the conspiracy in pursuance of which the offence is committed." Sec. 108-A deals with abetment in British India of offences outside it. "A person abets an offence within the meaning of this Code who, in British India, abets the commission of any act without and beyond British India which would constitute an offence if committed in British India." For example, where A, in British India, instigates B, a foreigner in Goa, to commit a murder in Goa, A is guilty of abetting the crime.

## CHAPTER XII.

### SOME GUIDING PRINCIPLES FOR TRADE MARKS LEGISLATION IN INDIA.

It was shown in Chap. II that in the absence of a Trade Marks Act Indian trade mark owners suffer serious disabilities in protecting their trade mark rights at home and abroad, and that the removal of these disabilities can be effected by the enactment of a statute law for the registration of trade marks in India. In view of the possibility that a Trade Marks Bill may engage the attention of the Indian Legislature in the near future it is proposed to examine in this chapter some of the important principles of trade mark law which should form the basis of the Indian Bill. In discussing the question the special conditions in India have been carefully considered and it is hoped that the broad outlines of legislation put forward in this chapter would be acceptable to the Indian Legislature.

**General considerations.**—The essential requirement of a Trade Marks Act as indeed of all law, is that the law should clearly lay down the nature and extent of the protection it offers and the conditions under which it offers the same. The rights and obligations of trade marks owners should therefore be clearly enunciated in the future Indian Trade Marks Act. In this matter the existing trade mark laws of different countries are available to us for guidance. It may be mentioned here, that as Indian commercial legislation has generally been based on the corresponding English statutes, it would be a matter of great convenience if legislation for Trade Marks in India be also modelled on the English Trade Marks Act. Indeed, the existing criminal law relating to trade and merchandise marks closely follows the British Merchandise Marks Act. Again, in all civil suits relating to trade marks in India the courts are following the common law of England. Since statute law in England is based on the common law, Indian legislation, if based on the English Act, would be best suited to the needs of the country. A distinct advantage that will accrue from following the English Act will be that, as in the case of the adminis-

tration of other Acts, well established precedents and lucid expositions of law by eminent British judges will be available to the Indian courts in administering the new Act, which by its very nature, is bound to be highly technical. Apart from these considerations it may be observed that an examination of the Trade Marks Laws of the various countries would point unmistakably to the inherent superiority of English Statute law and to its greater adaptability to Indian conditions. Another practical advantage may be mentioned. The most important part of India's external trade is admittedly that with England and a large majority of the foreign marks seeking registration in India will be from England. In the case of many of these marks questions concerning their registrability would have already been settled in England so that their registration again in India will present no serious difficulties.

**Goschen Committee.**—Early in 1933, a Committee was appointed by the Board of Trade in England under the chairmanship of Viscount Goschen to consider and report "whether any, and if so what changes in the existing law and practice relating to trade marks are desirable." Very valuable evidence was tendered before this Committee by all the important British interests concerned as well as by authorities on Trade Marks Law, and a report<sup>1</sup> embodying the results of the labours of this Committee was submitted to the Board of Trade in April 1934. The recommendations contained in this important document have been carefully considered and such of them as appear to be suitable to Indian conditions are referred to in detail in the present Chapter. It must, however, be pointed out that any suggestions put forward in the following pages indicate only in broad outline the provisions that should form the basis of the future Act, and that the question of actual drafting is left to the legislature. The matters dealt with are fairly numerous and have been arranged under a number of separate heads.

**I. Theories of Trade Mark Legislation:**—It may be convenient at the outset to point out briefly the broad principles on which the trade mark laws of the various countries can be classified. There are three main systems of registration with their accompanying statutory protection, namely, (1) the Attributive system according to which the rights are conferred solely by registration, (2) the British system according to which registration *per se* confers no

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(1) Command 4568. "Report of the Departmental Committee on the Law and Practice relating to Trade Marks," H. M. Stationery Office.

rights but such as are founded on user, and (3) the deposit system where registration is effected without any examination of the mark.

*Attributive system.*—In countries where attributive registration prevails it is imperative for the manufacturer or trader to resort to registration as speedily as possible, as otherwise, there is the danger of his trade mark being usurped by another person who may register it in his name. If a manufacturer or a trader fails to register his mark in these countries he may often find himself in the unenviable position of being unable to sell his goods marked with the brands which he had all along been using, merely because, a more enterprising rival had forestalled him by obtaining registration of these marks. The attributive system of registration prevails in most of the South American States, and in Germany, Denmark, Greece, Portugal, and Sweden. In many of them, however, opportunity is given to the prior user to oppose the registration within a limited period. But such facilities are not of much practical value to non-residents in the country as they are not likely to see the advertisements of the application which may appear in the local official publications. In some of these countries, again, cancellation of registration may be sought by the first user, but the period within which this could be done is generally too short to enable him, especially if he is a non-resident, to get this form of redress. As against these disadvantages, it may be claimed that the rights under a system of attributive registration are clear and well-defined.

*British system.*—On the other hand, in many countries, the law provides protection to the prior user. In these countries mere registration of a trade mark does not create an exclusive right to ownership, and the rights of the prior user are always recognised by the law irrespective of whether the mark is registered or not. The statutes providing for registration are generally in conformity with the common law, the remedies given by the former being supplemental to those already available under the latter. Hence by the fraudulent registration of a trade mark of which he is not the first user a person will avail himself of nothing and such registration is liable to cancellation on a motion by the first user. Among the important countries where this system of registration prevails we may mention Great Britain and her Dominions and Colonies, United States of America, France, Japan, Spain, Switzerland and Belgium.

*Disadvantage of the British system.*—It has often been urged that the disadvantage of the British system lies in the uncertainty

which a trader has in determining the rights that accrue to him from registration. A person who has honestly chosen and registered a trade mark may find that some years after his mark had been registered his title to the mark is questioned by a prior user, who may succeed in expunging the mark from the Register. The defect in this system is that while the law recognises the first user alone as entitled to the mark it does not provide any means of informing a person seeking registration of a mark whether the same or a similar mark is already being used by another or not.<sup>2</sup>

*Deposit system.*—A modification of the British system known as the Deposit system prevails in France. The difference between the two systems lies in the fact that under the 'deposit system' a trade mark is not subjected to examination for distinctiveness before registration and the registration is not open to opposition. Obviously, the rights conferred by such registration are very uncertain. The owner of a registered trade mark does not know at the time of registration whether the same or a similar mark has already been registered by another person, not to speak of the existence of prior users. The absence of examination as to distinctiveness will further entail a greater degree of uncertainty as to the validity of a registered trade mark. These difficulties are bound to be a constant source of irritation to the trade mark owners and will involve them in no end of litigation. This system of registration prevails in France, Belgium and some other countries.

*The different systems compared.*—Thus, it is seen that in so far as rights accruing from registration are concerned the attributive system confers the greatest amount of statutory protection to trade mark owners, the British system comes next, while the deposit system gives the least protection. But in the matter of rights founded on user the attributive system recognises none whatever, while such rights are preserved under the other two systems, the British system providing in this respect more effective safe-guards than the deposit system.

**System of registration recommended for India.**—From a consideration of the fore-going it is obvious that, if the rights accruing

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(2) The necessity for the maintenance of a record as complete as possible of trade marks in use was urged by Sir William Jarrett before the Goschen Committee. On behalf of the Trade Marks, Patents and Designs Federations, Ltd., Sir William pressed for the introduction of a 'refused list' which in the absence of compulsory registration would, in his opinion, provide a practicable, though partial, solution of the problem. This proposal did not, however, meet with the approval of the Committee.

from prior user under the common law to which owners of trade marks in India are now entitled should not suffer, the Indian Trade Marks Bill should be modelled on the English Trade Mark Act. The adoption of a legislation which would recognize the first registrant as the exclusive owner of the mark in utter disregard of the rights of the prior user would lead to great confusion, increased litigation and severe hardship to the commercial community. Such legislation would create, what an American author calls the 'danger spots' of the world as far as trade mark rights are concerned. The right to a trade mark should always be regarded as a common law right and legislation should aim at only extending the sphere of common law remedies and affording more effective and less costly redress against trade mark piracy. This object is attained by Sec. 42 of the English Act, whereby in addition to provision in Sec. 45 for passing-off action, the right to institute an 'action for infringement' is conferred on the proprietors of registered trade marks. The English Trade Marks Act thus provides the most equitable solution and Indian legislators would find it in the best interests of the country to adopt the relevant provisions of this Act. Indeed, any other solution is not likely to commend itself to the commercial community in this country. In this connection it may be observed that it would, certainly, be most desirable if the various countries in the world could be persuaded to evolve a uniform system of registration in place of the present conflicting laws relating to trade marks. The unification of the trade mark laws in the British Commonwealth would undoubtedly be a distinct step forward in that direction.

**II. Conditions governing registration.**—As the primary object of a Trade Marks Act is to protect proprietors of trade marks, the law should combine the maximum of protection with the minimum of restriction on the trader in the choice and use of trade marks. Indeed, the modern tendency in trade mark legislation is towards relaxation of restriction and this should form the guiding principle in framing the Indian Act. As Lord Moulton said: "The object of trade mark legislation is to induce persons to make the register of trade marks complete and accurate and, therefore, we ought as far as possible to get everything that is an effective trade mark on the register."<sup>3</sup> The Indian Act should, therefore,

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(3) Trans. Institute of Patent Agents, Vol. 24, p. 43 (1905). See also the evidence of Sir William S. Jarratt before the Goschen Committee (Minutes of Evidence, pp. 79 to 119).



be conceived in a liberal spirit with a desire to get on the register practically all trade marks that are really effective and are actually in use in the country. Great thought and labour would be required in drafting the fundamental section of the Act defining the conditions under which a trade mark can get on the Register.

*Distinctiveness.*—As registration of a trade mark grants an exclusive monopoly of the use of the mark to its owner the first condition of registration obviously, should be that the monopoly conferred deprives no other trader of the use of a word or device he might reasonably require in the ordinary course of his business to describe his goods. This raises the question of distinctiveness as a requirement for registration. Distinctiveness may be either inherent or acquired. Section 9 of the British Act of 1905 lays down what kinds of marks are inherently distinctive. Marks that are common to the trade or descriptive of the goods, geographical names, surnames and such other words or marks as are not inherently distinctive are *a priori* considered unsuitable for registration.<sup>4</sup> But the question arises whether marks that are *prima facie* descriptive but have subsequently acquired distinctiveness by usage can be registered upon evidence of such acquired distinctiveness. While it may be conceded that registration of such marks may have the desirable effect of bringing a greater number of effective trade marks on the register it must be nevertheless pointed out that the adoption of this practice would lead to serious difficulties in the administration of an Act that might contain such a provision. For, acquired distinctiveness will have to be established before registration can be effected and the weight of evidence required will vary with the nature of the mark, the kind of goods and the class of purchasers. Such cases are better dealt with by a court of law than by quasi-judicial proceedings before the head of a Government department. Again, legislation should discourage the undesirable practice of traders choosing descriptive or quasi-descriptive words for trade marks with the hope of claiming acquired distinctiveness at a later date and then registering them to secure additional statutory protection. Further, no case of real hardship will arise by refusing registration to such descriptive or quasi-descriptive marks if it be provided in the Indian Act on the lines of Sec. 42 of the English Statute, that in the case of trade marks which are in use before the Act comes into force and are refused registration for want of inherent distinctiveness the owners of such

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(4) The question has been discussed in Chap. IV.

marks shall, nevertheless, be entitled to institute legal proceedings for infringement. Registration should, therefore, be confined under the future Indian Act to trade marks which possess inherent distinctiveness.<sup>5</sup>

*Part A and Part B Registers under the English Act.*—In Sec. 9 of the English Trade Marks Act of 1905, a distinctive trade mark has been defined as one 'adapted to distinguish' the goods of the proprietor of the mark from those of other persons. The section further lays down that in determining whether a trade mark is adapted to distinguish the goods of its proprietor from those of other persons "the tribunal may in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered." The object of this provision was to enable the registration of a number of common law trade marks which though not inherently distinctive, had acquired distinctiveness by user. It was, however, found that, notwithstanding the above provision, the limitations placed by this section on registration necessarily excluded a large number of common law marks which were, and would continue to be actually used in trade. As was stated by Lord Parker<sup>6</sup> the difficulty was that in defining what was capable of registration certain limits had to be laid down and certain very good common law marks were outside those limits. As far as rights in England were concerned non-registration of these marks did not matter as in cases of infringement of their marks the owners had a right to relief under the common law by an action for passing-off. But the owners of these marks were put to serious difficulties in foreign countries. In many of these countries common law trade marks were not legally recognised and registration was essential in order to protect the rights of trade mark owners. Many foreign countries, however, require as a condition of registration in their country that any person who is not a subject of their state shall produce a certificate of registration of his mark in his home country. Obviously such certificate could not be secured in England in the case of a common

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(5) If it be considered expedient that registration should be extended to some non-distinctive old marks, provision may be made for their registration on the owners producing satisfactory evidence of exclusive user for a period of not less than ten years over a wide area. The rights accruing from such registration should be of a limited character. A provision of this nature finds statutory recognition in the United States in the Ten Year Mark Rule.

(6) Trans. Institute of Patent Agents Vol. 36, p. 153 (1918).

law mark, and many valuable common law trade marks of British subjects could not, therefore, be registered in those foreign countries. In the case of many such trade marks, traders abroad had actually registered them in foreign countries as their own trade marks, and had used them to pass-off their own goods as the goods of the British trader. In some cases they had even endeavoured by means of such registration to restrain the importation of British goods bearing the marks of the actual British proprietor who was responsible in the past for their creation and value. The interests of owners of common law marks in England were thus materially affected abroad, and British traders were specially at a disadvantage compared with the nationals of countries where the deposit system of registration prevailed or where a less rigorous test of distinctiveness for registration was required than in England. In view of the rigorous construction put by the courts on the section defining distinctiveness, a suggestion was made that the substitution of the words "capable of distinguishing" for the words "adapted to distinguish" in Sec. 9 of the Act of 1905 might mean something broader and might enable registration to be obtained for the common law marks which were refused registration before. Although this suggestion was accepted the traditional conservatism of the English mind could not reconcile itself to a radical change of the law. "A simple amendment of Sec. 9 of the Act of 1905" writes Haddon,<sup>7</sup> "would probably have sufficed, but in order to make more certain that the new phrase would be construed more differently from "adapted to distinguish" the somewhat cumbrous method was adopted of setting up a separate Register to be known as Part B of these marks." (Act of 1919). The distinction between marks which are "adapted to distinguish" and marks which are "capable of distinguishing" was discussed at length in the case of *Davis Trade Marks*<sup>8</sup> by the Court of Appeal in 1927.

*B Register not necessary in India.*—The introduction of two trade mark registers in India, on the model of the English system is, however, of doubtful value. It may be noted that even in England this system has not fulfilled its purpose and has given rise to some dissatisfaction among the commercial community. In the first place there are still a number of good common law marks

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(7) Haddon on Trade Marks, p. 12.

(8) *Frank James Davis (Trading as Ustikon Co. v. Sussex Rubber Co., Ltd.*, 44 R.P.C. 412.

which are in use in trade and commerce and which have been held by the courts as non-registrable in the B Register. *The Liverpool Electric Cable Co., Ltd.'s Application*,<sup>9</sup> may be cited as an illustrative case. Although secondary signification in the word "Liverpool" for cables was established, it was held by the Court of Appeal that the mark was not "capable of distinguishing" the goods of the Plaintiffs and that it was consequently not registrable in the B Register.

Secondly, the rights conferred by registration in Part B Register are considerably less than by registration in Part A Register. Thus, the registration of a person as proprietor of a mark in the B Register does not give to such person the exclusive right to the use of such trade mark upon or in connexion with goods in respect of which it is registered. Again, the fact of registration in Part B of the Register is not at any time conclusive evidence of the validity of the registration. Such evidence serves only as *prima facie* evidence that the registrant has the exclusive right to the mark. But in any action for infringement in respect of a trade mark entered in the B Register no injunction or other relief shall be granted to the owner of the mark in respect of such registration, if the defendant establishes to the satisfaction of the court that the user which is complained of is not likely to lead to the belief that his goods are the goods of the proprietor of the trade mark. The general tendency among the merchants is always, therefore, to apply first for registration in Part A of the Register and on refusal to apply for registration in Part B. Thus, on an average, while over 10,000 applications per year are made for registration in Part A Register, less than 300 new applications are submitted for registration in Part B.

Thirdly, the difference in meaning between the two expressions "adapted to distinguish" and "capable of distinguishing" is not clear and has not been well explained by the English Courts. For example, in *the Liverpool Electric Cable Co., Ltd.'s Application*,<sup>10</sup> Romer, J., observed that he very much doubted whether there was any difference between these two expressions and that if a mark did in fact distinguish, it should be adapted to distinguish.

From what has been said above it will be clear that the adoption of two Trade Marks Registers on the lines of the English Act of

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(9) 46 B.P.C. 99.

(10) 46 B.P.C. 99.

1919 will result in confusion among the Indian public who have hitherto no experience at all about registration of trade marks. The system is still in an experimental stage in the United Kingdom and if it is decided to repeat this experiment at all in this country it would be desirable to postpone it for some years so that the Indian commercial communities may have acquired by that time some knowledge of the actual working of the first Trade Marks legislation, which should provide for a single Trade Marks Register as under the earlier English Acts. The introduction of Part A and Part B Registers on the model of the present English system cannot, therefore, be recommended for India at present.

**III. Definition of a trade mark.**—The proper function of a trade mark is to indicate that the goods upon which it is used are the goods of a certain trader by virtue of manufacture, selection, offering for sale, etc. Following Sec. 3 of the English Act, the following definition of a trade mark may be adopted in the Indian Trade Marks Bill, when it is prepared :

*“A ‘trade mark’ shall mean a mark used or proposed to be used upon or in connexion with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale.”*

The above definition will be in accordance with Indian case law. Marks that are not used in trade, such as, club badges, names of private houses, etc., shall not constitute trade marks.

**IV. Registrable trade marks.**—All marks that satisfy the above definition of a trade mark, however, shall not be registered. As has been already pointed out, only such trade marks as are inherently distinctive should be registrable. Following Sec. 9 of the English Act, the following definition of a registrable trade mark may be adopted under the Indian Act:—

*“A registrable trade mark must contain or consist of at least one of the following particulars:—*

- (1) The name of a company, individual, or firm represented in a special or distinctive manner.*
- (2) The signature of the applicant for registration or some predecessor in business.*
- (3) An invented word or words.*
- (4) A word or words having no direct reference to the character or quality of the goods, and not being*

*according to its ordinary signification a geographical name or surname.*

- (5) *Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the description in the above paragraph (1), (2), (3) and (4) shall not, except by order of the Governor-General in Council or a High Court be deemed a distinctive mark:*

*Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the passing of the Act, which has continued to be used either in its original form or with minor alterations down to the date of the application shall be registrable as a trade mark under the Act.*

*For the purposes of the above paragraph "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.*

*In determining whether a trade mark is so adapted, the tribunal may take into consideration the extent to which user of the trade mark or any other circumstance has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered."*

It will be seen that under Clause (5) of the above definition even a surname or geographical name can be registered so long as it is distinctive, subject to the requirement of an order from the Governor-General in Council.<sup>11</sup>

In his evidence before the Goschen Committee Sir William Jarrett pleaded for the deletion of the statement of essential particulars from Sec. 9 of the English Act, and suggested that every trade mark which is in fact distinctive should be registrable irrespective of whether the mark is inherently distinctive or has acquired distinctiveness by usage. It was, however, pointed out by Dr. Lindley that if the above suggestion was adopted there would be a danger of encouraging people to acquire monopolies in highly descriptive words as trade marks after a certain period of

(11) Registration of the following words were allowed by the courts in England under the corresponding sub-section of the English Act:—"Apollinaris" (In re *Apollinaris Brunnen*, 24 R.P.C. 436); "Oswego" (In re *National Starch Co.*, 25 R.P.C. 802); "Lawson Tait" (In re *Whitfield's Bedsteads, Ltd.*, 26 R.P.C. 657); "California Syrup of Figs" (In re *California Fig Syrup Co.*, 26 R.P.C. 436); "Itala" (In re *Itala Fabbrica di Automobili*, 27 R.P.C. 493).

user, and that it would be easy to get declarations of distinctiveness from all over the country whatever the words initially meant. The proposal was rejected by the Goschen Committee who observed: "The statement of essential particulars is a useful guide to the categories of marks which may be regarded as distinctive. Moreover, it has been the subject of judicial decisions extending over many years, and the case law thus built up is of great assistance in interpreting and administering the Act. If these categories are taken out of the Act, it would be necessary in practice to compile a fresh set by judicial decisions, with uncertainty and expense to traders in the meantime."

The last paragraph in the draft section proposed above follows the amendment in Sec. 9 of the English Act suggested by the Goschen Committee.

#### V. Restrictions on Registration.—(a) *Identical marks.*—

Apart from the test of distinctiveness, certain other restrictions on registration will be essential. As a trader or manufacturer seeks registration with the object of securing an exclusive monopoly in the use of the words it is obvious that once a trade mark is registered in respect of a certain class of goods by one trader no other trader can be allowed to register the same mark for the same class of goods. The restriction will, no doubt, apply to the case of a mark which so nearly resembles the original registered mark as is likely to deceive. This provision is contained in Sec. 19 of the English Act and obviously is intended not only in the interests of registered trade marks owners but also in the interests of the public. Apparent exceptions to this rule are in the case of honest concurrent user (Sec. 21 of the Act) and in the case of Associated Trade Marks (Secs. 24 to 27).

(b) *Concurrent user.*—The question of allowing registration of the same mark by concurrent users in a vast country like India is bound to be a matter of considerable administrative difficulty. The adoption of the three mark rule<sup>12</sup> whereby registration was formerly refused in England for old marks when there were more than three applicants will be a safe guide for this purpose.

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(12) When the first Trade Marks Act came into force in England there were several cases where two or more traders applied for the registration of substantially identical marks. The Registrar adopted as a convenient rule that registration should be refused in case of more than three applicants for the same mark. This rule received later statutory recognition in Sec. 74 (3) of the Act of 1883 which laid down that a mark owned by more than three persons should be deemed common to the trade.

(c) *Contrary to law or morality.*—Under Section 11 of the English Act it shall not be lawful to register marks which are contrary to law or morality or otherwise disentitled to protection in a court of justice. A provision of this nature in the Indian Act will be obviously necessary.

(d) *Names of deities.*—The names of Hindu deities are commonly used in India as trade marks and such marks have been protected by the courts in India.<sup>13</sup> As these names are the common heritage of the country, the question may be raised whether such marks should be registrable under the Indian Act. It may be mentioned in this connection that trade names consisting of the names of gods and goddesses are regarded as non-registrable by the Bombay Mill owners' Association for purposes of registration in their private register. There does not, however, appear to be any need for introducing such a severe restriction on registration under the Indian Act. The names of Hindu gods and goddesses are legion and the adoption of one of these names as a trade mark by one person will not unduly restrict the choice by others of this class of names. The same thing applies to the names of mythological persons.

(e) *Marks offending religious susceptibilities.*—In a number of cases the association of names or representations of deities with certain articles of trade is likely to offend the religious sentiment of the people. For instance, registration will have to be refused in respect of beef for a trade mark of which the name or pictorial representation of a Hindu deity forms a part. A provision will be necessary for refusing registration to such marks.

(f) *Names of castes, tribes, etc.*—The objection to the registration of surnames as trade marks applies with even greater force in the case of names of sects, castes or tribes which are of common occurrence. For instance, a person may not claim a monopoly in the use of the word 'Pandit' or 'Shastri.'

(g) *Disclaimers.*—Section 15 of the English Act provides that if a trade mark contains parts not separately registrable or matter common to the trade or otherwise of a non-distinctive character, the registrant may then be asked to disclaim the right to the exclusive use of such parts or matter.

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(13) See for instance, *British American Tobacco Co. v. Mahboob Buksh*, 15 C.W.N. 280 (Sri Durga); *Sheikh Abdul Sovan v. Jitendranath Datta*, A.I.R. 1931 Cal. 445 (Sree Ramachandra Murti).



(h) *Royal arms*.—The use of Royal arms or other state emblem as part of a trade mark without sanction from properly constituted authority is prohibited under Sec. 68 of the British Trade Marks Act. Similar provisions are found in the trade marks legislations of all countries and should find a place in the Indian Act.<sup>14</sup>

(i) *Chemical names*.—In the case of registration of chemical names<sup>15</sup> a special provision is introduced by Sec. 6 (2) of the British Act of 1919 by which no word which is the only practicable name of any single chemical element or compound shall be registered as a trade mark and if registered such word shall be liable to be removed from the register notwithstanding the provisions of Sec. 41 of the Act of 1905.

(j) *Names of patented or new articles*.—It is a well-known principle of common law that the name of a patented article cannot be protected as a trade mark. The right of the public to manufacture the article after the expiration of the patent may be practically destroyed, if they are unable to use the name by which alone the patented article has been known and sold. Registration should, therefore, be refused where the trade name sought to be registered is or has become the name of the article.

**VI. Advertisement of applications for registration.**—As under the English Act it must be provided in the Indian legislation that every application for registration of a trade mark shall be advertised after acceptance and any aggrieved person should be permitted to enter an opposition to the registration of the mark within a prescribed period. A trade mark should be registered only when it has not been opposed, and the period for notice of opposition has expired, or having been opposed, the opposition has been decided in favour of the applicant. In special cases the Registrar may be empowered to advertise an application for registration before acceptance.

**VII. Appeals.**—It may be provided in the Act that the decision of the Registrar refusing registration or in opposition proceedings shall be subject to appeal to the Governor-General in Council.

**VIII. Effect of registration.**—Sections 38 to 45 of the English Act deal with the effect of registration. Secs. 38 and 39

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(14) Similar provisions are contained in Indian Partnership Act, Sec. 58 (3), and Indian Companies Act, Sec. 11 (3).

(15) See Chapter IV.

confer the right of property in respect of a registered trade mark. The registration of a person as proprietor of a trade mark, shall, if valid, give to such person the exclusive right to the use of such trade mark upon or in connection with the goods in respect of which it is registered. Where two or more persons having the right of concurrent user are registered as the proprietors of the same trade mark in respect of the same goods, the right of exclusive user of such trade mark cannot be claimed by any of them as against any of the other concurrent users, but each of such persons shall otherwise have the same right as if he were the sole registered proprietor thereof.

*Registration to be prima facie evidence of validity.*—In all legal proceedings relating to a registered trade mark the fact that a person is registered as proprietor of such a trade mark should be *prima facie* evidence of the validity of the original registration of such trade mark and of all assignments and transmissions of the same.<sup>16</sup> The original registration of such trade mark should after the expiration of seven years from the date of such original registration be taken to be valid in all respects. The exceptions to this rule should be (1) where the original registration was obtained by fraud, or (2) where the mark is likely to deceive, or (3) where the mark is otherwise disentitled to protection in a court, or (4) where the mark is contrary to law or morality, or (5) where the mark comprises any scandalous design.<sup>17</sup>

It should be provided, however, that the proprietor of a registered trade mark shall not interfere with the user by any other person of a similar trade mark which he or his predecessor in business has continuously used from a date anterior to the user of the first mentioned trade mark by the registered proprietor thereof or his predecessor in business.

Although it is advocated in a later section that the period of registration of a trade mark before renewal should be ten years only which is substantially less than under the English Trade Marks Act, it is advisable to keep the period required to constitute conclusive evidence of ownership as seven years from the date of registration, as under Sec. 41 of the English Act. Indeed, it is desirable to increase this period to ten years in the Indian statute. The reasons for this suggestion will be obvious when we consider the large area of the country, the diversity of languages spoken,

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(16) See Sec. 40 of the English Trade Marks Act.

(17) See Sec. 41 of the English Trade Marks Act.

and the high illiteracy of the people, apart from the facts that industry is not well developed and the art of advertisement is still in its infancy in this country. In this connection it may be pointed out that under the English Trade Marks Acts of 1875<sup>18</sup> and of 1883<sup>19</sup> it was enacted that in all legal proceedings relating to a registered trade mark the original registration of such trade mark should, after the expiration of five years from the date of such original registration, be taken to be conclusive evidence of the registrant's right to the exclusive use of the trade mark and that the period required for this purpose was increased to one of seven years in the Trade Marks Act of 1905.<sup>20</sup>

Under Section 42 of the English Act the right to institute a suit for infringement under the Act is confined to the proprietors of registered marks and to the owners of old marks for which registration has been refused. Registration does not prevent the use by another person of any *bona fide* description of the character and quality of his goods. (Sec. 44). Similar provisions may be incorporated in the Indian Act.

**IX. Classification of goods.**—An application for registration of a trade mark shall be for particular goods or class of goods on which the applicant has been using or proposes to use the mark. Such a restriction will be necessary in the Act in order to prevent defensive registration and blocking of the Register. At present different systems of classification of goods for the purposes of registration of trade marks prevail in different countries. It would be a matter of great advantage if the various countries could be made to agree to a uniform system of classification,<sup>21</sup> as it would enable a trader to register his mark in the same class in a number of countries. With this object a Committee of the International Union for the Protection of Industrial Property was set up and the scheme of classification prepared by them and adopted at the recent London Conference of the International Convention is given in Appendix XVII. This classification may be adopted for the purposes of registration under the Indian Act.

**X. Assignment of trade marks.**—The law relating to assignment of trade marks has been dealt with in Chap. V. It was

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(18) Sec. 3 of the Act of 1875.

(19) Sec. 76 of the Act of 1883.

(20) Sec. 41 of the Act of 1905.

(21) See Dr. Lindley's evidence before the Goschen Committee (Minutes of Evidence at p. 12).

shown that under the common law a trade mark cannot be assigned in gross but only along with the entire goodwill of the business. Statutory enactment in England has followed this principle. Section 22 provides that a trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill. The reason for this provision is that if a mark which had become associated with the goods of a particular manufacturer were assigned for use on similar goods in a different business the purchasing public would be deceived.

The question of assignment of the goodwill of a business along with the trade mark engaged the attention of the Goshen Committee. In his valuable evidence Dr. Lindley (Registrar of Trade Marks) pointed out that "the problem before the Committee stated in its simplest terms appeared to be to determine how to allow traders the greatest liberty for the assignment of their trade marks consistent with the avoidance of deception to the purchasing public and (as a subsidiary consideration) with the prevention of the possibility of mere trafficking in trade marks."<sup>22</sup> The objections to allowing assignments without any restriction are: (1) that the trade may generally be in doubt as to validity of an assignment that is likely to be set aside later on the ground that confusion and deception have been caused or are likely to be caused to the public, and (2) that such deception and confusion would often have already occurred before steps are taken to set aside the assignment. It is, therefore, necessary that the law should clearly lay down what kinds of assignment are valid. According to the evidence before the Committee the principle underlying both statutory and common law relating to assignment of trade marks is based on the theory that a trade mark owes its value to the goodwill and reputation of the business concerned. This, in the unanimous opinion of the commercial community no longer holds good under modern conditions of trade. Nowadays, the tendency is for the business to be built up around the trade mark, and any goodwill of the business is for all practical purposes inherent in the trade mark itself. The Committee were impressed by the weight of evidence in the matter and felt bound to recommend that the existing law should be relaxed so as to permit assignment without goodwill, provided such assignment is not likely to cause confusion and deception of the purchasing public. The Committee

(22) See Minutes of Evidence, p. 13.

recommended accordingly that Sec. 22 should be amended as follows<sup>23</sup> :—

(i) “A trade mark when registered should be assignable and transmissible in respect of any of the goods for which it is registered, either with or without the goodwill of the business in which it is being used; provided that there does not arise by reason of such assignment or transmission a right for more than one independent proprietor to use the mark or a similar mark for the same goods or description of goods so as to be likely to deceive or cause confusion.”

(ii) “Notwithstanding the preceding provision, a registered trade mark should be assignable and transmissible as aforesaid in respect of goods to be sold in the United Kingdom only, or in respect of goods to be exported from the United Kingdom to any overseas country or countries only, and the assignee or transferee be registrable as proprietor of the mark with corresponding geographical limitations notwithstanding that the assignor or transferor remains registered as proprietor of the mark for other markets.”

These recommendations are of very great significance and if adopted will remove the present hardships of trade mark owners as evidenced, for example, by the recent *Sinclair Trade Marks* case.<sup>24</sup> The sections dealing with assignment of trade marks in the future Indian Act should accordingly be framed on the basis of these recommendations.

Another useful provision which may be incorporated is that where a registered trade mark has been associated with the goods of an Indian firm assignment should not be allowed in respect of such mark to a person or a body of persons in a foreign country without previous permission from the Governor-General in Council or from the Registrar of Trade Marks.

The rule under common law relating to apportionment of trade marks on dissolution of partnership has been dealt with in Chap. V and should form the basis of statutory law as in England (Sec. 23 of the English Act). In the case of Associated trade marks the Indian Act must provide that the marks shall be assignable as a whole and not each mark separately. (Sec. 27 of the English statute).

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(23) See Goschen Committee Report, para. 115, pp. 29-30.

(24) 49 R.P.C. 123 (1932). See Chapter V where this case is discussed. See also Goschen Committee Report, para. 105, p. 26.

**XI. Associated trade marks.**—Section 24 of the English Act provides that where an application is made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the Register for the same goods as to be calculated to deceive if used by a person other than the applicant, registration may be allowed of such marks as associated trade marks. Sections 25 and 26 deal with combined trade marks and series of trade marks which are also treated like associated marks for the purposes of assignment. Similar provisions may be incorporated in the Indian Act.

**XII. Group marks.**—In these days of rationalisation and amalgamation it becomes necessary for a group of companies to use a trade mark registered by one of the members of the group. Under the existing law in England this is not possible, the theory being that the public identify a trade mark with the goods of a particular trader and if a system of licensing be introduced the public are likely to be deceived. But, under modern conditions of trade in a number of cases the public have no idea of the name of the manufacturer or selector of goods and regard the trade mark only as a means of identifying goods, possessing certain quality or characteristics. The question of a restricted system of licensing was raised before the Goschen Committee by the Federation of British Industries, London and Birmingham Chambers of Commerce, Trade Marks, Patents and Designs Federation, and the Chartered Institute of Patent Agents. While admitting that the existing law was inherently sound, these bodies asked for the introduction of a provision whereby certain persons associated in trade with the proprietor of a registered mark should be allowed the use of his mark. The Goschen Committee recommended that in special cases the proprietor of a registered trade mark may get the names of associated traders entered in the register as “registered users,” without depriving himself of the right to use the same, the new system being thus differentiated from ordinary assignment. This type of registration is granted only on grounds of public interest and hedged in by a number of conditions or restrictions as to mode and place of user.<sup>25</sup>

In the present state of industrialisation in India it will be difficult to ensure that the grant of this type of registration will serve public interest and will not be abused; its introduction cannot, therefore, be confidently recommended.

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(25) See paras. 117 to 123 of the Report of the Goschen Committee.

**XIII. Certification marks.**—With the growing industrialisation of a country goods (raw produce or manufactured articles) are not generally accepted by the trade unless they satisfy certain standard specifications. As the purchaser is not ordinarily in a position to test for himself the quality of the goods, associations come into existence which draw up specifications and undertake to certify whether the goods offered for sale are in accordance with such specifications. Goods so certified are often marked with a special identification mark to distinguish them from those not certified. Such associations are not manufacturers or vendors of goods. The question arises whether the marks used by them for the above purpose can be treated as trade marks. It is extremely doubtful whether any of them will receive protection under common law. The Act of 1905 recognised for the first time the need to grant protection for these marks in England. Section 62 of the Act provided for the registration of standardisation or certification marks as trade marks under the Act and the statutory definition of a trade mark was amended accordingly to include such special marks. It was also provided that for the recognition of these marks the consent of the Board of Trade was necessary apart from the requirement as to distinctiveness. Such permission could be given only if the registration was in the public interest and if the association was competent and was willing to undertake to certify. Registration of these marks was liable to cancellation at any time if the Board of Trade felt that the particular certification mark was no longer in public interest. Section 62 of the Act of 1905, as amended by the Act of 1919, enacts as follows:—

*“Where any association or person undertakes to certify the origin, material, mode of manufacture, quality, accuracy or other characteristic of any goods by mark used upon or in connection with such goods, the Board of Trade, if and so long as they are satisfied that such association or person is competent to certify as aforesaid, may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association on trade or possessed of a goodwill in connection with such certifying.”*

On behalf of the British Standards Institution the late Sir Richard Glazebrook, F.R.S., in his evidence before the Goschen Committee submitted that the requirements as to distinctiveness and intention to use should not be insisted upon in the case of

certification marks.<sup>1</sup> He quoted some instances where the Institution was unable to prevent misuse or piracy of its registered trade mark "British Standard." Thus, shortly after a British standard schedule for lubricating oils was issued in 1924 a company was formed under the title of British Standard Lubricating Oil Co., Ltd. Again, while the preparation of a British standard specification for taps and dies for making screws was under consideration by the Institution a company was registered under the name of British Standard Taps, Ltd. The most glaring misuse was the use of the word 'British Standard' for an American article sold by a German firm in England. Sir Richard, therefore, submitted that it would be in the interests of the public if the Institution were permitted to register the mark "British Standard" in respect of a wide range of goods and that registration should be allowed in the case of such marks for any class of goods notwithstanding that there was no immediate intention to use the mark. It was, however, pointed out by Dr. Lindley, in the course of the examination that the requirement of distinctiveness was much more imperative in the case of standardisation marks as the goods marked with these marks were likely to be extensively used; and Sir Richard ultimately agreed with this contention. The Goschen Committee have accordingly recommended (paras. 229 and 230 of their Report) that, (1) a certification mark should be 'adapted to distinguish' the goods so certified from similar goods not so certified, (2) that wherever practicable the difference between a certification mark and an ordinary mark should be clearly indicated on the goods so as to avoid any possibility of confusion between the two classes of marks, and (3) that regulations governing the use of a certification mark should meet with the approval of the Board of Trade and be so drawn up as not to exclude any trader's goods from the benefits of the mark. The other recommendations of the Committee mainly relate to procedure and aim at ensuring that the grant of a certification mark should only be in public interest.

The subject of certification marks is of some importance in India and in making statutory enactment great care and thought should be devoted not only to framing the main section but also to drawing up a set of sufficiently stringent rules, the keynote of which should be to allow registration of the marks solely on considerations of public interest. Registration should be refused unless the Registrar is satisfied that the applicant association or person is competent to certify and that the registration will be to



the public advantage. The Government of India should be the final authority on this question and should have power to cancel registration if at any time it appears to them that the registered proprietor is incompetent to certify or that the use of the certification mark is not to the interests of the public. The Act should also provide that registration be limited to non-trading bodies which will be guided by national as distinguished from sectional or communal interests. As bodies eligible to register certification marks we may cite the instances of the Institution of Engineers (India) and the Indian Stores Department.

**XIV. Duration of registration.**—In Great Britain the registration is in the first instance for a period of 14 years (Sec. 28) and can be renewed for a period of 14 years from the expiration of the original registration or of the last renewal of registration. (Sec. 29). In his evidence before the Goschen Committee Dr. Lindley advocated the adoption of a shorter period. He said that many of the trade marks which were registered ceased to be used after a year or two but nevertheless remained on the Register to the embarrassment of future applicants for similar marks. It would be useful, "in order the sooner to clear the Register of such marks, if registration, at all events in the first instance, were for a shorter period than fourteen years." The Chartered Institute of Patent Agents took the same view and pointed out the advantages of clearing the register of dead marks. The Goschen Committee have recommended that the period of first registration be reduced to seven years and the period between renewals be retained at 14 years.

The adoption in India of a shorter period of duration of registration will be a great advantage as several of the trade marks will be owned by petty traders who may drop them off after a few years' use. Ten years will not be an unduly long period of duration for the first registration. The period is 15 years in France and Canada, and 20 years in the United States, Japan and China. On the other hand, the period is ten years in most of the other countries, (*e.g.*), Germany, Austria, Hungary, Norway, Sweden; Russia, Latvia, Denmark, Greece, Portugal, Czechoslovakia, Belgium, Persia, Siam, Bulgaria, Poland and the South American States.<sup>2</sup> The renewal period in India may also be fixed at ten years.

**XV. Status of unrenewed trade marks.**—Section 31 of the British Act provides that, where a mark has been removed

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(2) See Appendix XIV.

from the Register for non-payment of the renewal fee, such mark shall nevertheless be deemed to be a registered mark for the purpose of any application for registration during one year next after the date of such removal. It may be provided in the Indian Act on the lines of Sec. 31, that an unrenewed mark shall be cited for one year against new applications.

**XVI. Correction and rectification of Register.**—A Registration Act should provide that registration once granted may be modified or cancelled whenever circumstances demand such a step. According to the English Act, a registered proprietor of a trade mark may be allowed to add or alter the same in a manner which does not substantially alter the identity of the mark. (Sec. 34). He may also be allowed to have the mark removed from the Register if it is not in use or ask that the registration shall be limited to particular goods on which the mark is used and not to extend to all goods for which registration was originally granted. Similarly, on the application of any person aggrieved the court may pass an order for expunging or varying entries in the Register of trade marks. Again, in case of fraud in the original registration or transmission the Registrar may himself apply to the court for rectification of the Register. (Sec. 35). Similar provisions may be made in the Indian Act. In order to avoid conflicting decisions it may be necessary to provide that an application for the rectification of the Register may be filed only before the Federal Court or any High Court or other court constituted for this purpose by the Federal Court.

**XVII. Non-user.**—The principle on which trade mark registration is granted is that the owner of the mark is already using the mark or intends to use it on his goods in the immediate future.\* The object will be defeated if the mark is allowed to be on the register for an indefinite period without being used. The mark will then be only blocking the Register and be embarrassing to the other traders. Section 37 of the English Act<sup>3</sup> provides that on application made by any aggrieved person a registered trade mark may be struck off the Register in respect of any of the goods for which it is registered on the ground that it was registered by the proprietor without any *bona fide* intention to use the same in connection with his goods and that there has been in fact no *bona fide* user of the same in connection with such goods during the five years immediately preceding the application for removal,

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(3) For amendments proposed by the Goschen Committee, *See* paras. 169 and 170 of their report.

unless such non-user is shown to be due to special circumstances in the trade. A provision of this nature will prevent traders from registering trade marks merely with the object of hampering other traders in the choice of trade marks. Where defensive registration is granted this provision cannot obviously apply.

**XVIII. Unregistered trade marks.**—It must be specifically provided in the legislation that nothing in the Act shall be deemed to affect the existing rights of trade mark owners under the common law. The right to an action for passing off and the remedies in respect thereof under the Common Law shall not be affected by registration.

**XIX. Defensive Registration.**—It was urged before the Goschen Committee by Mr. Evans Jackson<sup>4</sup> appearing for the London Chamber of Commerce, that “where a trade mark has become identified with the proprietor to such an extent that the use of the mark by others on any goods is calculated to cause members of the public to think that there may be connection between the goods in question and the proprietor of the mark, such marks should be registrable as a general trade mark for all goods.” He agreed that surnames or geographical names were ineligible for this type of registration. But marks, which have become household words, as for instance, ‘Kodak’, ‘Bovril,’ ‘Izal’ ‘Glaxo’ and ‘Hovis’ or devices such as ‘Players’ or ‘Johnnie Walker’ would be suitable for such registration. In the course of examination Dr. Lindley pointed out that the granting of general registration to devices would be difficult and embarrassing to traders and that such registration if given at all, should be confined to invented words of world-wide reputation. The Committee accepted this suggestion and have recommended that provision may be made for this type of registration, such marks being termed “defensive trade marks”.<sup>5</sup> Registration may be granted for any or all classes of goods and will not be subject to cancellation on the ground of non-user. For the purposes of assignment these marks will be governed by the provisions for ‘Associated trade marks’ and shall be assignable as a whole.

This new type of registration is beset with grave difficulties. To determine whether a mark has acquired sufficient reputation to entitle it to general registration is not an easy matter, and depends largely on the discretion of the Registrar. The privilege may be claimed for practically every invented word, and if granted

(4) Minutes of Evidence, pp. 33-37.

(5) See Goschen Committee Report, paras 73-77, pp. 21-22.

freely may block the entire Register. A similar thing happened in Canada where any trade mark could formerly be registered as a general mark for all classes of goods on payment of an extra fee, and the practice had to be abandoned. A second difficulty is that, although the word in question is an invented one and distinctive for the particular class of goods for which it was originally registered it may come very near a descriptive word for an entirely different class of goods. For instance, the word "Orlwoola" may be considered as an invented word and distinctive for steam boilers but not for woollen goods. This necessitates a thorough examination of the word in question in relation to every conceivable description of goods. Thirdly, the mark for which defensive registration is sought may be identical with or closely similar to one already registered in a different class of goods by another person and is, therefore, likely to be confused in respect of such goods. The prior registrant in this class of goods will be aggrieved when the owner of the defensive trade mark commences to manufacture the same goods. In such cases defensive registration cannot be granted to cover all classes of goods.

As against these difficulties it may be claimed in support of defensive registration that it is unfair to the owner of a well-known trade mark that he has no effective remedy against piracy of his mark. An unscrupulous trader may use it on goods not covered by the class or classes in which registration has been obtained. Such unfair use of the trade mark may bring the mark into disrepute and thus cause injury to its owner. The grant of defensive registration would give the owners of valuable trade marks the protection they deserve. Further, in the event of defensive registration being confined to invented words it would not deprive other traders of their freedom in choosing their marks. After all, the claim of the person for the exclusive use of the word he had invented and made popular is justifiable on grounds of equity. The future Indian Act may, therefore, provide for the registration of defensive marks in very exceptional cases where the mark in question is specially qualified for this privilege. Suitable safeguards will be necessary to ensure that this new type of registration does not tend to block the Trade mark register. The grant of such registration must be entirely at the discretion of the Registrar.

**XX. Old marks.**—The position of trade marks already in existence at the time when the Trade Marks Act comes into force, would require special consideration. Several of these are good

trade marks with inherent distinctiveness and can, therefore, be registered. Difficulty will, however, arise in regard to marks that are not sufficiently distinctive for registration. A special provision will have to be made in the Act extending the benefit of registration to these non-registrable marks, provided the registration is applied for and refused within a specified period (say 10 years) after the passing of the Act. Under the English law "old marks" are put in a special position as to their registrability and have sometimes been allowed registration although new marks would be refused registration in similar circumstances.

**XXI. Cotton marks.**—Some of the difficulties of registration of cotton marks have already been pointed out in Chapter III and a tentative scheme has been put forward for dealing with textile marks seeking registration immediately after the Trade Marks Act comes into force. It was pointed out that in England line headings were excluded from registration in cotton classes as these marks were so numerous and the differences between them were so negligible that it was practically impossible to classify them. The position in India would be more or less similar in this respect and it would be desirable to insert in the Indian Act a section for excluding registration of line headings in cotton classes on the lines of the English statute. Registration of word marks for cotton goods was formerly refused in England but the sub-section relating thereto has been subsequently repealed by the Amendment Act of 1919. Exclusion of word marks from registration in the cotton classes would entail great hardship to traders in India. These are quite popular and their classification does not involve the same difficulty as in the case of line headings. Exclusive rights in such marks have in many cases been recognised by the Indian courts. The Indian Act should not, therefore, exclude word marks from registration in the cotton classes provided the marks otherwise satisfy the requirements of the Act.

In this connection it may be mentioned that the Bombay Mill Owners' Association have framed certain rules for the purposes of registration of trade names in their Register. Rule No. 3 defines registrable trade names, and Rule No. 4 specifies the types of words which shall not be registrable.<sup>6</sup> The restrictions on registration

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(6) "Rule No. 3.—For the purposes of these Rules a registrable trade name shall be:—

. (a) An invented word or words printed or written in English characters; or

of trade names contained in the latter rule appear, however, to be somewhat severe. For instance, the names of gods and goddesses, the names of mythological persons, monograms, words describing scenes from scriptures or mythology of any religion whatever, are not registrable as trade names.

A refused list may be maintained of cotton marks that have been in actual use by the applicant or his predecessors in business prior to the date of application and have been refused registration. A fee may be charged for keeping such marks on this list and a search may be made in this list also in the case of cotton marks seeking registration. The refused list should also be open to public inspection.

**XXII. Trade Marks Law a federal subject.**—The advantages of making trade marks law a federal subject are too obvious and the disadvantages of making it a non-federal subject are too

- (b) An English Dictionary word or words having no direct reference to the character, quality, design, colour, border or dimensions of the cloth on which it is used; or
- (c) An Indian Vernacular Dictionary word or words having no direct reference to the character, quality, design, colour, border or dimensions of the cloth on which it is used.

Provided that such vernacular word or words shall only be used in the vernacular or vernaculars from which it|they is|are taken and shall be recorded in the Trade Names Registers of the Association (phonetic spelling) in English characters.”

Rule No. 4.—“Notwithstanding anything contained in the foregoing Rules, the following types of words shall not be registrable:—

- (a) Personal names.
- (b) Geographical Names.
- (c) Mis-spelt Words.
- (d) Names of Gods and Goddesses.
- (e) Names of mythological persons.
- (f) Word or Words describing scenes from scriptures or mythology of any religion whatsoever.
- (g) Word or words likely to offend religious susceptibilities.
- (h) Indecent or obscene word or words.
- (i) Trade names known to be current on imported goods.
- (j) Recognized textile terms, for example, African Domestics, Alhambra Quiltings, etc.
- (k) Word or words already registered with the Association as the name of a trade mark.
- (l) Monograms.
- (m) Names or colourable imitations of names of Indian Mills.
- (n) Colourable imitations of letter combinations already registered with the Association as trade numbers.”

numerous to call for any discussion. Indeed, this question does no longer arise as according to the present Government of India Act, patents, designs and trade marks have already been included as a federal subject.<sup>7</sup> This is in conformity with the present practice in several federal countries. In Australia the separate States had their own trade marks laws up to 1905 when a new Act had to be passed for the whole Commonwealth replacing the separate state laws.<sup>8</sup>

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(7) Government of India Act (1935), Seventh Schedule (Federal Legislative List), Article 27.

(8) A more complicated system prevails in the United States where side by side with separate state laws there is a federal Act for the whole country. Jurisdiction between the State Courts and the Federal Courts is divided and is often confusing to the parties seeking redress.

## APPENDIX I.

### THE INDIAN MERCHANDISE MARKS ACT, 1889.

ACT NO. IV OF 1889.<sup>1</sup>

[1st March, 1889.]

AN ACT TO AMEND THE LAW RELATING TO FRAUDULENT MARKS ON  
MERCHANDISE.

[As modified up to the 1st August, 1908.]

WHEREAS it is expedient to amend the law relating to fraudulent marks on merchandise; It is hereby enacted as follows:—

Title, extent and commencement. 1. (1) This Act may be called THE INDIAN MERCHANDISE MARKS ACT, 1889.

(2) It extends to the whole of British India; and<sup>2\*</sup> \* \*

(3) It shall come into force on the first day of April, 1889.

Definitions. 2. In this Act, unless there is something repugnant in the subject or context,—

(1) “trade mark” has the meaning assigned to that expression in Sec. 478 of the <sup>3</sup>Indian Penal Code as amended by this Act:

(2) “trade description”<sup>4</sup> means any description, statement or other indication, direct or indirect,—

(a) as to the number, quantity, measure, gauge or weight of any goods, or

(1) For Statement of Objects and Reasons, see Gazette of India, 1888, Pt. V, p. 109; for Report of the Select Committee, see *ibid.*, 1889, Pt. V, p. 27; and for Proceedings in Council, see *ibid.*, 1888, Pt. VI, pp. 111 and 136, and *ibid.*, 1889, Pt. VI, p. 38.

(2) The words “subject to the provision of the last section of this Act” were repealed by the Indian Merchandise Marks and Sea Customs Acts Amendment Act, 1891 (IX of 1891), Sec. 1, General Acts, Vol. VI.

(3) For Act 45 of 1860, see the revised edition, as modified up to 1st April, 1903.

(4) Cf. the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 3 (1)].



- (b) as to the place or country in which, or the time at which, any goods were made or produced, or
  - (c) as to the mode of manufacturing or producing any goods, or
  - (d) as to the material of which any goods are composed, or
  - (e) as to any goods being the subject of an existing patent, privilege or copyright; and the use of any numeral, word or mark which according to the custom of the trade is commonly taken to be an indication of any of the above matters shall be deemed to be a trade description within the meaning of this Act:
- (3) "false trade description" means a trade description which is untrue in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement or otherwise, where that alteration makes the description untrue in a material respect, and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being a false trade description within the meaning of this Act:
- (4) "goods" means anything which is the subject of trade or manufacture: and
- (5) "name" includes any abbreviation of a name.

*Amendment of the Indian Penal Code.*

Substitution of new sections for Sec. 478 to 489 of the Indian Penal Code.

3. For that part of Chapter XVIII of the Indian Penal Code which relates to Trade and Property Marks, the following shall be substituted, namely:—

*"Of Trade, Property and other Marks."*

"478. A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purposes of this Code the expression 'trade mark' includes any trade mark which is registered in the register of trade marks kept under the

(5) For Act XLV of 1860, see the revised edition, as modified up to 1st April, 1903.

(6) Cf. the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 3 (1)].

Patents, Designs and Trade Marks Act, 1883, and any trade mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the one hundred and third section of the Patents, Designs and Trade Marks Act, 1883, are, under Order in Council, for the time being applicable.

“479. A mark used for denoting that  
 ‘Property mark      moveable property belongs to a particular person is called a property mark.

“480. Whoever marks any goods or any case, package or other receptacle containing goods, or uses  
 Using a false trade mark.      any case, package or other receptacle with any mark thereon, in a manner reasonably calculated to cause it to be believed that the goods so marked, or any goods contained in any such receptacle so marked, are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

“481. Whoever marks any moveable property or goods or any case, package or other receptacle  
 Using a false property mark.      containing moveable property or goods, or uses any case, package or other receptacle having any mark thereon in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belong to a person to whom they do not belong, is said to use a false property mark.

“482. Whoever uses any false trade mark or any false  
 Punishment for using a false trade mark or property mark.      property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.

“483. Whoever counterfeits any trade mark or property  
 Counterfeiting a trade mark or property mark used by another.      mark used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with fine, or with both.

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(7) For list of Possessions and States to which 46 & 47 Vict., c. 57, has been applied, see List of General Rules and Orders in force in British India, p. 13.

**“484.** Whoever counterfeits any property mark used by a public servant, or any mark used by a public servant to denote that any property has been manufactured by a particular person or at a particular time or place or that the property is of a particular quality or has passed through a particular office or that it is entitled to any exemption, or uses as genuine any such mark knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to three years, and shall also be liable to fine.

**“485.** Whoever makes or has in his possession any die, plate or other instrument for the purpose of counterfeiting a trade mark or property mark or has in his possession a trade mark or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.

**“486.** Whoever sells, or exposes or has in possession for sale or any purpose of trade or manufacture, any goods or things with a counterfeit trade mark or property mark affixed to or impressed upon the same or to or upon any case, package or other receptacle in which such goods are contained, shall, unless he proves—

(a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and

(b) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or

(c) that otherwise he had acted innocently, be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.

**“487.** Whoever makes any false mark upon any case, package or other receptacle containing goods, in a manner reasonably calculated to cause any public servant or any other person to believe that such receptacle contains goods which it does not contain or that it does not contain goods which it does contain or that the goods contained in such receptacle are of a nature or quality different from the real nature or quality thereof shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both.

**“488.** Whoever makes use of any such false mark in any manner prohibited by the last foregoing section shall, unless he proves that he acted without intent to defraud, be punished as if he had committed an offence against that section.

**“489.** Whoever removes, destroys, defaces or adds to any property mark, intending or knowing it to be likely that he may thereby cause injury to any person, shall be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both.”

#### *Trade Descriptions.*

**\*4.** (1) The provisions of this Act respecting the application of a false trade description to goods or respecting goods to which a false trade description is applied, shall extend to the application to goods of any such numerals, words or marks, or arrangement or combination thereof, whether including a trade mark or not, as are or is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are, and to goods having such numerals, words or marks, or arrangement or combination, applied thereto.

**\* (2)** The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a

(8) *Cf.* the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 3 (2)], and Wright thereon, pp. 16 and 38.

(9) *Cf.* the Merchandise Marks Act, 1887 [50 & 51, Vict., c. 28, Sec. 3 (3)].

false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means as applied to any goods any name or initials—

- (a) not being a trade mark, or part of a trade mark, and
- (b) being identical with, or a colourable imitation of, the name or initials of a person carrying on business in connection with goods of the same description and not having authorized the use of such name or initials.

(3) A trade description which denotes or implies that there are contained in any goods to which it is applied more yards, feet or inches than there are contained therein standard yards, standard feet or standard inches is a false trade description.

**Application of trade descriptions.**      105. (1) A person shall be deemed to apply a trade description to goods who—

- (a) applies it to the goods themselves, or
- (b) applies it to any covering label, reel or other thing in or with which the goods are sold or are exposed or had in possession for sale or any purpose of trade or manufacture, or
- (c) places, encloses or annexes any goods which are sold, or are exposed or had in possession for sale or any purpose of trade or manufacture, in, with or to any covering, label, reel or other thing to which a trade description has been applied, or
- (d) uses a trade description in any manner reasonably calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade description.

(2) A trade description shall be deemed to be applied whether it is woven, impressed or otherwise worked into or annexed or affixed to the goods or any covering, label, reel or other thing.

(3) The expression “covering” includes any stopper, cask, bottle, vessel, box, cover, capsule, case; frame or wrapper, and the expression “label” includes any band or ticket.

<sup>11</sup>6. If a person applies a false trade description to goods he shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be punished with imprisonment for a term which may extend to three months or with fine which may extend to two hundred rupees, and in the case of a second or subsequent conviction with imprisonment which may extend to one year, or with fine, or with both.

Penalty for applying a false trade description.

7. If a person sells, or exposes or has in possession for sale or any purpose of trade or manufacture, any goods or things to which a false<sup>12</sup> trade description is applied, he shall, unless he proves—

(a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade description, and

(b) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or

(c) that otherwise he had acted innocently, be punished with imprisonment for a term which may extend to three months or with fine which may extend to two hundred rupees, and in case of a second or subsequent conviction with imprisonment which may extend to one year, or with fine, or with both.

*Unintentional Contravention of the Law relating to marks and Descriptions.*

<sup>13</sup>8. Where a person is accused under Sec. 482 of the Indian Penal Code<sup>14</sup> of using a false trade mark or property mark by reason of his having applied a mark to any goods, property or

(11) Cf. the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 2 (1)].

(12) For instructions as to prosecutions under Secs. 6 and 7 for offences relating to short reeling of yarn in Indian mills, see Resolution by the Department of Commerce and Industry, Nos. 2843-2856-4, dated the 14th April, 1906, Bom. Govt. Gazette, 1906, Pt. I, p. 487.

(13) Cf. the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 6].

(14) For Act XLV of 1860, see the revised edition, as modified up to 1st April, 1903.

receptacle in the manner mentioned in Sec. 480 or Sec. 481 of that Code, as the case may be, or under Sec. 6 of this Act of applying to goods any false trade description, or under Sec. 485 of the Indian Penal Code of making any die, plate or other instrument for the purpose of counterfeiting a trade mark or property mark, and proves—

- (a) that in the ordinary course of his business he is employed, on behalf of other persons, to apply trade marks or property marks, or trade descriptions, or, as the case may be, to make dies, plates or other instruments for making, or being used in making, trade marks or property marks, and that in the case which is the subject of the charge he was so employed and was not interested in the goods or other thing by way of profit or commission dependent on the sale thereof, and
- (b) that he took reasonable precautions against committing the offence charged, and
- (c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark or description, and
- (d) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons on whose behalf the mark or description was applied,

he shall be acquitted.

### *Forfeiture of Goods.*

<sup>159.</sup> (1) When a person is convicted under Sec. 482 of the Indian Penal Code<sup>16</sup> of using a false trade mark, or under Sec. 486 of that Code of selling, or exposing or having in possession for sale or any purpose of trade or manufacture, any goods or things with a counterfeit trade mark applied thereto, or under Sec. 487 or Sec. 488 of that Code of making, or making use of, a false mark, or under Sec. 6 or Sec. 7 of this Act of applying a false trade description to goods, or of selling, or exposing or having in possession for sale or any purpose of trade or manufacture, any

(15) *Cf.* the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 2 (3) (*ibid*)].

(16) For Act 45 of 1860, *see* the revised edition, as modified up to 1st April, 1903.

goods or things to which a false trade description is applied, or is acquitted on proof of the matter or matters specified in Sec. 486 of the Indian Penal Code or Sec. 7 or Sec. 8 of this Act, the Court convicting or acquitting him may direct the forfeiture to Her Majesty of all goods and things by means of, or in relation to, which the offence has been committed or, but for such proof as aforesaid, would have been committed.

(2) When a forfeiture is directed on a conviction and an appeal lies against the conviction, an appeal shall lie against the forfeiture also.

(3) When a forfeiture is directed on an acquittal and the goods or things to which the direction relates are of value exceeding fifty rupees, an appeal against the forfeiture may be preferred, within thirty days from the date of the direction, to the Court to which in appealable cases appeals lie from sentences of the Court which directed the forfeiture.

*Amendment of the Sea Customs Act, 1878.*

Amendment of <sup>17</sup>10. (1) For Clause (d) of Sec. 18 of Sec. 18, Act VIII of the <sup>18</sup>Sea Customs Act, 1878, the following 1878. shall be substituted, namely:—

“(d) goods having applied thereto a counterfeit trade mark within the meaning of the Indian Penal Code,<sup>19</sup> or a false trade description within the meaning of the Indian Merchandise Marks Act, 1889:

(e) goods made or produced beyond the limits of the United Kingdom and British India and having applied thereto any name or trade mark being, or purporting to be, <sup>20</sup>. . . the name or trade mark of any person who is a manufacturer, dealer or trader in the United Kingdom or in British India unless—

(i) the name or trade mark is, as to every application thereof, accompanied by a definite indication of

(17) Cf. the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 16 (2)].

(18) For Act 8 of 1878, see the revised edition, as modified up to 1st June, 1908.

(19) For Act 45 of 1860, see the revised edition, as modified up to 1st April, 1903.

(20) The words “or being a colourable imitation of” were repealed by the Sea Customs (Amendment) Act, 1904 (16 of 1904).



the goods having been made or produced in a place beyond the limits of the United Kingdom and British India, and

- (ii) <sup>21</sup>[the country in which that place is situated is] in that indication indicated in letters as large and conspicuous as any letter in the name or trade mark, and in the same language and character as the name or trade mark.”

(2) To Section 18 of the <sup>22</sup>Sea Customs Act, 1878, as amended by sub-Sec. (1), the following shall be added, namely:—

“(f) piece-goods, such as are ordinarily sold by length or by the piece, which—

- (i) have not conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece, and
- (ii) have been manufactured beyond the limits of India, or,
- (iii) having been manufactured within those limits have been manufactured beyond the limits of British India in premises which, if they were in British India, would be a factory as defined in the <sup>23</sup>Indian Factories Act, 1881.”

11. The following shall be added after section after Sec. 19, Act VIII of 1878, XV of 1881, Sec. 19 of the <sup>22</sup>Sea Customs Act, 1878, namely:—

<sup>24</sup>“19-A. (1) Before detaining any such goods as are or may be specified in or under Sec. 18 or Sec. 19, as the case may be, or taking any further proceedings with a view to the confiscation thereof under this Act, the Chief Customs officer or other officer appointed by the Local Government in this behalf may require the regulations under this section, whether as to information, security,

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(21) These words were substituted for the words “that place and the country in which it is situated are” by the Indian Merchandise Marks and Sea Customs Acts Amendment Act, 1891 (9 of 1891), Sec. 3, General Acts, Vol. VI.

(22) For Act 8 of 1878, *see* the revised edition, as modified up to 1st June, 1908.

(23) For Act 15 of 1881, *see* the revised edition, as modified up to 1st December, 1904.

(24) *Cf.* the Merchandise Marks Act, 1887 [50 & 51 Vict., c. 28, Sec. 16 (2), (3), (4), (5), (7) and (8)].

conditions or other matters, to be complied with and may satisfy himself in accordance with those regulations that the goods are such as are prohibited to be imported.

(2) The Governor-General in Council may make <sup>25</sup>regulations, either general or special, respecting the detention and confiscation of goods the importation of which is prohibited, and the conditions, if any, to be fulfilled before such detention and confiscation, and may by such regulations determine the information, notices and security to be given, and the evidence requisite for any of the purposes of this section and the mode of verification of such evidence.

(3) Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in the United Kingdom or British India, that name, unless accompanied in equally large and conspicuous letters, and in the same language and character, by the name of the country in which such place is situate, shall be treated for the purposes of Secs. 18 and 19 as if it were the name of a place in the United Kingdom or British India.

(4) Such regulations may apply to all goods the importation of which is prohibited by Sec. 18 or under Sec. 19, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

(5) The regulations may provide for the informant reimbursing any public officer and the Secretary of State for India in Council all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

(6) All regulations under this section shall be published in the Gazette of India and in the Calcutta, Fort St. George, Bombay and Burma Gazettes."

*Stamping of Length of Piece-goods manufactured in  
British India.*

Stamping of length  
of piece-goods manu-  
factured in British  
India.

12. (1) Piece-goods, such as are ordinarily sold by length or by the piece, which have been manufactured in premises which are a factory as defined in the 'Indian

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(25) For such Regulations, see General Statutory Rules and Orders, Vol. I, p. 378, and Gazette of India, 1907, Pt. I, p. 401.

(1) For Act 15 of 1881, see the revised edition, as modified up to the 1st December, 1904.

Factories Act, 1881, shall not be removed from those premises without having conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece.

(2) If any person removes or attempts to remove any such piece-goods from any such premises without the length of each piece being stamped in the manner mentioned in sub-Sec. (1), every such piece, and everything used for the packing or removal thereof, shall be forfeited to Her Majesty, and such person shall be punished with fine which may extend to one thousand rupees.

### *Supplemental Provisions.*

**Evidence of origin of goods imported by sea.** \*13. In the case of goods brought into British India by sea, evidence of the port of shipment shall, in a prosecution for an offence against this Act or Sec. 18 of the Sea Customs Act, 1878, as amended by this Act, be *prima facie* evidence of the place or country in which the goods were made or produced.

**Costs of defence or prosecution.** \*14. (1) On any such prosecution as is mentioned in the last foregoing section, or on any prosecution for an offence against any of the sections of the Indian Penal Code,<sup>5</sup> as amended by this Act, which relate to trade, property and other marks, the Court may order costs to be paid to the defendant by the prosecutor or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively.

(2) Such costs shall, on application to the Court, be recoverable as if they were a fine.

**Limitation of prosecution.** \*15. No such prosecution as is mentioned in the last foregoing section shall be commenced after the expiration of three years next after the commission of the offence, or one year after

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(2) *Cf.* the Merchandise Marks Act, 1887 [50 & 51 Viet., c. 28, Sec. 10 (2)].

(3) For Act 8 of 1878, *see* the revised edition, as modified up to 1st June, 1908.

(4) *Cf.* the Merchandise Marks Act, 1887 (50 & 51 Viet., c. 28, Sec. 14).

(5) For Act 45 of 1860, *see* the revised edition, as modified up to 1st April, 1903.

(6) *Cf.* the Merchandise Marks Act, 1887 (50 & 51 Viet., c. 28, Sec. 15).

the first discovery thereof by the prosecutor, whichever expiration first happens.

Authority of the Governor-General in Council to issue instructions as to administration of this Act.

16. (1) The Governor-General in Council may, by notification in the Gazette of India and in local official Gazettes, issue instructions for observance by Criminal Courts in giving effect to any of the provisions of this Act.

(2) Instructions under sub-Sec. (1) may provide, among other matters, for the limits of variation, as regards number, quantity, measure, gauge or weight, which are to be recognized by Criminal Courts as permissible in the case of any goods.

Implied warranty on sale of marked goods.

\*17. On the sale or in the contract for the sale of any goods to which a trade mark or mark or trade description has been applied, the seller shall be deemed to warrant that the mark is a genuine mark and not counterfeit or falsely used, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the seller and delivered at the time of the sale or contract to and accepted by the buyer.

Savings.

\*18. (1) Nothing in this Act shall exempt any person from any suit or other proceeding which might, but for anything in this Act, be brought against him.

(2) Nothing in this Act shall entitle any person to refuse to make a complete discovery or to answer any question or interrogatory in any suit or other proceeding, but such discovery or answer shall not be admissible in evidence against such person in any such prosecution as is mentioned in Sec. 14.

(3) Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in British India who in good faith acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master and as to the instructions which he has received from his master.

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(7) For such instructions, see General Statutory Rules and Orders, Vol. II, p. 1245.

(8) Cf. the Merchandise Marks Act, 1887 (50 & 51 Vict., c. 28, Sec. 17).

(9) Cf. the Merchandise Marks Act, 1887 (50 & 51 Vict., c. 28, Sec. 19).

19. [*Date of commencement of this Act as regards unstamped piece-goods.*] *Rep. Act IX of 1891.*<sup>10</sup>

<sup>11</sup>19. For the purposes of Sec. 12 of this Act and Clause (f) of Sec. 18 of the *Definition of piece-goods.*  
<sup>12</sup>Sea Customs Act, 1878, as amended by this Act, the Governor-General in Council may, by <sup>13</sup>notification in the Gazette of India, declare what classes of goods are included in the expression 'piece-goods, such as are ordinarily sold by length or by the piece.'

<sup>11</sup>20. (1) The Governor-General in Council may <sup>13</sup>make rules, for the purposes of this Act, to provide, with respect to any goods which purport or are alleged to be of uniform number, quantity, measure, gauge or weight, for the number of samples to be selected and tested and for the selection of the samples.

(2) With respect to any goods for the selection and testing of samples of which provision is not made in any rules for the time being in force under sub-Sec. (1), the Court or officer of customs, as the case may be, having occasion to ascertain the number, quantity, measure, gauge or weight of the goods, shall, by order in writing, determine the number of samples to be selected and tested and the manner in which the samples are to be selected.

(3) The average of the results of the testing in pursuance of rules under sub-Sec. (1) or of an order under sub-Sec. (2) shall be *prima facie* evidence of the number, quantity, measure, gauge or weight, as the case may be, of the goods.

(4) If a person having any claim to, or in relation to, any goods of which samples have been selected and tested in pursuance of rules under sub-Sec. (1) or of an order under sub-Sec. (2) desires that any further samples of the goods be selected and tested, they shall, on his written application and on the payment in advance by him to the Court or officer of customs, as the case

(10) The heading to this section, namely, "Transitory Provision" was repealed at the same time by S. 2 of Act 9 of 1891.

(11) Sections 19 to 22 here printed were added by the Indian Merchandise Marks and Sea Customs Acts Amendment Act, 1891 (9 of 1891), Sec. 4, General Acts, Vol. VI.

(12) For Act 8 of 1878, see the revised edition, as modified up to 1st June, 1908.

(13) For rules and orders in respect of piece-goods and yarns, see General Statutory Rules and Orders, Vol. II, p. 1247.

may be, of such sums for defraying the cost of the further selection and testing as the Court or officer may from time to time require, be selected and tested to such extent as may be permitted by rules to be made by the Governor-General in Council in this behalf or as, in the case of goods with respect to which provision is not made in such rules the Court or officer of customs may determine in the circumstances to be reasonable, the samples being selected in manner prescribed under sub-Sec. (1), or in sub-Sec. (2), as the case may be.

(5) The average of the results of the testing referred to in sub-Sec. (3) and of the further testing under sub-Sec. (4) shall be conclusive proof of the number, quantity, measure, gauge or weight, as the case may be, of the goods.

(6) Rules under this section shall be made after previous publication.

**Information as to commission of offences.** <sup>14</sup>**21.** An officer of the Government whose duty it is to take part in the enforcement of this Act shall not be compelled in any Court to say whence he got any information as to the commission of any offence against this Act.

**Punishment of abetment in India of acts done out of India.** <sup>14</sup>**22.** If any person, being within British India, abets the commission, without British India, of any act which, if committed in British India,<sup>15</sup> would under this Act, or under any section of that part of Chapter XVIII of the Indian Penal Code which relates to trade, property and other marks, be an offence, he may be tried for such abetment in any place in British India in which he may be found, and be punished therefor with the punishment to which he would be liable if he had himself committed in that place the act which he abetted.

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(14) See foot-note 11 on p. 592, *supra*.

(15) See Sec. 108-A, of the Indian Penal Code (Act 45 of 1860), as modified up to 1st April, 1903.

## APPENDIX II.

### THE SEA CUSTOMS ACT VIII OF 1878.

#### CHAPTER IV.

#### *PROHIBITIONS AND RESTRICTIONS OF IMPORTATION AND EXPORTATION.*

Prohibitions.                      18. No goods specified in the following clauses shall be brought, whether by land or sea, into British India :—

- <sup>1</sup>(a)       \*                      \*                      \*                      \*                      \*
- (b) Counterfeit coin; or coin which purports to be Queen's coin of India, or to be coin made under the Native Coinage Act, 1876, but which is not of the established standard in weight or fineness.
- (c) Any obscene book, pamphlet, paper drawing, painting, representation, figure or article:
- <sup>2</sup>(d) Goods having applied thereto a counterfeit trade mark within the meaning of the Indian Penal Code, or a false trade description within the meaning of the Indian Merchandise Marks Act, 1889.
- (e) Goods made or produced beyond the limits of the United Kingdom and British India and having applied thereto any name or trade mark being, or purporting to be
- \*                      \*                      \*                      \*                      \*
- the name
- or trade mark of any person who is a manufacturer, dealer or trader in the United Kingdom or in British India, unless—
- (i) the name or trade mark, is, as to every application thereof, accompanied by a definite indication of the goods having been made or produced in a place beyond the limits of the United Kingdom and British India, and

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(1) Clause (a) was repealed by the Indian Copy-right Act 1914 (3 of 1914).

(2) The Cls. (d) & (e) were substituted by Sec. 10 (1) of the Merchandise Marks Act, 1889.

(ii) (the country in which that place is situated is) in that indication indicated in letters as large and conspicuous as any letter in the name or trade mark, and the same language and character as the name or trade mark."

<sup>3</sup>(f) Piece-goods, such as are ordinarily sold by length or by the piece, which—

(i) have not conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece, and

(ii) have been manufactured beyond the limits of India, or

(iii) having been manufactured within those limits have been manufactured beyond the limits of British India in premises which, if they were in British India, would be a factory as defined in the Indian Factories Act, 1881.

<sup>4</sup>(g) Matches made with white phosphorus.

#### ***POWER TO PROHIBIT OR RESTRICT IMPORTATION OR EXPORTATION OF GOODS.***

**19.** The Governor-General-in-Council may from time to time, by notification in the Gazette of India,<sup>5</sup> prohibit or restrict the bringing or taking by sea or by land goods of any specified description into or out of British India,<sup>6</sup> or any specified part thereof, either generally or from or to any specified country region, port or place beyond the limits of British India.

**19-A.** See Sec. 11 of Merchandise Marks Act, 1889, (*Vide* Appendix I, page 588).

(3) Clause (f) was added by Sec. 10 (2) of the Merchandise Marks Act 1889.

(4) This clause was added by Sec. 3 of the White Phosphorus Matches Prohibition Act, 1913 (5 of 1913).

(5) For list of notifications issued under Sec. 19, see Gen. R. & O. Vol. II, pp. 70 to 125.

(6) These words were substituted for the words "or any specified part of British India" by Sec. 2 of the Sea Customs Amendment Act 1914 (XII of 1914).



## APPENDIX III.

### THE TRADE MARKS ACT, 1905.

[5 EDW. 7. CH. 15.]

*An Act to consolidate and amend the Law relating to Trade Marks.* [11th August, 1905.]

Be it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Short title. 1. This Act may be cited as THE TRADE MARKS ACT, 1905.

2. This Act shall, save as otherwise expressly provided, come into operation on the first day of April one thousand nine hundred and six.

Commencement of Act.

#### PART I.

##### *Definitions.*

3. In and for the purposes of this Act (unless the context otherwise requires):—

Definitions.

A "mark" shall include a device, brand, heading, label ticket, name, signature, word, letter, numeral, or any combination thereof:

A "trade mark" shall mean a mark used or proposed to be used upon or in connexion with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale:

A "registrable trade mark" shall mean a trade mark which is capable of registration under the provisions of this Act:

"The register" shall mean the register of trade marks kept under the provisions of this Act:

A "registered trade mark" shall mean a trade mark which is actually upon the register:

“Prescribed” shall mean, in relation to proceedings before the Court, prescribed by rules of court, and in other cases, prescribed by this Act or the Rules thereunder:

“The Court” shall mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty’s High Court of Justice in England.

*Register of Trade Marks.*

4. There shall be kept at the Patent Office for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Comptroller-General of Patents, Designs, and Trade Marks, who is in this Act referred to as the Registrar.

5. There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

6. The register of trade marks existing at the date of the commencement of this Act, and all registers of trade marks kept under previous Acts, which are deemed part of the same book as such register, shall be incorporated with and form part of the register. Subject to the provisions of sections thirty-six and forty-one of this Act the validity of the original entry of any trade mark upon the registers so incorporated shall be determined in accordance with the statutes in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

7. The register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

*Registrable Trade Marks.*

Trade mark must be for particular goods. 8. A trade mark must be registered in respect of particular goods or classes of goods.

Registrable trade marks. 9. A registrable trade mark must contain or consist of at least one of the following essential particulars:—

- (1) The name of a company, individual, or firm represented in a special or particular manner;
- (2) The signature of the applicant for registration or some predecessor in his business;
- (3) An invented word or invented words;
- (4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark:

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.

For the purposes of this section “distinctive” shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

10. A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

*Registration of Trade Marks.*

12. (1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner.

(2) Subject to the provisions of this Act the Registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications.

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, or modifications, if any, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connexion with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

13. When an application for registration of a trade mark has been accepted, whether absolutely or  
 Advertisement of subject to conditions, the Registrar shall, as application.  
 soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions subject to which the application has been accepted.

14. (1) Any person may, within the prescribed time from the date of the advertisement of an appli-  
 Opposition to cation for the registration of a trade mark,  
 registration. give notice to the Registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the Court or, with the consent of the parties, to the Board or Trade.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section, the tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) The Registrar, or in the case of an appeal to the Board of Trade the Board of Trade, shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

15. If a trade mark contains parts not separately registered

Disclaimers.

by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade or the Court, in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

16. When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, unless the Board of Trade otherwise direct, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration.

17. On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar, and sealed with the seal of the Patent Office.

18. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

### *Identical Trade Marks.*

19. Except by order of the Court or in the case of trade marks in use before the thirteenth day of August one thousand eight hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive.

20. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade.

**21.** In case of honest concurrent user or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose.

#### *Assignment.*

**22.** A trade mark when registered shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connexion with any goods for which it is registered together with the goodwill of the business therein in such goods.

**23.** In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

#### *Associated Trade Marks.*

**24.** If application be made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may



require as a condition of registration that such trade marks shall be entered on the register as associated trade marks.

**25.** If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade marks separately, he may apply to register the same as separate trade marks. Each such separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

**26.** When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of—

- (a) statements of the goods for which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality, or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

**27.** Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks. Provided that where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the tribunal may if and so far as it shall think right accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

*Renewal of Registration.*

**28.** The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

Duration of registration.

**29.** The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed "the expiration of the last registration."

Renewal of registration.

**30.** At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the Registrar may remove such trade mark from the register, subject to such conditions (if any) as to its restoration to the register as may be prescribed.

Procedure on expiry of period of registration.

**31.** Where a trade mark has been removed from the register for non-payment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that there has been no *bona fide* trade user of such trade mark during the two years immediately preceding such removal.

Status of unrenewed trade mark.

*Correction and Rectification of the Register.*

**32.** The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name,—

Correction of register.

- (1) Correct any error in the name or address of the registered proprietor of a trade mark; or

- (2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or
- (3) Cancel the entry of a trade mark on the register; or
- (4) Strike out any goods or classes of goods from those for which a trade mark is registered; or
- (5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

33. Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the Registrar shall, on request made in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

34. The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Rectification of register. 35. Subject to the provisions of this Act—

- (1) The Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry, as it may think fit:
- (2) The Court may in any proceeding under this section decide any question that it may be necessary or

expedient to decide in connexion with the rectification of the register:

- (3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section:
- (4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

36. No trade mark which is upon the register at the commencement of this Act and which under this Act is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Acts then in force.

37. A registered trade mark may, on the application to the Court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bona fide* intention to use the same in connexion with such goods, and there has in fact been no *bona fide* user of the same in connexion therewith, or on the ground that there has been no *bona fide* user of such trade mark in connexion with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

#### *Effect of Registration.*

Bowers of registered proprietor.

38. Subject to the provisions of this Act—

- (1) The person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from such register to be vested in any other person, have power to assign the same, and

to give effectual receipts for any consideration for such assignment:

- (2) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

39. Subject to the provisions of section forty-one of this Act and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of such trade mark upon or in connexion with the goods in respect of which it is registered: Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

40. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the fact that a person is registered as proprietor of such trade mark shall be *prima facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

41. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connexion with goods upon or in connexion with which such person has, by himself or

his predecessors in business, continuously used such trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act.

**42.** No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark unless such trade mark was in use before the thirteenth of August one thousand eight hundred and seventy-five, and has been refused registration under this Act. The Registrar may, on request, grant a certificate that such registration has been refused.

Unregistered trade mark.

**43.** In an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connexion with such goods by other persons.

Infringement.

**44.** No registration under this Act shall interfere with any *bona fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods.

User of name, address, or description of goods.

**45.** Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

"Passing-off" action.

### *Legal Proceedings.*

**46.** In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade mark, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or

Certificate of validity.

judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court certifies that he ought not to have the same.

47. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

Registrar to have notice of proceeding for rectification.

### *Costs.*

48. In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Costs of proceedings before the Court.

### *Evidence.*

49. In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which it shall think it right so to do, the tribunal may (with the consent of the parties) take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

Mode of giving evidence.

In case any part of the evidence is taken *viva voce* the Board of Trade or the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as an Official Referee of the Supreme Court.

**50.** Printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Sealed copies to be evidence.

**51.** A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

Certificate of Registrar to be evidence.

**52.** (1) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

Certificate of Board of Trade to be evidence.

(2) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

## PART II.

### *Powers and Duties of Registrar of Trade Marks.*

**53.** Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Exercise of discretionary power by Registrar.

**54.** Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a decision of the Registrar otherwise than to the Board of Trade, but the Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section

Appeal from Registrar.



thirty-five of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

**55.** Where by this Act any act has to be done by or to any person in connexion with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with rules made under this Act or in particular cases by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

**56.** The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to His Majesty's Attorney-General or Solicitor-General for England for directions in the matter.

**57.** The Comptroller-General of Patents, Designs, and Trade Marks shall in his yearly report on the execution by or under him of the Patents, Designs, and Trade Marks Act, 1883, and Acts amending the same, include a report respecting the execution by or under him of this Act as though it formed a part of or was included in such Acts.

*Powers and Duties of the Board of Trade.*

**58.** All things required or authorised under this Act to be done by to or before the Board of Trade may be done by to or before the President or a secretary or an assistant secretary of the Board or any person authorised in that behalf by the President of the Board.

**59.** Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer any such appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

**60.** (1) Subject to the provisions of this Act the Board of Trade may from time to time make such rules, prescribe such forms, and generally do such things as they think expedient—

Power of Board of Trade to make rules.

- (a) For regulating the practice under this Act:
- (b) For classifying goods for the purposes of registration of trade marks:
- (c) For making or requiring duplicates of trade marks and other documents:
- (d) For securing and regulating the publishing and selling or distributing in such manner as the Board of Trade think fit, of copies of trade marks and other documents:
- (e) Generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar, or of the Board of Trade.

(2) Rules made under this section shall, whilst in force, be of the same effect as if they were contained in this Act.

(3) Before making any rules under this section the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained in such manner as the Board consider most expedient, so as to enable persons affected to make representations to the Board before the rules are finally settled.

(4) Any rules made in pursuance of this section shall be forthwith advertised twice in the Trade Marks Journal, and shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament.

(5) If either House of Parliament within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

#### *Fees.*

61. There shall be paid in respect of applications and registration and other matters under this Act,  
*Fees.* such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade.

*Special Trade Marks.*

62. Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connexion with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connexion with such examination and certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade.

*Sheffield Marks.*

63. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Sheffield marks. Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:—

(1) The Cutlers' Company shall continue to keep at Sheffield the register of trade marks (in this Act called the Sheffield register) kept by them at the date of the commencement of this Act, and, save as otherwise provided by this Act, such register shall for all purposes form part of the register:

(2) The Cutlers' Company shall, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks, which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in such register before the passing of this Act:

(3) An application for registration of a trade mark used on metal goods shall, if made after the commencement of this Act

by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4) Every application so made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner, and, unless the Registrar within the prescribed time gives notice to the Cutlers' Company of any objection to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the Registrar gives notice of an objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may in the prescribed manner appeal to the Court:

(6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the Registrar, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Registrar on that day:

(7) The provisions of this Act, and of any rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section (and notwithstanding anything in any Act relating to the Cutlers' Company), apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the Registrar, the Patent Office, and the Register of Trade Marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Registrar by the Cutlers' Company:

(8) When the Registrar receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Court:

(10) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal:

(11) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the Registrar.

### *Cotton Marks.*

64. (1) The Manchester Branch of the Trade Marks Registry of the Patent Office (herein-after called "the Manchester Branch") shall be continued according to its present constitution. A chief officer of the Manchester Branch shall be appointed who shall be styled "the Keeper of Cotton Marks," and shall act under the direction of the Registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks.

(2) As regards cotton goods which have hitherto constituted classes 23, 24 and 25, under the classification of goods under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Register of Trade Marks for all such goods, except such as may be prescribed, shall be called "the Manchester Register," and a duplicate thereof shall be kept at the Manchester Branch.

(3) All applications for registration of trade marks for such cotton goods in the said classes (herein-after referred to as "cotton marks") shall be made to the Manchester Branch.

(4) Every application so made to the Manchester Branch shall be notified to the Registrar in the prescribed manner together with the report of the Keeper of Cotton Marks thereon, and unless the Registrar, after considering the report and hearing, if so required, the applicant, within the prescribed time gives notice to the Keeper of Cotton Marks of objection to the acceptance of the application, it shall be advertised by the Manchester Branch and shall be proceeded with in the prescribed manner.

(5) If the Registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved may in the prescribed manner appeal to the Court or the Board of Trade, at the option of the applicant.

(6) Upon the registration of a trade mark in the Manchester Register the Keeper of Cotton Marks shall upon notice thereof from the Registrar thereupon enter the mark in the duplicate of

the Manchester Register, and such registration shall bear date as of the day of application to the Manchester Branch, and shall have the same effect as if the application had been made to the Registrar on that day.

(7) When any mark is removed from or any cancellation or correction made in the Manchester Register notice thereof shall be given by the Registrar to the Keeper of Cotton Marks, who shall alter the duplicate register accordingly.

(8) For the purpose of all proceedings in relation to trade marks entered in the Manchester Register a certificate under the hand of the Keeper of Cotton Marks shall have the same effect as a certificate of the Registrar.

(9) In every application for registration of a cotton mark, if such mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of such user shall be stated on the application.

(10) As from the passing of this Act—

(a) In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words, shall be deemed to be distinctive in respect of such goods:

(b) In respect of cotton piece goods no mark consisting of a line heading alone shall be registered, and no line heading shall be deemed to be distinctive in respect of such goods:

(c) No registration of a cotton mark shall give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

(11) The right of inspection of the Manchester Register shall extend to and include the right to inspect all applications whatsoever that have been since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester Branch in respect of cotton goods in classes 23, 24 and 25, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending.

(12) The Keeper of Cotton Marks, shall, on request, and on production of a facsimile of the mark, and on payment of the prescribed fee, issue a certified copy of the application for registration of any cotton mark, setting forth in such certificate the

length of time of user (if any) of such mark as stated on the application, and any other particulars he may deem necessary.

(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft of the same shall be sent to the Keeper of Cotton Marks and also to the Manchester Chamber of Commerce. And the said Keeper, and also the said Chamber, shall, if they or either of them so request, be entitled to be heard by the Board of Trade upon such proposed rules before the same are carried into effect.

(14) The existing practice whereby the Keeper of the Manchester Branch consults the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce upon questions of novelty or difficulty arising on applications to register cotton marks shall be continued by the Keeper of Cotton Marks.

#### *International and Colonial Arrangements.*

65. The provisions of sections one hundred and three and one hundred and four of the Patents, Designs, and Trade Marks Act, 1883 (as amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1885), relating to the registration of trade marks both as enacted in such Acts and as applied by any Order in Council made thereunder, shall be construed as applying to trade marks registrable under this Act.

#### *Offences.*

66. If any person makes or causes to be made a false entry in the register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

67. (1) Any person who represents a trade mark as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purposes of this enactment, to represent that a trade mark is registered, if he uses in connexion with the trade mark the word "registered," or any words expressing or implying that registration has been obtained for the trade mark.

*Royal Arms.*

68. If any person, without the authority of His Majesty, uses in connexion with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connexion with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

*Courts.*

69. The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to trade marks; and with reference to any such proceedings in Scotland the term "the Court" shall mean the Court of Session; and with reference to any such proceedings in Ireland the term "the Court" shall mean the High Court of Justice in Ireland.

*Isle of Man.*

70. This Act shall extend to the Isle of Man, and—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement or in any action or proceeding respecting a trade mark competent to those courts:

(2) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:



(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

71. The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Branch, have the like jurisdiction under this Act as His Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly:

Jurisdiction of  
Lancashire Palatine  
Court.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.

72. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Offences in Scot-  
land.

### *Repeals; Savings.*

73. The enactments described in the schedule to this Act are repealed to the extent mentioned in the third column, but this repeal shall not affect any rule, table or fees, or classification of goods made under any enactment so repealed, but every such rule, table of fees, or classification of goods shall continue in force as if made under this Act until superseded by rules, tables of fees, or classification under this Act.

Repeal and saving  
for rules, &c.

74. The provisions of sections eighty-two to eighty-four of the Patents, Designs, and Trade Marks Act, 1883, as amended by any subsequent enactment, shall continue to apply with respect to the administration at the Patent Office of the law relating to the registration of trade marks, and shall accordingly be construed as if this Act formed part of that Act.

Application of 46  
& 47 Vict. c. 57.  
ss. 82-84.

## SCHEDULE.

### ENACTMENTS REPEALED.

(Section 73.)

Session and Chapter	Short Title.	Extent of Repca
46 & 47 Vict c. 57.	The Patents Designs, and Trade Marks Act, 1883.	Sections sixty two to eighty one, and, so far as they respectively relate to trade marks, sections eighty-five to ninety nine, one hundred and one, one hundred and two, one hundred and five, one hundred and eight, and one hundred and eleven to one hundred and seventeen.
51 & 52 Vict c. 50.	The Patents Designs, and Trade Marks Act, 1888.	Sections eight to twenty, and so far as they respectively relate to trade marks, sections twenty one to twenty-six.

# APPENDIX IV.

## TRADE MARKS ACT, 1914.

[4 AND 5 GEO. 5. Ch. 16.]

*An Act to amend section sixty-four of the Trade Marks Act, 1905.* [7th August, 1914.]

Be it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

1. Clause (c) of sub-section (10) of section sixty-four of the Trade Marks Act, 1905, shall be and the same is hereby amended by insertion therein of the words "in respect of cotton piece goods or cotton yarn" immediately after the opening words, "No registration of a cotton mark."

Amendment of 5  
Edw. 7. c. 15. s. 64.

2. This Act shall be construed as one with the Trade Marks Act, 1905, and the said Act of 1905 shall be construed and take effect from the date of its passing as if this Act had then formed part thereof.

Construction and  
commencement of  
Act.

3. This Act may be cited as the Trade Marks Act, 1914; and the Trade Marks Act, 1905, and this Act may be cited together as the Trade Marks Acts, 1905 and 1914.

Short title.

## APPENDIX V.

### TRADE MARKS ACT, 1919.

[9 AND 10 GEO. 5, CH. 79.]

*An Act to amend the Trade Marks Act, 1905.*

[23rd December, 1919.]

Be it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

#### PART I.

##### REGISTRATION OF CERTAIN TRADE MARKS NOT REGISTRABLE UNDER PRINCIPAL ACT.

1. (1) The register of trade marks (including the Manchester Register) kept under the Trade Marks Act, 1905 (hereinafter referred to as the principal Act), shall be divided into two parts to be called respectively Part A. and Part B.
- Division of Register of trade marks into two parts.

(2) Part A. of the register shall comprise all trade marks entered in the register of trade marks at the commencement of this Act and all trade marks which after the commencement of this Act may be registered under the provisions of the principal Act.

(3) Part B. shall comprise all trade marks registered under this Part of this Act, and all trade marks entered on or removed thereto under this Act.

2.—(1) Where any mark has for not less than two years been bona fide used in the United Kingdom upon or in connection with any goods (whether for sale in the United Kingdom or exportation abroad), for the purpose of indicating that they are the goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with or offering for sale, the person claiming to be the proprietor of the mark may apply in writing to the registrar in the prescribed manner to have the mark entered as his registered trade mark in Part B. of the register in respect of such goods.

Registration of trade marks in Part B.

(2) The registrar shall consider every such application for registration of a trade mark in Part B. of the register, and if it appears to him, after such search, if any, as he may deem necessary, that the application is inconsistent with the provisions of section eleven or section nineteen of the principal Act, or if he is not satisfied that the mark has been so used as aforesaid, or that it is capable of distinguishing the goods of the applicant, he may refuse the application, or may accept it subject to conditions, amendments or modifications as to the goods or classes of goods in respect of which the mark is to be registered, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose, and in any other case he shall accept the application.

(3) Every such application shall be accompanied by a statutory declaration verifying the user, including the date of first user, and such date shall be entered on the register.

(4) Any such refusal or conditional acceptance shall be subject to appeal to the court, and, if the ground for refusal is insufficiency of evidence as to user, such refusal shall be without prejudice to any application for registration of the trade mark under the provisions of the principal Act.

(5) Every such application shall, if accepted, be advertised in accordance with the provisions of the principal Act.

(6) A mark may be registered in Part B. notwithstanding any registration in Part A. by the same proprietor of the same mark or any part or parts thereof.

3. The provisions of the principal Act, as amended by this Act, with the exception of those set out in the First Schedule to this Act, shall, subject to the provisions of this Part of this Act, apply in respect of trade marks to which this Part of this Act applies as if they were herein re-enacted and in terms made applicable to this Part of this Act.

Application of certain provisions of principal Act to Part B. trade marks.

4. The registration of a person as the proprietor of a trade mark in Part B. of the register shall be *prima facie* evidence that that person has the exclusive right to the use of that trade mark, but, in any action for infringement of a trade mark entered in Part B. of the register, no injunction, interdict or other relief shall be granted to the owner of the trade mark in respect of such registration, if the defendant establishes to the satisfaction of the court

Effect of registration in Part B.

that the user of which the plaintiff complains is not calculated to deceive or to lead to the belief that the goods the subject of such user were goods manufactured, selected, certified, dealt with or offered for sale by the proprietor of the trade mark.

5. If any person applies for the registration of a trade mark under the principal Act in Part A. of the register, the registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B. of the register under this Part of this Act and deal with the application accordingly.

Power to treat applications for registration in Part A. as applications for registration in Part B.

## PART II.

### PROVISIONS FOR THE PREVENTION OF ABUSES OF TRADE MARKS.

6.—(1) Where in the case of an article or substance manufactured under any patent in force at or granted after the passing of this Act, a word trade mark registered under the principal Act or Part I. of this Act is the name or only practicable name of the article or substance so manufactured, all rights to the exclusive use of such trade mark, whether under the common law or by registration (and notwithstanding the provisions of section forty-one of the principal Act), shall cease upon the expiration or determination of the patent, and thereafter such word shall not be deemed a distinctive mark, and may be removed by the court from the register on the application of any person aggrieved.

Removal from Register of word trade marks used as names of articles.

(2) No word which is the only practicable name or description of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark, and any such word now or hereafter on the register may, notwithstanding section forty-one of the principal Act, be removed by the court from the register on the application of any person aggrieved:

Provided that—

(a) the provisions of this sub-section shall not apply where the mark is used to denote only the proprietor's brand or make of such substance, as distinguished from the substance as made by others, and in association with a suitable and practicable name open to the public use; and

(b) in the case of marks registered before the passing of this Act, no application under this section for the removal of the mark from the register shall be entertained until after the expiration of four years from the passing of this Act.

(3) The power to remove a trade mark from the register conferred by this section shall be in addition to and not in derogation of any other powers of the court in respect of the removal of trade marks from the register.

(4) The provisions contained in Part III. of this Act authorising applications for the rectification of the register to be made in the first instance to the registrar instead of to the court shall apply to applications under this section.

### PART III.

#### GENERAL AMENDMENTS OF PRINCIPAL ACT.

7. In paragraph (5) of section nine of the principal Act (which defines the particulars which registrable trade marks must contain or consist of) for the words "except by order of the Board of Trade or the court be deemed a distinctive mark," there shall be substituted the words "be registrable under the provisions of this paragraph, except upon evidence of its distinctiveness."

8.—(1) All appeals from the decisions of the registrar under section fourteen of the principal Act shall be made to the court, and an appeal shall not lie from any such decision to the Board of Trade, and accordingly that section shall have effect, subject to the modifications set forth in the Second Schedule to this Act;

Provided that nothing in this sub-section shall affect any appeal which may be pending at the commencement of this Act.

(2) In any appeal from the decision of the registrar to the court under the principal Act or this Act the court shall have and exercise the same discretionary powers as under the principal Act or this Act are conferred upon the registrar.

9.—(1) Any application for the rectification of the register or the removal of any trade mark from the register in respect of any goods which, under section thirty-five or section thirty-seven of the principal Act or under Part II. of this Act, is to be made to

the court, may, at the option of the applicant, be made in the first instance to the registrar:

Provided that no such application shall be made otherwise than to the court where an action concerning the trade mark in question is pending.

(2) The registrar may, at any stage of the proceedings, refer any such application to the court or he may, after hearing the parties, determine the question between them, subject to appeal to the court.

(3) In any proceedings for the rectification of the register under this Act or under section thirty-five of the principal Act as amended by this section the court or the registrar shall, in addition to the powers conferred by that section as so amended, have power to direct a trade mark entered in Part A. of the register to be removed to Part B. of the register.

10. In all proceedings before the registrar under the principal Act or this Act the registrar shall have  
Costs. power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of court.

11. For section thirty-three of the  
Registration of principal Act, the following section shall be  
assignments. substituted:—

“33.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade mark, he shall make application to the registrar to register his title, and the registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade mark, and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title. Any decision of the registrar under this section shall be subject to appeal to the court.

“(2) Except in cases of appeals under this section and applications made under section thirty-five of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-Sec. (1) aforesaid shall not be admitted in evidence in any court in proof of the title to a trade mark unless the court otherwise directs.”



12. The amendments specified in the second column of the  
 Minor amendments of principal Act. Second Schedule to this Act, which relate to minor details, shall be made in the provisions of the principal Act specified in the first column of that schedule.

13.—(1) This Act may be cited as the Trade Marks Act, 1919,  
 and the Trade Marks Acts, 1905 and 1914,  
 Short title, construction, and commencement. and so much of the Patents and Designs Acts, 1907 to 1919, as relates to trade marks, and this Act may be cited together as the Trade Marks Acts, 1905 to 1919.

(2) This Act shall be construed as one with the principal Act and shall come into operation on the first day of April, nineteen hundred and twenty.

**SCHEDULES.****FIRST SCHEDULE.****PROVISIONS OF PRINCIPAL ACT NOT APPLIED.**

No. of Section.			Subject-matter.
1	..	..	Short title.
2	..	..	Commencement of Act.
6	..	..	Incorporation of existing register.
9	..	..	Registrable trade marks.
12	..	..	Application for registration.
14 (9)	..	..	Modification of trade mark on appeals.
15	..	..	Disclaimers.
24	..	..	Associated trade marks.
25	..	..	Combined trade marks.
27	..	..	Assignment and user of associated trade marks.
31	..	..	Status of unrenewed trade marks.
36	..	..	Trade marks registered under previous Acts.
39 (except proviso)	..	..	Rights of proprietor of trade mark.
41 down to the words "against the provisions of section eleven of this Act."			Registration to be conclusive after seven years.
42	..	..	Unregistered trade mark.
62	..	..	Standardization, &c., trade marks.
73	..	..	Repeal and saving for rules, &c.

## SECOND SCHEDULE.

## MINOR AMENDMENTS OF PRINCIPAL ACT.

Section Amended.	Nature of Amendment.
Section 12	<p>.. At the end of sub-Sec. (2) there shall be inserted the following words "or to such limitations, "if any, as to mode or place of user or other- "wise as he may think right to impose."</p> <p>In sub-Section (4), after the words "<b>modi-</b> "fications, if any," shall be inserted the words "or to what limitations, if any, as to mode or "place of user or otherwise."</p>
Section 13	<p>.. After the word "conditions" in both places where it occurs, there shall be inserted the words "and limitations."</p> <p>At the end of the section there shall be inserted the words "Provided that an appli- "cation under the provisions of sub-Sec. (5) "of section nine of this Act may be advertised "by the Registrar on receipt of such appli- "cation and "before acceptance."</p>
Section 14	<p>.. In sub-Section (4), after the word "conditions" there shall be inserted the following words "or what limitations as to mode or place of "user or otherwise."</p> <p>In sub-Sec. (5) the words "or with the consent "of the parties to the Board of Trade" shall be repealed.</p> <p>In sub-Sec. (6) the words "the Board of Trade or" and "as the case may be" shall be repealed; and after the words "conditions, if any" there shall be inserted the words "or "what limitations, if any, as to mode or place "of user or otherwise."</p> <p>Sub-Sec. (10) shall be repealed.</p>
Section 16	<p>.. After the words "the register shall" there shall be inserted the words "unless the mark has "been accepted in error or."</p>
Section 21	<p>.. After the word "court" there shall be inserted the words "or registrar" in each case.</p>

Section Amended.	Nature of Amendment.
	Delete the words "as it may think it right to impose" and insert "as the court or the registrar, as the case may be, may think it right to impose."
Section 22	.. At the end of the section there shall be added the following words "and the assignment of such right to use the same shall constitute the assignee a proprietor of a separate trade mark for the purpose of section twenty-one of this Act, subject to such conditions and limitations as may be imposed under that section."
Section 23	.. After the words "modifications, if any," there shall be inserted the words "and to such limitations, if any, as to mode or place of user."
Section 24	.. After the words "registration of a trade mark" there shall be inserted the words "identical with or."
Section 34	.. After the word "terms" there shall be inserted the words "and subject to such limitations as to mode or place of user."
Section 41	.. In the proviso, after the words "anterior to the user" there shall be inserted the words "or registration, whichever is the earlier."
Section 43	.. For section forty-three the following section shall be substituted: "In any action or proceeding relating to a trade mark or trade name the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get up legitimately used by other persons."
Section 62	.. For the words "Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public

Section  
Amended.

Nature of Amendment.

“advantage, permit such association or person  
“to register such mark as a trade mark in  
“respect of such goods whether or not such  
“association or person be a trading association  
“or trader or possessed of a goodwill in con-  
“nection with such examination and certify-  
“ing,” there shall be substituted the words  
“Where any association or person undertakes  
“to certify the origin, material, mode of  
“manufacture, quality, accuracy or other  
“characteristic of any goods by mark used  
“upon or in connection with such goods, the  
“Board of Trade, if and so long as they are  
“satisfied that such association or person is  
“competent to certify as aforesaid, may, if they  
“shall judge it to be to the public advantage,  
“permit such association or person to register  
“such mark as a trade mark in respect of such  
“goods, whether or not such association or  
“person be a trading association or trader or  
“possessed of a goodwill in connection with  
“such certifying.”

Section 64 .. Sub-section [10 (a)] shall be repealed.  
In sub-section [10 (c)] the word “word” shall be  
omitted.

## APPENDIX VI.

### THE TRADE MARKS RULES, 1920.<sup>1</sup>

*Dated 9th March, 1920.*

By virtue of the provisions of the Trade Marks Act, 1905, to 1919, the Board of Trade do hereby make the following Rules:—

#### *Preliminary.*

1. These Rules may be cited as the Trade Marks Rules, 1920, and shall come into operation from and immediately after the 31st day of March, 1920.

#### *Interpretation.*

2. In the construction of these Rules any words herein used the meaning of which is defined by the said Interpretation. Acts or the Interpretation Act, 1889,<sup>2</sup> shall have the meanings thereby assigned to them respectively.

“Agent” means an agent duly authorized to the satisfaction of the Registrar.

“Office” means Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C. 2.

“Journal” means “Trade Marks Journal.”

“Acts” means the Trade Marks Acts, 1905 to 1919.

#### *Fees.*

3. The fees to be paid in pursuance of the Act shall be the fees specified in the First Schedule to these Rules.

#### *Forms.*

4. The forms herein referred to are the forms contained in the Second Schedule to these Rules and such forms shall be used in all cases to which they are applicable, and shall be modified as directed by the Registrar to meet other cases.

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(1) Statutory Rules and Orders, 1920, No. 397.

(2) The more material definitions of the Interpretation Act are:—  
“Statutory Declaration” means a declaration made by virtue of the Statutory Declarations Act, 1835.

“Month” means Calendar month.

“Person” unless the contrary intention appears, includes any body of persons corporate or unincorporate.

Words in the singular shall include the plural and words in the plural shall include the singular.

*Classification of goods.*

5. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto.

Classification of goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Registrar.

*Documents.*

6. Subject to any other directions that may be given by the Registrar, all applications, notices, counter-statements, papers having representations affixed, or other documents required by the Acts or by these Rules to be left with or sent to the Registrar or to the Keeper of Cotton Marks or to the Cutler's Company, shall be upon foolscap paper of a size of approximately 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Size, etc., of documents.

7. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Office, or to or with the Registrar, or with or to any other person may be sent through the post by a prepaid or official-paid letter; any document so sent shall be deemed to have been delivered at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post. A letter addressed to a registered proprietor of a trade mark at his address as it appears on the register, or address for service, or to any applicant for or person opposing the registration of a trade mark at the address appearing in the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

Service of documents.

8. Where any person is by the Acts or these Rules bound to furnish the Registrar with an address the address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of business of the person whose address is given.

Address.

The Registrar may require the address to include the name of the street, and the number in the street or name of premises, if any.

9. Every applicant for the registration of any trade mark, and every opponent to such registration, and every agent, who does not reside or carry on business in the United Kingdom, shall, if so required, give an address for service in the United Kingdom, and such address may be treated as the actual address of such applicant, opponent, or agent for all purposes connected with such application for registration or the opposition thereto.

The Registrar may require the proprietor of a registered trade mark who does not reside or carry on business within the United Kingdom to give an address for service within the United Kingdom, and such address may be treated as the actual address of the proprietor for all purposes connected with such trade mark.

#### *Agents.*

10. An application for registration and an opposition to registration and all other communications between an applicant, an opponent and the Registrar, or the Board of Trade, and between the proprietor of a registered trade mark and the Registrar, or the Board of Trade, or any other person, may be made by or through an agent.

Any such applicant, opponent, or proprietor may appoint an agent to represent him in the matter of the trade mark by signing and sending to the Registrar an authority in writing to that effect in the Form TM No. 1, or in such other form as the Registrar may deem sufficient. In case any proprietor of a registered trade mark shall appoint such an agent, service upon such agent of any document relating to such trade mark shall be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of such trade mark may be addressed to such agent.

The Registrar shall not be bound to recognize as such agent any person who has been convicted criminally or struck off the Roll of Solicitors, or whose name, by reason of his having been adjudged guilty of conduct discreditable to a patent agent has been erased from the Register of Patent Agents, kept under the provisions of the Patents and Designs Act, 1907 and 1919, and not since restored.

#### *Registrable Trade Marks.*

11. The Registrar may refuse to accept any application for the registration of a mark upon which any of the following appear:—

Registrable trade marks.



(a) The words "Patent," "Patented," or "By Royal Letters Patent," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is a forgery," or words to like effect.

(b) Representations of Their Majesties or of any member of the Royal Family.

12. Representations of the Royal or Imperial Arms or crests, armorial bearings, insignia or devices so nearly resembling them as to lead to mistake, or of British Royal or Imperial crowns, or of the Royal, Imperial or National flags, or the word Royal or Imperial or any other words, letters, or devices calculated to lead persons to think that the applicant has Royal patronage or authorization, may not appear on trade marks the registration of which is applied for. Provided always that nothing contained in this rule shall preclude the Registrar from allowing the registration as an "old mark," that is as a mark which was used by the applicant or his predecessors in business before the 13th August, 1875, of any mark which was capable of being so registered before the Trade Marks Act, 1905, came into operation.

13. Where a representation of the armorial bearings, insignia, decorations or flags of any state, city, borough, town, place, society, body corporate, or institution appears on a mark, the applicant shall, if so required, furnish the Registrar with a consent from such official as the Registrar may consider entitled to give consent to the use of such emblems.

14. Where the names or representations of living persons or persons recently dead appear on a trade mark, the Registrar shall, if he so require, be furnished with consents from such persons before proceeding to register the mark, and in the case of persons recently dead the Registrar may call for consents from their legal representatives.

15. Where the name or a description of any goods appears on a trade mark the Registrar may refuse to register such mark in respect of any goods other than the goods so named or described.

Where the name or description of any goods appears on a trade mark which name or description in use varies the Registrar

may permit the registration of the mark with the name or description upon it for goods other than those named or described, the applicant stating in his application that the name or description varies.

*Application for Registration.*

• 16. An application for the registration of a trade mark must be made upon the appropriate form as in the Second Schedule to these Rules, and must be signed by the applicant or his agent.

Form of application.

17. If application for registration of a trade mark be made by a firm or partnership it may be signed in the name or for and on behalf of the firm or partnership by any one or more members thereof, but the full names of all the partners shall be given in the body of the application.

Application by Firm.

If the application be made by a body corporate it may be signed by a Director or by the Secretary or other principal officer of such body corporate.

Application by body corporate.

18. Where application is made for registration of a cotton mark the applicant shall address and send his application to the Keeper of Cotton Marks at the Manchester Branch, 501, Royal Exchange, Manchester. Other applications (except applications which under Sec. 63 of the Trade Marks Act, 1905, should be made to the 'Cutlers' Company) shall be addressed and sent to the Registrar at the Office.

Address of application.

19. On or after receipt of the application the Registrar shall furnish the applicant with an acknowledgment thereof.

Acknowledgment of application.

20. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th August, 1875, the application shall contain a statement of the time during which and by whom it has been used in respect of the goods mentioned in the application. The Registrar may require a

Application for old mark.

statutory declaration verifying such user with exhibits showing the mark as used.

21. Every application for registration of a trade mark shall contain a representation of the mark affixed to it in the square which the application form contains for that purpose.

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth or other material that the Registrar may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded over.

22. There shall be sent with every application for registration of a trade mark four additional representations of such mark on the Form TM No. 4 or, in the case of a cotton mark, on Form Cotton No. 3, exactly corresponding to that affixed to the application form, and noted with all such particulars as may from time to time be required by the Registrar or by the Keeper of Cotton Marks. Such particulars shall, if required, be signed by the applicant or his agent.

23. All representations of marks must be of a durable nature, but the applicant may in case of need apply in place of representations on the Form TM No. 4, or Form Cotton No. 3, half sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

24. Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications, and in all cases where a trade mark is registered under the same official number for goods in more than one class, the registration shall henceforth for the purpose of fees and otherwise, be deemed to have been made on separate and distinct applications in respect of the goods included in each class.

25. The Registrar, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

**26.** Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Registrar may think most convenient.

**Specimens of trade marks in exceptional cases.**

The Registrar may also, in exceptional cases, deposit in the Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

**27.** When application is made for the registration of a series of trade marks under Sec. 26 of the Trade Marks Act, 1905, a representation of each trade mark of the series shall be affixed, as aforesaid, to the application form, and to each of the accompanying Forms TM No. 4 or Forms Cotton No. 3.

**Series of trade marks.**

**28.** When a trade mark contains a word or words in other than Roman characters, there shall be endorsed on the application form, and on each of the accompanying Forms TM No. 4 or Forms Cotton No. 3, a sufficient transliteration and translation to the satisfaction of the Registrar of each of such words and every such endorsement shall be signed by the applicant or his agent.

**Transliteration and translation.**

Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.

#### *Procedure on Receipt of Application.*

**29.** Upon receipt of an application for registration the Registrar shall, or may, if he deem it necessary, in the case of an application under the provisions of Sec. 2 of the Trade Marks Act, 1919, cause a search to be made among the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for or so nearly resembling it as to be calculated to deceive.

**Search.**

**30.** After such search (if any), if on consideration of the application and of any evidence which the applicant may or may be required to furnish the Registrar thinks there is no objection to the mark being regis-

**Acceptance.**

tered, he may accept it absolutely, or subject to such conditions, amendments, modifications or limitations as he may think right to impose, which he shall communicate to the applicant in writing.

31. After such search (if any), if on consideration of the application and of any evidence which the

**Objections.**

applicant may or may be required to furnish any objections appear, a statement of those objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application.

32. If the Registrar accepts an application subject to any conditions, amendments, modifications, or

**Hearings.**

limitations, and the applicant objects to such conditions, amendments, modifications or limitations, he shall within one month from the date of the communication notifying such acceptance apply for a hearing, and if he does not do so he shall be deemed to have withdrawn his application. If the applicant does not object to such conditions, amendments, modifications, or limitations, he shall forthwith notify the Registrar in writing.

33. The decision of the Registrar at such hearing as afore-

**Decision of Registrar.**

said shall be communicated to the applicant in writing, and if he objects to such decision, he may within one month apply upon Form TM No. 5, requiring the Registrar to state in writing the grounds of his decision and the materials used by him in arriving at the same.

Upon receipt of such form the Registrar shall send to the applicant such statement as foresaid in writing, and the date when such statement is sent shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

34. The Registrar may call on an applicant to insert in his application such disclaimer as the Registrar

**Disclaimers.**

may think fit, in order that the public generally may understand what the applicant's rights, if his mark is registered, will be.

35. An application under the provisions of Sec. 2 of the Trade Marks Act, 1919, shall be made on

**Application under Sec. 2 of Trade Marks Act, 1919.**

Form TM No. 3 or in the case of a cotton mark, on Form Cotton No. 2, with a statutory declaration as required, but the Registrar may require such further evidence as to user or otherwise as he may think necessary.

*Special Trade Marks under Section 62.*

**36.** Where an association or person desires to register a mark under Sec. 62 of the Acts, application shall be made to the Registrar in writing upon the Form TM No. 6.

Application under Sec. 62.

**37.** Such application shall be in duplicate and shall be accompanied by four copies of the mark applied for.

Mode of application.

**38.** Upon the receipt of such application the Registrar shall as soon as may be notify the same to the Board of Trade together with his report upon the application, and shall at the same time send a copy of the application together with two copies of the mark applied for to the Board. The Registrar shall also send the applicants a copy of his report, and within one month from the receipt of such report the applicants shall send the Comptroller, Industrial Property Department, Board of Trade, 25 Southampton Buildings, London, W.C. 2, in duplicate a case setting out the grounds upon which they rely in support of their application and if they fail so to do their application shall be deemed to be abandoned.

Report by Registrar.

**39.** Upon receipt of such case the Board may call for such evidence, if any, as they think fit and shall if necessary, hear the applicants and the Registrar, and make an order determining whether and subject to what conditions, amendments, modifications or limitations, if any, the application may be permitted to proceed.

Hearings.

**40.** If such application is permitted to proceed the mark shall be advertised and the application shall be treated in all respects as if it were an ordinary application, and it shall be open to opposition in the same way and all such proceedings shall be had therein as if it were an application under Sec. 12 of the Trade Marks Act, 1905.

Advertisement, etc.

*Advertisement of Application.*

**41.** Every application either before or after acceptance, as provided by Sec. 13 of the Acts, shall be advertised by the Registrar in the Journal during such times and in such manner as he may direct.

Advertisement of application.

If no representation of the trade mark be inserted in connexion with the advertisement of an application, the Registrar shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

42. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Registrar, or such other information or means of advertising the trade mark, as may be required by the Registrar; and the Registrar, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

43. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in Sec. 26 of the Trade Marks Act, 1905, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; or the Registrar may, if he thinks, fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

44. Advertisements under Sec. 14 (9) of the Trade Marks Act, 1905, shall *mutatis mutandis* be made in the same manner as advertisements relating to an application for registration.

#### *Opposition to Registration.*

45. Any person may within one month from the date of any advertisement in the Journal of an application for registration of a trade mark give notice in writing at the Office of opposition to the registration.

46. Such notice shall be in Form TM No. 7 and shall contain a statement of the grounds upon which the opponent objects to the registration. If registration is opposed on the ground that the mark resembles marks already on the register, the numbers of such marks and the numbers of the Journals in which they have been advertised shall be set out. Such notice shall be accompanied

by a duplicate which the Registrar will forthwith send to the applicant.

47. Within one month from the receipt of such duplicate the applicant shall send to the Registrar a  
Counter statement. counterstatement (Form TM No. 8) in writing setting out the grounds on which he relies as supporting his application. The applicant shall also set out what facts, if any, alleged in the Notice of Opposition he admits. Such counterstatement shall be accompanied by a duplicate in writing.

48. Upon receipt of such counterstatement and duplicate the Registrar will forthwith send the duplicate to the opponent and within one month from the receipt of the duplicate the opponent shall  
Evidence in support of opposition. leave at the Office such evidence by way of statutory declaration as he may desire to adduce in support of his opposition and shall deliver to the applicant copies thereof.

49. If an opponent leaves no evidence, he shall, unless the Registrar otherwise directs, be deemed to have abandoned his opposition, but if he does  
Evidence in support of application. then within one month from the receipt of the copies of declarations, the applicant shall leave at the Office such evidence by way of statutory declaration as he desires to adduce in support of his application and shall deliver to the opponent copies thereof.

50. Within fourteen days from the receipt by the opponent of the copies of the applicant's declarations the opponent may leave at the Office evidence by statutory declaration in reply, and shall deliver to the applicant copies thereof. Such evidence shall be confined to matters strictly in reply.  
Evidence in reply by opponent.

51. No further evidence shall be left on either side, but in any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to file any evidence upon such terms as to costs or otherwise as he may think fit.  
Further evidence.

52. Where there are exhibits to declarations filed in an opposition, copies or impressions of such exhibits shall be sent to the other party on his request, or, if such copies or impressions cannot conveniently be furnished, the originals shall be sent to the Office, so that they  
Exhibits.



may be open to inspection. The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.

53. Upon completion of the evidence the Registrar shall give notice to the parties of a date when he will hear the arguments in the case. Such appointment shall be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice. Within seven days from the receipt of such notice both parties shall file Form TM No. 9. A party who receives such notice and who does not, within seven days from the receipt thereof, give notice on Form TM No. 9 that he intends to appear, may be treated as not desiring to be heard and the Registrar may act accordingly.

54. Where in opposition proceedings any extension of time is granted to any party, the Registrar may thereafter, if he thinks fit, without giving the said party a hearing, grant any reasonable extension of time to the other party in which to take any subsequent step.

55. Where a party giving notice of opposition neither resides nor carries on business in the United Kingdom, the Registrar may call upon him to give a security, in such form as the Registrar may deem sufficient, for the costs of the proceedings before the Registrar, for such amount as to the Registrar may seem fit, and at any stage in such opposition may require further security to be given at any time before giving his decision in the case.

56. In the event of an opposition being uncontested by the applicant, the Registrar in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the opposition was filed.

#### *Non-Completion.*

57. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar shall give notice to the applicant in writing in the Form O No. 1 of such non-completion, and if the applicant has an agent, shall send a dupli-

cate of such notice to such agent. If after fourteen days from the date when such notice was sent, or such further time as the Registrar may allow, the registration is not completed, the application shall be deemed to be abandoned.

*Entry on the Register.*

58. As soon as may be after the expiration of one month from the date of the advertisement in the Journal of any application, the Registrar shall, subject to any opposition and the determination thereof, and subject to the provisions of Sec. 16 of the Acts, and upon payment of the prescribed fee, on Form TM No. 10, enter the trade mark on the register. The entry of a trade mark on the register shall give the date of the registration, the goods in respect of which it is registered, and all particulars named in Sec. 4 of the Trade Marks Act, 1905, together with particulars of the trade, business, profession, or occupation, if any, of the proprietor, and such other particulars as the Registrar may deem necessary.

59. Where a mark is registered as associated with any other mark or marks the Registrar shall note upon the register in connection with such mark the numbers of the marks with which it is associated and shall also note upon the register in connection with each of the associated marks the number of the newly registered mark as being an associated mark with each of them.

60. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the Registrar after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, on such ownership being proved to the satisfaction of the Registrar.

61. Upon the registration of a trade mark the Registrar shall issue to the applicant a certificate in the Form O No. 2.

*Renewal.*

**62.** At any time not less than two months and not more than three months before the expiration of the last registration of a trade mark any person may leave at the Office a fee for the renewal of the registration of the mark upon Form TM No. 11. Such person shall endorse upon such form his name and address, and before taking any further step the Registrar may require such person to furnish within five days an authority to pay such fee signed by the registered proprietor, and if such person does not furnish such authority, may return such fee and treat it as not received.

**63.** When he does not require such authority, the Registrar shall upon receipt of such fee communicate with the registered proprietor at his registered address, stating that the fee has been received and that the registration will in due course be renewed.

**64.** At a date not less than one month and not more than two months before the expiration of the last registration of a mark, if no fee upon the Form TM No. 11 has been received, the Registrar shall send to the registered proprietor at his registered address a notice in the Form O. No. 3.

**65.** At a time not less than 14 days and not more than 28 days before the expiration of the last registration of a mark, the Registrar shall, if no renewal fee has been received, send a notice to the registered proprietor at his registered address in the Form O No. 4.

**66.** If at the date of the expiration of the last registration of a mark the renewal fee has not been paid, the Registrar shall advertise the fact forthwith in the Journal, and if within one month of such advertisement the renewal fee upon Form TM No. 12 together with an additional fee upon Form TM No. 13, is received, he may renew the registration without removing the mark from the register.

67. Where after one month from such advertisement such fees have not been paid, the Registrar may remove the mark from the Register as of the date of the expiration of the last registration, but may upon payment of the renewal fee upon Form TM No. 12, together with the additional fee upon the Form TM No. 14, restore the mark to the register if satisfied that it is just so to do, and upon such conditions as he may think fit to impose.

68. Where a trade mark has been removed from the register the Registrar shall cause to be entered in the register a record of such removal and of the cause thereof.

69. Upon the renewal of a registration a notice to that effect shall be sent to the registered proprietor at his registered address and the renewal shall be advertised in the Journal.

#### *Assignments.*

70. Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade mark he may conjointly with the registered proprietor, make application to the Registrar on Form TM No. 15 to register his title.

71. Where a person becomes entitled to a registered trade mark in the manner referred to in Rule 70, and no conjoint application as therein mentioned is made, he shall make application to the Registrar on Form TM No. 16 to register his title. Such application shall in the case of an individual be signed by the applicant and in the case of a firm or partnership by one or more members of such firm or partnership, and in the case of a body corporate shall be signed by a director or by the secretary or other principal officer of such body corporate.

72. An application under Rule 70 or Rule 71 shall contain the name, address and description of the person claiming to be entitled, together with full particulars of the instrument, if any, under which he claims, and such instrument shall be produced for inspection by the Registrar. The full names of all the partners in a firm or partnership shall be given in the body of the application.

73. The Registrar may in any case require an attested copy  
 Copies of documents. of any instrument produced for inspection in proof of title.

74. Where in the case of an application on Form TM No. 15 or Form TM No. 16 the applicant does not  
 Case accompanying application. claim to be entitled under any document or instrument which is capable in itself of furnishing proof of his title, he shall, unless the Registrar otherwise directs, either upon or with the application, state a case setting forth the full particulars of the facts upon which his claim to be proprietor of the trade mark is based, and showing that the trade mark has been transmitted or assigned in connection with the goodwill of the business concerned. Such case shall be verified by a statutory declaration if so required by the Registrar on Form TM No. 17.

75. In any case, the Registrar may call on any person who  
 Proof of title. desires to be registered as proprietor of a trade mark for such proof or additional proof of title and of the existence and ownership of such goodwill as aforesaid as the Registrar may require for his satisfaction.

76. When the Registrar is satisfied as to the applicant's  
 Entry in register. title, he shall cause the applicant to be registered as proprietor of the trade mark, and shall record in the Register such particulars as he may consider necessary of the instrument, if any, under which the title was acquired.

#### *Alteration of Address.*

77. Every registered proprietor of a trade mark who alters  
 Alteration of address in register. his address shall forthwith apply to the Registrar on Form TM No. 18 to insert the new address on the register, and the Registrar shall alter the register accordingly.

#### *Discretionary Power.*

78. Before exercising any discretionary power given to the  
 Hearing. Registrar by the Acts, or these Rules, adversely to any person, the Registrar shall, if so required, hear the person who will be affected by the exercise of such power.

**79.** An application for a hearing shall be made within one month from the date when the matter on which the Registrar is called on to exercise discretionary power has arisen.

Application for hearing.

**80.** Upon receiving such application the Registrar shall give the person applying ten days' notice of a time when he may be heard by himself or his agent.

Notice of hearing.

Within five days from the date when such notice would be delivered in the ordinary course of post the person applying shall notify the Registrar whether or not he intends to be heard on the matter.

**81.** The decision of the Registrar in the exercise of any such discretionary power as aforesaid shall be notified to the person affected.

Notification of decision.

*Applications under Section 23 of the Trade Marks Act, 1905.*

**82.** All applications to the Registrar under Sec. 23 of the Trade Marks Act, 1905, shall be upon the Form TM No. 19. Such application shall be accompanied by a case setting out fully the facts relating to the marks which the Registrar is requested to permit an apportionment of.

Application under Sec. 23 of Act of 1905.

**83.** Upon receipt of such request and of such case the Registrar shall enquire into the facts and call for such evidence as he may deem necessary upon the subject of such application. Before giving his decision the Registrar shall, if necessary, give the parties an opportunity of attending before him at a hearing either by themselves or by their agents.

Registrar to enquire and decide.

The decision of the Registrar shall be in writing.

**84.** Upon any apportionment of marks under this section the Registrar shall insert in the register a note in connection with each of the registered trade marks of the fact of such apportionment, and shall in such note refer to the date of the decision under which such apportionment has taken place.

Note in register.

*Applications under Section 32 of the Trade Marks Act, 1905.*

**85.** Applications under Sec. 32 of the Trade Marks Act, 1905, to the Registrar may be made by the registered proprietor, or by the trustee in bankruptcy of the registered proprietor, or where the registered proprietor is a company in liquidation, by the liquidator, and in other cases by such person as the Registrar may decide to be entitled to act in the name of the registered proprietor.

**86.** Where such application is made the Registrar may require such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application is made.

**87.** Where application is made, on Form TM No. 24, to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before deciding upon such application, shall advertise the application in the Journal for one month in order to enable any person desiring so to do to state any reasons in writing against the applicant being allowed to make such disclaimer or enter such memorandum.

*Applications under Section 34 of the Trade Marks Act, 1905.*

**88.** Where a person desires to apply under Sec. 34 of the Trade Marks Act, 1905, to alter a trade mark he shall make his application in writing on Form TM No. 25, and shall furnish the Registrar with four copies of the mark as it will appear when altered.

**89.** Before proceeding with such application the Registrar may call on the applicant to furnish a block suitable to advertise in the Journal the fact that such application has been made, or, if he think fit, the Registrar, without calling for a block, may insert an advertisement describing the alteration proposed in words so that it can be understood by persons interested in the matter.

When leave is granted the Registrar may, if he is not already in possession of a block showing the trade mark as altered, cause the applicant to furnish a block showing the trade mark as altered for advertisement in the Journal, and upon receipt of such block shall forthwith advertise the mark as altered in the Journal.

*Applications under Section 9 of the Trade Marks Act, 1919.*

90. An application for the rectification of the register or the removal of a trade mark from the register, if made to the Registrar, shall be in Form TM No. 26. Such application shall be accompanied by an unstamped copy and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. Copies of the application and the statement of case will be transmitted forthwith by the Registrar to the registered proprietor.

91. Upon such application being made and copy thereof transmitted to the registered proprietor the provisions of Rules 47 to 56 shall apply *mutatis mutandis* to the further proceedings thereon. In any case of doubt any party may apply to the Registrar for directions.

92. Any person other than the registered proprietor alleging interest in a registered Trade Mark in respect of which an application is made on Form TM No. 26 may apply to the Registrar on Form TM No. 27 for leave to intervene, and the Registrar may refuse or grant such leave, after hearing the parties concerned, upon such conditions and terms as he may deem fit. Before dealing with such application in any way the Registrar may require the applicant to give an undertaking to pay such costs as in the circumstances he may award to any party.

*Search.*

93. The Registrar, if requested so to do in writing upon a Form TM No. 28, may cause a search to be made in any class to ascertain whether any marks are on record at the date of such search which may resemble any mark sent in duplicate to him by the person requesting such search and may cause that person to be informed of the result of such search.

*Hours of Inspection.*

94. The office shall be open to the public every week day, except Saturday, between the hours of ten and four; and on Saturday between the hours of ten and one, except on the days following:



Christmas Day; Good Friday; the day observed as His Majesty's birthday; the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England; and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

*Power to Dispense with Evidence.*

95. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Registrar, or at the office, and it is shown to the satisfaction of the Registrar that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Registrar, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

*Amendments.*

96. Any document or drawing or other representation of a trade mark may be amended, and any irregularity in procedure which in the opinion of the Registrar may be obviated without detriment to the interests of any person may be corrected, if the Registrar think fit, and on such terms as he may direct.

*Enlargement of Time.*

97. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Registrar, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.

98. Whenever the last day fixed by the Acts or by these Rules, for leaving any document or paying any fee at the office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed

as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

### *Certificates.*

**99.** The Registrar, when required otherwise than under Sec. 17 of the Trade Marks Act, 1905, to give a certificate by re-gistrar. a certificate as to any entry, matter, or thing which he is authorized by the Acts, or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, but every certificate of registration so given shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining registration abroad, or for purposes other than use in legal proceedings or obtaining registration abroad.

**100.** Where a mark is registered without limitation of colour it shall be lawful for the Registrar to grant a certificate of its registration for the purpose of obtaining registration abroad either in the colour in which it appears upon the register or in any other colour or colours.

**101.** Where a certificate of registration is desired for use in obtaining registration abroad, the Registrar shall affix to the said certificate a copy of the mark, and shall state in such certificate such particulars concerning the registration of the mark as to him may seem fit, and may omit therefrom reference to any disclaimers appearing on the register.

### *Declarations.*

Manner in which and person before whom declaration is to be taken.

**102.** The statutory declarations required by the Acts, and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

- (a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;
- (b) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer

authorized by law to administer an oath there for the purpose of a legal proceeding; and

- (c) If made out of His Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a Judge or Magistrate.

103. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorized to take such declaration in testimony of such declaration having been made and submitted before him, may be admitted by the Registrar without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Notice of seal of officer taking declaration to prove itself.

#### *Cutlers' Company.*

104. All applications to the Cutlers' Company for registration of a trade mark, under Sec. 63 of the Trade Marks Act, 1905, shall be in duplicate accompanied by the prescribed fees and representations. Requests to enter old corporate marks on the Sheffield Register, under Sec. 63 (2) of the Trade Marks Act, 1905, should be made on form Sheffield No. 1.

Applications.

105. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Registrar one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Notice to Registrar.

106. The time within which the Registrar shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said Company shall be one month from the date of the receipt by the Registrar of the notice from the said Company of the making of the application.

Objections by Registrar to acceptance.

107. If no such objection is made by the Registrar, the Cutlers' Company shall require the applicant to send the Registrar a wood block or electrotype as the Registrar may direct, and

Advertisement of application.

the Registrar shall, if satisfied with such wood block or electrotpe, advertise the application in the same manner as an application made to him at the Office.

108. The manner in which the Registrar shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-Sec. 8 of Sec. 63 of the Trade Marks Act, 1905, shall be by sending to the Cutlers' Company a copy of the Journal containing the application of which notice is required to be given with a note distinguishing such application.

109. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings, shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

#### *Cotton Marks.*

110. An application to the Manchester Branch for registration of a trade mark under Sec. 64 of the Trade Marks Act, 1905, shall be in duplicate. The special Forms for cotton marks contained in the Second Schedule to these Rules shall be used. One of the Forms of application shall be stamped and the other unstamped.

111. The Keeper of Cotton Marks shall forthwith, on receipt of such application, send the Registrar one representation of the mark applied for.

112. As soon as may be after receiving any application, the Keeper of Cotton Marks shall, or may, if he deem it necessary, in the case of an application under the provisions of Sec. 2 of the Trade Marks Act, 1919, make a search amongst the marks on the Manchester register, in the B List, those which have been refused upon application made within fourteen years next before the date of application under examination and those refused upon applications of earlier date, which have been continued for quotation in the collection of refused marks under the provisions of Rule 113 of these Rules and those which are pending, and shall notify to the Registrar the application,

and the marks, if any, which he has found so nearly resembling the mark applied for as to be calculated to deceive, and together with such notification shall send a report upon the application.

**113.** A mark shall not be continued in the collection of  
 Refused marks. refused marks as a mark to be quoted by the  
 Keeper for a period of more than fourteen  
 years from the date of the application to register unless the appli-  
 cant or his successor in business shall before the expiration of the  
 said period of fourteen years from the date of application to regis-  
 ter, pay the prescribed continuance fee; and a mark which has been  
 continued for quotation in the said collection on payment of the  
 prescribed continuance fee shall not be continued in the collection  
 for quotation after the expiration of a period of fourteen years  
 from the date when the prescribed continuance fee became payable,  
 unless the said fee shall be again paid before the expiration of such  
 period and so on for every succeeding period of fourteen years  
 from the date when the last prescribed continuance fee became  
 payable.

**114.** Before discontinuing for quotation a mark in the  
 collection of refused marks, the Keeper of  
 Discontinuance on record of refused marks. Cotton Marks shall, at a date not more than  
 six months nor less than three months from  
 the date on which the mark would be so dis-  
 continued, give notice that the mark will not be continued for  
 quotation in the collection of refused marks unless the prescribed  
 continuance fee shall be paid before the expiration of the periods  
 of fourteen years mentioned in the last preceding Rule.

**115.** The notice mentioned in Rule 114 of these Rules shall  
 be addressed to the applicant at the address  
 Notice to appli- cant. given on the form of application. In case  
 such notice is returned by the Postal authori-  
 ties, the Keeper of Cotton Marks may, so far as he can but without  
 being under any obligation to do so, discover the present address  
 of the applicant if he be still in business, or of his successors in  
 business or of the existing owner of the refused mark, if any, with  
 a view of bringing the notice to his or their attention.

**116.** The prescribed continuance fee shall be paid by trans-  
 mitting to the Keeper of Cotton Marks, at the  
 Continuanace Fee. Manchester Branch, the Form Cotton No. 6  
 in the Second Schedule hereto.

**117.** Upon considering the report of the Keeper of Cotton

**Hearings.**

Marks, if the Registrar thinks it will be necessary to object to the acceptance of the application, he shall give notice to the applicant of a time when he can be heard, and within one month after hearing the applicant, may give notice to the Keeper of Cotton Marks of objection to the acceptance of the application, or that he has no objection, as the case may be. If no notice of objection, or if notice of no objection is received from the Registrar, the application shall be advertised in the Journal by the Manchester Branch.

If the applicant, being notified as aforesaid of a time for hearing, does not attend, his application shall be deemed to be refused.

**118.** If the mark is advertised by the Manchester Branch

**Registration.**

and is not opposed, the Keeper of Cotton Marks may call upon the applicant for the prescribed fee for the registration of such trade mark, and upon receipt thereof shall report to the Registrar, who shall forthwith, if he think fit, register the same.

**119.** Where under the Acts, or these Rules, an application

**Procedure.**

has to be made to the Keeper of Cotton Marks, such application shall be made and such proceedings shall be had thereon as if in these Rules the expression "Manchester Branch, 501, Royal Exchange, Manchester," were substituted for the word "Office", and the expression "Keeper of Cotton Marks" were substituted for the word "Registrar."

**120.** Where any document is by these Rules directed to be

**Service of documents.**

served upon the Registrar it shall, in respect of cotton marks, be served in duplicate upon the Keeper of Cotton Marks, who shall forthwith transmit one copy to the Registrar.

**121.** Where under Rule 93 a search has to be made by the

**Search under Rule 93.**

Keeper of Cotton Marks, such search shall cover all marks of which there is a right of inspection under Sec. 64 (11) of the Trade Marks Act, 1905.

*Appeals to the Court.*

**122.** When any person intends to appeal to the Court, such

**Appeal to Court.**

appeal shall be made by motion in the usual way, and no such appeal shall be entertained unless notice of motion be given within one month from the date

of the decision appealed against or within such further time as the Registrar shall allow.

*Appeals to the Board of Trade.*

**123.** When any person intends to appeal to the Board of Trade he shall, before doing so, apply to the Registrar for a hearing and obtain a decision from him upon the point raised. Within one month from the date of such decision he shall, if he is advised to appeal to the Board of Trade in any case in which an appeal is given by the Acts, leave at the Office a notice of such his intention, on Form TM No. 29.

Such notice shall be accompanied—

(1) In case the appeal concerns an application not yet advertised, by a copy of the form of application and two representations of the mark applied for and a copy of the grounds of the Registrar's decision.

(2) In other cases by a copy of the decision of the Registrar and a statement of the date of the hearing before him.

**124.** Such notice shall also be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

**125.** A copy of the notice and all the accompanying documents shall also be forthwith sent by the appellant to the comptroller, Industrial Property Department, Board of Trade, 25 Southampton Buildings, London, W.C. 2.

**126.** The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

**127.** Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Registrar and to the appellant.

128. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Registrar may allow, except by special leave of the Board of Trade.

No appeal unless  
notice duly given.

*Withdrawal of Appeals.*

129. Where under Sec. 12 (5) or Sec. 14 (8) of the Trade Marks Act, 1905, an appellant is entitled to withdraw his appeal, such withdrawal shall be effected by notice given to the Registrar and to the other parties, if any, to such appeal within seven days after the leave referred to in such sections has been obtained.

Withdrawal  
of appeal.

*Applications to and Orders of the Court.*

130. Every application to the Court under the said Acts shall be served on the Registrar.

Applications  
to Court.

131. Where an order has been made by the Court in any case under the Acts, the person in whose favour such order has been made, or such one of them, if more than one, as the Registrar may direct, shall forthwith leave at the Office an office copy of such order, together with Form TM No. 30 if required. The register may, if necessary thereupon, be rectified or altered by the Registrar.

Order of Court.

132. Whenever an order is made by the Court under the said Acts the Registrar may, if he thinks that such order should be made public, publish it in the Journal.

Publication  
of order of Court.

*Repeal.*

133. All general rules relative to Trade Marks heretofore made by the Board of Trade under the Trade Marks Act, 1905, and in force on the 31st March, 1920, shall be, and they are, hereby repealed as from that date, without prejudice nevertheless, to anything done under such rules, or to any application or other matter then pending.

Repeal.

Dated this 9th day of March, 1920.

A. C. GEDDES,  
*President of the Board of Trade.*



## APPENDIX VII.

### NOTICE IN RESPECT OF DETENTION OF GOODS ALLEGED TO BE LIABLE TO CONFISCATION UNDER THE SEA CUSTOMS ACT, 1878.

Collector

To the \_\_\_\_\_ at the port of .....  
Chief Customs Officer

We hereby give notice that the undermentioned goods  
are about to be

(1) Description of \_\_\_\_\_ brought into British India  
Vessel and name or \_\_\_\_\_ have been  
other details for identification. at..... on or about the.....  
day of.....in the (1).....from.....and  
that they are liable to confiscation under the provisions of the Sea  
Customs Act, 1878, for reasons stated below:—

(2) State the num-  
ber of packages,  
marks, description of  
goods and any other  
particulars necessary  
for identification.

Details of goods (2)

(3) State in what  
way the marks or  
other indications on  
the goods infringe the  
provisions quoted,  
giving copies, if  
available, of the  
genuine and counter-  
feit marks, etc.

Grounds of liability to confiscation (3).

Mr.....of.....is prepared to become  
surety in such bond as may be required upon detention of the goods.  
Reference as to his sufficiency for the penalty of the bond may be  
made to Messrs. (4).

(4) Bankers, Soli-  
citors, etc.

I

\_\_\_\_\_ request that the said goods be  
We

detained and dealt with accordingly.

Dated this \_\_\_\_\_ day of

A. B. (or Agent for)

## APPENDIX VIII.

### FORM OF INDEMNITY IN RESPECT OF DETENTION OF GOODS ALLEGED TO BE LIABLE TO CONFISCATION UNDER THE SEA CUSTOMS Act, 1878.

We \_\_\_\_\_

Collector of Customs

having requested the \_\_\_\_\_ at \_\_\_\_\_ to detain the goods  
Chief Customs Officer

\_\_\_\_\_ be or about to be  
mentioned below which we allege or believe to \_\_\_\_\_  
\_\_\_\_\_ have been

brought into British India at that Port and to be liable to confiscation under the provisions of the Sea Customs Act, 1878, we hereby jointly and severally for ourselves and our respective heirs executors or administrators and representatives undertake and agree with the Secretary of State for India in Council and also

Collector of Customs

separately with the said \_\_\_\_\_ at  
Chief Customs Officer

and his successors in office and their representative assigns in the event and in consideration of the said goods being so detained as aforesaid for any period whatever to indemnify and keep indemnified the Secretary of State for India in Council and the said Collector of Customs

\_\_\_\_\_ and all other officers of Customs and other  
Chief Customs Officer

Officers of the Government of India, or servants of the Secretary of State for India in Council and their representative successors in office heirs executors administrators representatives and assigns from and against all actions proceedings claims and demands costs and damages or expenses for or on account or in respect or in any way arising out of the detention as aforesaid of the said goods or any part thereof for any period whatsoever or for or on account or arising out of any act thing or proceeding done or omitted to or in respect of or in connection with or any loss damage or deterioration of to or in the said goods while so detained or before or after the detention thereof or on account or by reason of such detention

or of any other act thing or proceeding at any time done or taken or omitted with a view to or respecting the detention or confiscation of the said goods or otherwise to or in respect of or in relation to the said goods in pursuance or in consequence of our said request.

Collector of

And we hereby expressly declare that if the said \_\_\_\_\_  
Customs Chief Customs

\_\_\_\_\_ shall see fit to detain the said goods (it being a matter  
Officer

entirely within his discretion whether they shall be detained or not) he shall be at liberty to detain them for such period whether provided for by rule or not as he shall in his absolute and uncontrolled discretion think fit and to release and deliver them at any time or to take such other action with respect thereto as he shall so think fit and the liability of us and each of us and of our respective heirs executors or administrators and representatives hereunder shall not be discharged or in any way impaired or affected by the release or delivery thereof by him at any time.

Particulars of goods.

## APPENDIX IX.

ARTICLES IMPORTED FROM AFRICA, ARABIA, PERSIA AND PERSIAN  
GULF AND TURKEY IN ASIA, FOR WHICH MARKS OF ORIGIN  
NEED NOT BE INDICATED.

Almonds.	Dragon's blood.
Aloes, Socotra.	Drugs (Persian) and medi- cines.
Amber.	Ebony wood.
Aniseed.	Elephant tusks.
Arsenic.	Figs, dry.
Asafoetida.	Fish, dry (salted and unsalted).
„ Coarse, Hingra.	Fishmaws.
Attary (Persian).	Fruits, fresh and dry.
Bees'-wax.	Gallnuts (Persian).
Betelnuts.	Garlic.
Bones.	Genda horns.
Bran.	Ghee.
Brimstone (Amalsara).	Gowla.
Buzgand (Gulpista).	Grain of sorts.
Calumba root.	Groundnuts (with and without shells).
Cheese.	Gum, Ammonia.
Chillies, dry.	„ Arabic.
Cloves.	„ Bdelium.
Clove stems.	„ Bysabol (coarse Myrrh).
Cloves, Narlavang.	„ Copal.
Coccanuts.	„ false.
„ sea.	„ Hirabol (Myrrh).
Coffee (Mocha).	„ Olibanum.
Copra.	„ other sorts.
Corals.	Hair.
Cotton, raw.	Hair bags, goat.
Cowries.	Hajrate—How.
Cowras.	Halwa.
Currants.	Hazelnuts.
Dates, dry.	Hides and skins (tanned and untanned).
„ Wet.	Honey.
Downa.	
Dhuppanadi.	

Horns.	Reeds, black.
Kishmish.	Rose flowers, dried.
Lava wood.	Rose water.
Lavender flowers.	Rumi Mustaki.
Lemons, dried.	Saffron.
Liquorice root.	Sajikhar.
Long pepper.	Salep.
Madder or manjit.	Samooderfal.
Mats.	Samoodrafen.
„ cuppas.	Sankhli.
„ saffies.	Seed of sorts.
Mother-of-Pearl Shells.	Senna leaves.
Moye teeth.	Sharkfins.
Nakh, tortoise.	Shells, tortoise.
Nakhala.	Silk, raw.
Ochre, red.	Storax.
Orange peel.	Talc, Mica.
Orchilla wood.	Tanning barks.
Orris or Kewda root.	Tobacco (manufactured and unmanufactured).
Pearls.	Vegetables, other sorts, fresh and dry.
Pellitory roots.	Vinegar.
Pistachio nuts.	Walnuts.
Prunes (alu bokhara).	Wood.
Quince, bihidana.	Wool, raw.
Raisins, red.	
„ black.	

## APPENDIX X.

### INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, (1934).

The International Convention for the Protection of Industrial Property was signed at Paris on the 20th March, 1883, and revised at Brussels, on the 14th December, 1900, at Washington, on the 2nd June, 1911, at The Hague on 6th November, 1925, and at London on the 2nd June, 1934. Some of the more important Articles as accepted at the London Conference are given below:—

#### *Article 1.*

1. The Countries to which the present Convention applies constitute themselves into a Union for the protection of industrial property.

2. The protection of industrial property is concerned with patents, utility models, industrial designs or models, trade marks, trade names and indications of source or appellations of origin, and the repression of unfair competition.

3. Industrial property is to be understood in the broadest sense and applies not only to industry and commerce properly so called, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, corn, tobacco leaves, fruit, cattle, minerals, mineral waters, beer, flowers and flour.

4. Under the term “patents” are included the various kinds of industrial patents recognised by the laws of the countries of the Union, such as patents of importation, patents of improvement, patents and certificates of addition, etc.

#### *Article 2.*

1. Persons within the jurisdiction of each of the countries of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to their nationals, without prejudice to the rights specially provided by the

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(1) Taken from the Translation published by H. M. Stationery Office, London, with the kind permission of the controller.

present Convention. Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the conditions and formalities imposed on nationals.

2. Nevertheless, no condition as to the possession of a domicile or establishment in the country where protection is claimed may be required of persons entitled to the benefits of the Union for the enjoyment of any industrial property rights.

#### *Article 4.*

A-1. Any person who has duly deposited an application for a patent, or for the registration of a utility model, industrial design or model or trade mark in one of the countries of the Union, or his legal representative or assignee, shall enjoy, for the purposes of deposit in the other countries, a right of priority during the periods hereinafter stated.

2. Every application which, under the domestic law of any country of the Union, or under international treaties concluded between several countries of the Union, is equivalent to a regular national application, shall be recognised as giving rise to a right of priority.

B. Consequently, a subsequent deposit in any of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either for instance, by another deposit, by publication or exploitation of the invention, by the putting on sale of copies of the design or model, or by use of the mark, and these acts cannot give rise to any rights of third parties or of personal possession. Rights acquired by third parties before the date of the first application which serves as a basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C-1. The above-mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs or models and trade marks.

#### *Article 5.*

C-1. If, in any country, the utilisation of a registered trade mark is compulsory, registration cannot be cancelled until after a reasonable period has elapsed, and then only if the person interested cannot justify the causes of his inaction.

2. The use of a trade mark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark from the form in which it was registered in one of the countries of the Union shall not involve cancellation of the registration, and shall not prejudice the protection granted to such mark.

3. The concurrent use of the same mark on identical or similar goods by industrial or commercial establishments who, under the provisions of the national law of the country where protection is claimed, are considered as co-proprietors of the mark, shall not prevent the registration nor prejudice in any manner the protection granted to the said mark in any country of the Union, provided that such use does not result in misleading the public, and is not contrary to the public interest.

#### *Article 6.*

A. Every trade mark duly registered in the country of origin shall be admitted for deposit and protected in its original form in the other countries of the Union, subject to the reservations indicated below. These countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No legislation shall be required for this certificate.

B. Registration of trade marks in the other countries of the Union shall not be refused for the sole reason that such marks differ from the marks protected in the country of origin only by elements which do not alter the distinctive character and do not affect the identity of the marks registered in the said country of origin.

C. The country of the Union where the depositor has a real and effective industrial or commercial establishment; if he has not such an establishment, the country of the Union where he is domiciled, and if he is not domiciled in the Union, the country of his nationality, if he is a person within the jurisdiction of one of the countries of the Union shall be considered as the country of origin.

D. When a trade mark has been duly registered in the country of origin and then in one or several other countries of the Union, each of these national marks shall be considered, as from the date of its registration, as independent of the mark in the country of origin, provided it conforms to the domestic legislation of the country of importation.



E. In no case shall the renewal of the registration of a mark in the country of origin involve the obligation to renew the registration of the mark in other countries of the Union where it has been registered.

*Article 6 bis.*

1. The countries of the Union undertake to refuse or to cancel, either administratively if their legislation so permits, or at the request of an interested party, the registration of any trade mark which constitutes a reproduction, imitation or translation capable of creating confusion with a mark considered by the competent authority of the country of registration to be well-known in that country as being already the mark of a person entitled to the benefits of the present Convention and utilised for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark, or an imitation capable of creating confusion therewith.

2. A period of at least three years shall be allowed for claiming the removal of such marks. This period shall run from the date of registration of the mark.

3. There shall be no limit to the period within which application may be made for the removal of marks registered in bad faith.

*Article 6 quater.*

1. When, in conformity with the legislation of a country of the Union, the assignment of a trade mark is valid only if it takes place simultaneously with the transfer of the business or goodwill to which the mark belongs, it shall be sufficient to establish validity if the portion of the business or goodwill situated in that country, together with the exclusive right of manufacturing or selling in that country the goods bearing the mark assigned, is transferred to the assignee.

2. This provision does not impose upon the countries of the Union any obligation to consider valid the assignment of any mark of which the use by the assignee would, in fact, be of such a nature as to deceive the public, in particular as regards the origin, nature or substantial qualities of the goods to which the mark is applied.

*Article 8.*

A trade name shall be protected in all the countries of the Union without necessity of deposit or registration, whether or not it forms part of a trade mark.

*Article 9.*

1. All goods illegally bearing a trade mark or trade name shall be seized on importation into those countries of the Union where this mark or name has a right to legal protection.

2. Seizure shall be effected equally in the country where the mark or name was illegally applied, or in the country into which the goods bearing it may have been imported.

3. The seizure shall take place at the request either of the Public Prosecutor or of any other competent authority or of any interested party whether an individual or a body of persons corporate or unincorporate in conformity with the domestic law of each country.

4. The authorities shall not be bound to effect the seizure of goods in transit.

5. If the laws of a country do not admit of seizure on importation, such seizure shall be replaced by prohibition of importation or seizure within such country.

6. If the laws of any country do not admit either of seizure upon importation, or of prohibition of importation, or of seizure within the country, and pending the requisite modification of these laws, these measures shall be replaced by the remedies available in such cases to nationals.

*Article 10.*

1. The stipulations of the preceding Article shall be applicable to all goods which falsely bear as an indication of origin the name of a specified locality or country, when such indication is joined to a trade name of a fictitious character or used with fraudulent intention.

2. Any producer, manufacturer or trader, whether an individual or a body of persons corporate or incorporate, engaged in the production, manufacture, or trade of such goods, and established either in the locality falsely indicated as the place of origin, in the district where the locality is situated, or in the country falsely indicated, or in the country where the false indication of origin is used, shall in any case be deemed a party interested.

*Article 10 bis.*

1. The countries of the Union are bound to assure to persons entitled to the benefits of the Union an effective protection against unfair competition.

2. Every act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

3. The following acts among others shall be prohibited:—

- (1) All manner of acts of such a nature as to create confusion by any means whatsoever with the establishment, the goods, or the industrial or commercial activities of a competitor;
- (2) False allegations, in the course of trade, of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities of a competitor.

*Article 10 ter.*

1. The countries of the Union undertake to assure to persons within the jurisdiction of other countries of the Union appropriate legal remedies to repress effectively all acts referred to in Articles 9, 10 and 10 bis.

*Article 11.*

1. The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs or models, and trade marks, in respect of goods exhibited at official, or officially recognised, international exhibitions held in the territory of one of them.

*Article 12.*

1. Each of the countries of the Union undertakes to establish a special Government department for industrial property, and a central office for communication to the public of patents, utility models, industrial designs or models, and trade marks.

## APPENDIX XI.

### INTERNATIONAL AGREEMENT FOR THE PREVENTION OF FALSE INDICATIONS OF ORIGIN ON GOODS.

The International Agreement for the Prevention of False Indications of Origin on goods was signed at Madrid on the 14th April, 1891, and revised at Washington on the 2nd June, 1911, at The Hague on the 6th November, 1925, and lastly at London on the 2nd June, 1934. Some of the important Articles as accepted at the London Conference are given below:<sup>1</sup>

#### *Article 1.*

1. All goods bearing a false indication by which one of the countries to which the present Agreement applies, or a place situated therein, shall be directly or indirectly indicated as being the country or place of origin, shall be seized on importation into any of the said countries.

2. The seizure shall take place either in the country where the false indication of origin has been applied, or in that into which the goods bearing the false indication may have been imported.

3. If the law of any country does not permit seizure on importation, such seizure shall be replaced by prohibition of importation.

4. If the law of any country does not permit either seizure upon importation, or the prohibition of importation, or seizure in the interior, and pending the requisite amendment of that law, these measures shall be replaced by the remedies assured in such case by the law of such country to its nationals.

5. In the absence of any special penalties ensuring the repression of false indications of origin, the penalties provided by the corresponding stipulations of the laws relating to marks or trade names shall be applicable.

#### *Article 2.*

1. The seizure shall be made by the Customs Authorities, who shall immediately inform the person interested, whether an individual or a body of persons corporate or unincorporate, in

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(1) Taken from the Translation published by H. M. Stationery Office, London, with the kind permission of the Controller.

order that such person may, if he so desires, take appropriate steps to confirm the seizure made as a protective measure. Nevertheless, the Public Prosecutor or any other competent authority may demand the seizure either at the request of the party injured or in their official capacity; the procedure shall then follow its ordinary course.

2. The Authorities are not bound to effect the seizure of the goods in transit.

### *Article 3.*

The present stipulations shall not prevent the vendor from indicating his name or address upon goods coming from a country other than that in which the sale takes place; but in such case the address or the name must be accompanied by a clear indication in legible characters of the country or place of manufacture or production, or by some other indication sufficient to avoid any error as to the true origin of the goods.

### *Article 3 bis.*

The countries to which the present agreement applies similarly undertake to prohibit the use in connection with the sale or exposing or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the origin of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers or any other commercial communication.

## APPENDIX XII.

### FOREIGN STATES AND BRITISH POSSESSIONS TO WHICH ORDERS IN COUNCIL RELATING TO INTERNATIONAL AND COLONIAL ARRANGEMENTS APPLY.<sup>1</sup>

#### (a) *International Arrangements.*

Foreign State.	Date of Order in Council.
Austria-Hungary .. ..	17 May, 1909.
Belgium .. ..	26 June, 1884.
Brazil .. ..	26 June, 1884.
Bulgaria .. ..	14 July, 1921.
Cuba .. ..	12 Jan. 1905.
Czechoslovakia .. ..	11 March, 1920.
Dantzic (Free City of) ..	21 Nov. 1921.
Denmark (including the Faroe Islands) .. ..	20 Nov. 1894.
Dominican Republic .. ..	21 Oct. 1890.
Ecuador .. ..	16 May, 1893.
Finland .. ..	11 Oct. 1921.
France (with Algeria and Colonies) .. ..	26 June, 1884.
Germany .. ..	9 Oct. 1903.
Greece .. ..	15 Oct. 1894.
Honduras .. ..	26 Sep. 1901.
Hungary .. ..	<i>See Austria-Hungary.</i>
Italy .. ..	26 June, 1884.
Japan .. ..	7 Oct. 1899.
Jugo-Slavia .. ..	26 Feb. 1921.
Luxembourg .. ..	14 July, 1922.
Mexico .. ..	28 May, 1889.
Morocco (part under French "protection) .. ..	1918.
Netherlands .. ..	26 June, 1884.
Netherlands (East Indian colonies) .. ..	17 Nov. 1888.

(1) Originally, Secs. 103 and 104 of the Patents, etc., Act, 1883, now replaced by Sec. 91 of the Patents and Designs Act, 1907.

Foreign State.	Date of Order in Council.	
Netherlands (Curacao and Surinam)	.. ..	17 May, 1890.
Norway	.. ..	See Sweden.
Paraguay	.. ..	24 Sep. 1886.
Poland	.. ..	25 Nov. 1919.
Portugal (with the Azores and Madeira)	.. ..	26 June, 1884.
Roumania <sup>1</sup>	.. ..	13 Oct. 1920.
Sorb-croat-slovone State	.. ..	14 Feb. 1921.
Serbia	.. ..	26 June, 1884.
Spain	.. ..	26 June, 1884.
Sweden	.. ..	9 July, 1885.
Switzerland	.. ..	26 June, 1884.
Tunis	.. ..	26 June, 1884.
United States	.. ..	12 July, 1887.
Uruguay <sup>1</sup>	.. ..	24 Sep. 1886.

(b) *Colonial Arrangements.*

Colony	Date of Order in Council.	
Ceylon	.. ..	7 Aug. 1903.
Commonwealth of Australia.	.. ..	26 March, 1907.
Queensland	.. ..	17 Sep. 1885.
New Zealand	.. ..	8 Feb. 1890.
Tasmania	.. ..	30 April, 1894.
Trinidad and Tobago	.. ..	12 Aug. 1907.
Western Australia	.. ..	11 May, 1895.

(1) Originally Secs. 103 and 104 of the Patents, etc., Act, 1883, now replaced by Sec. 91 of the Patents and Designs Act, 1907.

## **APPENDIX XIII.**

### **LIST OF COUNTRIES WITHOUT TRADE MARK LEGISLATION.**

**Abyssinia.**

**British Honduras.**

**British Solomon Islands Protectorate.**

**Brunei.**

**Gilbert and Ellice Islands Colony.**

**Grenada.**

**India.**

**Johore.**

**Kedah.**

**Kelantan.**

**Malay Peninsula.**

**Monaco.**

**Oman.**

**St. Helena.**

**St. Vincent.**

**Sarawak.**



## APPENDIX XIV.

TABLE SHOWING THE DATE OF LEGISLATION, DURATION AND EFFECT OF REGISTRATION OF TRADE MARKS IN FOREIGN COUNTRIES.

Country.	Date of law.	Duration of protection. Years.	Title to the mark acquired by.	Remarks.
Argentine Republic (South America)	1900	10	First Registrant	Assignment may be effected without the transfer of the goodwill of the business.
Australia	1905-1922	14	First user	..
Austria (Republic)	1928	10	First user	..
Belgium	1879-1925-32	10	First user	..
Bermuda	1930	14	First user	..
Bolivia (South America)	1918	10	First registrant	..
Brazil (South America)	1923	15	First registrant	..
British Guiana	1914-28-29	14	First user	..
Bulgaria	1903	10	First registrant if not contested	..
Canada	1932	General: 25 Specific: 15	First user	..
Ceylon	1888-1925	14	First user	..
Chile (South America)	1925-28-31	10	First registrant. But rights of prior user recognised.	Assignment may be transferred without the business.
China	1930	20	First user	..
Colombia (United States of) ..	1925	10	First registrant	..
Congo Free State	1888-1912-30	Unlimited.	First user	..
Costa Rica (South America) ..	1930	15	First registrant	..
Cuba (South America)	1884	15	First registrant	..
				In the case of foreigners certificate of home registration is necessary.

Cyprus	..	1910-20	14	First user	..	In the case of foreigners certificate of home registration is necessary.
Czechoslovakia	..	1919	10	First user	..	In the case of foreigners certificate of home registration is necessary.
Denmark	..	1890-93-1904-1918	10	First registrant, but prior user may contest within a limited period.	..	In the case of foreigners certificate of home registration is necessary.
Dutch East India.	..	1893	20	First user	..	In the case of foreigners certificate of home registration is necessary.
Ecuador (South America)	..	1928	20	First user	..	In the case of foreigners certificate of home registration is necessary. Deposit system.
Estonia (East Europe)	..	1921	1 to 10 at option of applicant.	First user	..	Registration by "Deposit" system; no examination.
Fiji Islands	..	1886	7	First user	..	In the case of foreigners certificate of home registration is necessary.
Finland (East Europe)	..	1898	10	First registrant	..	In the case of foreigners certificate of home registration is necessary.
France	..	1857-1890 & 1920	15	First user	..	In the case of foreigners certificate of home registration is necessary.
German Reich	..	1894-1923	10	First-user	..	In the case of foreigners certificate of home registration is necessary.
Great Britain	..	1905-1919	14	First user	..	In the case of foreigners certificate of home registration is necessary.
Greece	..	1893-1914-21, 22, 1923-24, 28	10	First user	..	In the case of foreigners certificate of home registration is necessary. Assignment may be effected without the transfer of the goodwill of the business.
Guatemala (South America).	..	1926	10	First registrant	..	In the case of foreigners certificate of home registration is necessary.
Holland	..	1893-1904	20	First user	..	In the case of foreigners certificate of home registration is necessary. Deposit system.
Honduras republic (South America).	..	1919	10	First user	..	In the case of foreigners certificate of home registration is necessary.
Hungary	..	1890	10	First user	..	In the case of foreigners certificate of home registration is necessary.
Iceland	..	..	10	First Registrant	..	Do.
Iraq	..	1931	15	First user	..	In the case of foreigners certificate of home registration is necessary. Deposit system.
Irish Free State	..	1927	14	First user	..	In the case of foreigners certificate of home registration is necessary.
Italy	..	1868	Unlimited	First user	..	In the case of foreigners certificate of home registration is necessary. Deposit system.
Japan	..	1909-21	20	First user	..	In the case of foreigners certificate of home registration is necessary. Deposit system.

Country.	Date of Law.	Duration of protection. Years.	Title to the mark acquired by.	Remarks.
Jugo-Slavia (East Europe)	1922-23-24	Unlimited	First user	In the case of foreigners certificate of home registration is necessary.
Latvia ( " )	1921	10	First user	Do.
Lithuania ( " )	1925-1928	1-10 at option of applicant.	First user	Do.
Mexico (South America)	1929	20	First user	Certificate of home registration is not essential; but should be sent when registered in applicant's home country.
Morocco	1916-1917	20	First user	
Netherlands	See Holland			
Newfoundland	"	Unlimited	First user	
New Zealand	1922	14	First user	
Nicaragua (South America)	1907	10	First registrant	Deposit system.
Norway	1910-1923	10	First registrant, but rights of prior user recognised.	In the case of foreigners certificate of home registration is necessary.
Palestine	1921-23-30	20	First user	Do.
Panama (South America)	1916	10	First user	Do. (Assignment only together with the good will of the business).
Paraguay (South America)	1889-1905	10	First registrant	Do. (Deposit system).
Persia	1931	10	First registrant	
Peru (South America)	1892-95	10	First registrant	
Philippine Islands		30 limited by home registration.	First user	
Poland (East Europe)	1928	10	First registrant, but rights of prior user recognised.	Do.
Portugal	1894	10	First registrant, but rights of prior user recognised for a limited period.	Do.

Rhodesia (Southern)	1897	14	First user	..	Deposit system.	..
Roumania (East Europe)	1879	15	First user	..	In the case of foreigners certificate of home registration is necessary.	..
Russia (R. S. F. S. R.)	1926	Any length of time at option of applicant.	First registrant	..		
Siam (Asia)	1931	10	First user	..		
South African Union	1916	14	First user	..		
Spain	1929	20	First registrant	..	In the case of foreigners certificate of home registration is necessary.	
Sudan	1930	20	First user	..		
Sweden	1884-1897-1918-29, 30, 34.	10	First registrant, but rights of prior user recognised for a limited period	..	In the case of foreigners certificate of home registration is necessary.	
Switzerland	1890-1928.	20	First user	..		
Turkey	1888-1921	15	First user. First registrant regarded <i>prima facie</i> as rightful owner	..	Assignment may be effected without the goodwill of the business.	Do.
U. S. A.	1905-1930	20 limited by home registration.	First user	..	In the case of foreigners certificate of home registration is necessary.	Do.
Uruguay (South America)	1909	10	First registrant, but rights of prior user recognised for a limited period	..		Do.
Venezuela ( " )	1927-30	10		..		

## APPENDIX XV.

**TABLE SHOWING THE FEES FOR REGISTRATION AND RENEWAL OF  
TRADE MARKS IN SOME FOREIGN COUNTRIES.**

Country.	Fee for application.		Fee for registration		Fee for renewal.	
	Domestic Currency.	Equivalent Indian currency.	Domestic currency.	Equivalent Indian currency.	Domestic currency.	Equi- valent Indian currency.
		Rs.		Rs.		Rs.
Australia ..	£ 2	27	£ 3	40	£ 5	67
Belgium ..			250 Belga	95		
Canada ..	25 Dollars.	69			15 dollars	41
Ceylon ..	Rs. 10	10	Rs. 20	20	Rs. 20	20
Denmark.			64 Kr.	47	19 Kr.	14
France ..	Deposit Tax 43 Francs.	5	State Tax 80 francs.	9		
German Riech ..	15 G.M.	10	15 G.M.	10	50 G.M.	33
Holland ..			30 gulden	33		
Iraq ..	Rs. 5	5	Rs. 30	30	Rs. 20	20
Irish Free State ..	£ 1.	13	£ 2	27	£ 2	27
New Zealand	15 sh.	10	£ 1 10	20	£ 2	27
Norway ..			40 Kr.	29	40 Kr.	29
U.S.S.R.	25 roubles.	35	25 roubles for each year and printing cost 20 roubles	35 for each year and printing cost Rs. 28	5 roubles each year and 20 roubles for publi- cation	7 for each year and 28 for publi- cation
Siam ..	10 ticals.	12	25 ticals.	15	25 ticals.	15
South Africa	£ 1.	13	£ 2	26	£ 1	13
Turkey ..	Turkish pound		T 30 1 (T £)	40	T 30 1 (T £)	40
United Kingdom.	£ 1.	13	£ 2	27	£ 2	27
United States of America.			15 dollars	41	15 dollars	41

# APPENDIX XV.—(Contd.)

## SOUTH AMERICAN COUNTRIES.

Country.	Fee for Registration.		Fee for renewal.	
	Domestic currency.	Equivalent Indian currency.	Domestic currency.*	Equivalent Indian currency.
		Rs.		Rs.
Argentina ..	50 pesos.	55		
Bolivia ..	30 bolivianos.	30		
Brazil ..	.. milreis.	33		
Chile ..	£ 8-10.	113	£ 9-10.	127
Colombia ..	36·10 dollars.	99	22·50 dollars.	62
Costa Rica ..	28 colones.	36		
Cuba ..	12·7 pesos.	35	12·70 pesos.	35
Dominican Republic.	20 years 46 dollars	126		126
	15 years 41 dollars	112		112
	10 years 36 dollars	99		99
Ecuador ..	67·6 sucres.	37	67·6 sucres.	37
Guatemala ..	36 quetzales.	123	36 quetzales.	123
Haiti ..	20·6	56	20·6.	56
Honduras ..	95 pesos.	130	95 pesos.	130
Mexico ..	25 pesos.	21	10 pesos.	8
Nicaragua ..	25 pesos.	69	25 pesos.	69
Panama ..	25 pesos.	69	20 pesos.	55
Paraguay ..	20 gold.	53	20 gold.	53
Peru ..	4 libras.	26		
Uruguay ..	10 pesos.	22	25 pesos.	55
Venezuela ..	70 bolivares.	57	70 bolivares.	57
El Salvador ..	25 colones.	34	25 colones.	34

\* Figures taken from the Bulletin of the American Trade Mark Bureau, March, 1936.

## APPENDIX XVII.

### CLASSIFICATION OF GOODS FOR THE PURPOSE OF TRADE MARK REGISTRATION ADOPTED AT THE LONDON CONFERENCE OF THE INTERNATIONAL CONVENTION.

The following scheme of a classification of goods for International adoption was recommended by the London Conference for the Protection of Industrial Property, in May 1934:—

(*Note.*—Parts of an article or apparatus are, in general classified with the article or apparatus except where such parts constitute articles included in other classes.)

1. Chemical products used in industry, science, photography, agriculture, horticulture, forestry, manures (natural and artificial), fire-extinguishing compositions, tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs; tanning substances; adhesive substances used in industry.

2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood colouring matters, dyestuffs; mordants, resins; metals in foil and powder form for painters and decorators.

3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps, perfumery, essential oils, cosmetics, hair lotions; dentifrices.

4. Industrial oils and greases (other than edible oils and fats and essential oils); lubricants dust laying and absorbing compositions, fuels (including motor spirit) and illuminants; candles, tapers, nightlights and wicks.

5. Pharmaceutical, veterinary and sanitary substances; children's and invalids' goods; plasters; material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin.

6. Unwrought and partly wrought common metals, anchors, anvils, bells, rolled and cast building materials; rails and other metallic materials for railway track; chains except driving chains

for vehicles, cables and wires (non-electric), locksmiths' work; metallic pipes and tubes; safes and cash boxes; steel balls; horse-shoes; nails and screws and other goods in non-precious metal not included in other classes; ores.

7. Machines and machine tools; motors (except for vehicles), machine couplings and belting (except for vehicles), large size agricultural implements; incubators.

8. Hand tools and instruments; cutlery, forks and spoons; side arms.

9. Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counterfreed apparatus; phonographs; cash registers; calculating machines; fire extinguishing apparatus.

10. Surgical, medical, dental and veterinary instruments and apparatus (including artificial limbs, eyes and teeth).

11. Installation for lightning, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

12. Vehicles; apparatus for locomotion by land, air or water.

13. Firearms; ammunition and projectiles; explosive substances; fireworks.

14. Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewellery; precious stones; horologe and other chronometric instruments.

15. Musical instruments (other than phonographs and wireless apparatus).

16. Paper and paper articles, cardboard and cardboard articles, printed matter, newspapers and periodicals, books; book-binding material, photographs; stationery; adhesive materials (stationery); artists' materials, paint brushes, typewriters and office requisites (other than furniture), instructional and teaching material (other than apparatus), type and cliches (stereotype).

17. Gutta percha, India rubber, balata and substitutes, articles made from these substances, and not included in other



classes; materials for packing, stopping or insulating; asbestos, mica, and their products; hose pipes (non-metallic).

18. Leather and imitations of leather, and articles made from these materials, and not included in other classes, skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

19. Building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel, pipes of earthenware or cement, road-making materials, asphalt, pitch and bitumen; portable buildings; stone monuments, chimney pots.

20. Furniture, mirrors, picture frames; articles (not included in other classes) consisting of wood, cork, reeds, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl; meerschaum, celluloid, and substitutes for all these materials.

21. Small hardware and hollow-ware articles (not of previous metal, nor coated therewith), combs and sponges; brushes (other than paint brushes), brush making materials; instruments and material for cleaning purposes; steelwool; glassware, porcelain and earthenware not included in other classes.

22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks; padding or stuffing materials, (hair, capoe, feathers, seaweed, &c.), raw fibrous textile materials.

23. Yarns; threads.

24. Tissues (piece goods), bed and table covers, textile articles not included in other classes.

25. Clothing, including boots, shoes and slippers.

26. Lace and embroidery; ribbands and braid, buttons, press buttons, hooks and eyes; pins and needles; artificial flowers.

27. Carpets, rugs, mats and matting; linoleums and other materials for covering floors; wall hangings (non-textile).

28. Games and playthings; gymnastic and sporting articles; ornaments and decorations for Christmas tree.

29. Meat, fish, poultry and game; meat extracts, preserved, dried and cooked fruits and vegetables; jellies, jams, eggs, milk and other dairy products; edible oils and fats, preserves, pickles.

30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, bis-

cuits, cakes, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, pepper, vinegar, sauces, spices, ice.

31. Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt.

32. Beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.

33. Wines, spirits and liqueurs.

34. Tobacco, raw or manufactured; smokers' articles, matches.

## APPENDIX XVIII.

### PLEADINGS IN ACTIONS FOR PASSING OFF.

#### *Statement of Claim in Reddaway Co. v. Bentham Hemp Spinning Co., 9 R.P.C. 503.*

By the Statement of Claim the plaintiffs stated as follows:—

“The plaintiffs have, for many years, been manufacturers of belting for driving machinery, and have extensively advertised, and sold the belting made by them under the styles of “Camel,” “Camel Brand,” and “Camel Hair.” In consequence thereof, belting called “Camel,” “Camel Brand,” or “Camel Hair” has become to be known in all parts of the world where belting is used as belting of the Plaintiffs’ manufacture—as the defendants well know.

The defendants have lately commenced the business of belting manufacturers, and in order to obtain for themselves the reputation acquired by the Plaintiffs, and to pass off their belting as that of the Plaintiffs, and to deceive purchasers thereof, have adopted the words “Camel,” “Camel Brand,” and “Camel Hair,” so used by the Plaintiffs as aforesaid, and have sold belting under the same designation, and have advertised for sale belting manufactured by them as “Camel,” “Camel Brand,” and “Camel Hair Belting.”

The use of the words “Camel,” “Camel Brand,” and “Camel Hair,” by the Defendants as aforesaid, is calculated to deceive purchasers of belting into the belief that they were buying belting of the plaintiffs’ manufacture, and many persons have been so deceived.” The plaintiffs alleged that they had suffered damage thereby, and that they had lost the benefit of their expenditure and advertisement.

#### *Defence.*

By their Statement of Defence, the defendants denied that belting called “Camel,” “Camel Brand” and “Camel Hair Belting” has become to be known in all parts of the world where belting is used as belting of the plaintiffs’ manufacture; and, if it had, they denied that the defendants were aware of the fact.

“The Defendants and their predecessors have long carried on the business of hemp spinning, and some time ago commenced the manufacture of various kinds of belting in connection with and as a branch of their said business.

Amongst other materials used by the Defendants in the manufacture of belting was yarn made of camels’ hair; and the Defendants have, as they lawfully may, described and sold, the said belting as the ‘Bentham Solid Woven Camel-Hair Belting’. The defendants have applied to the said belting manufactured and sold by them their distinctive trade-mark.

Save as aforesaid, the defendants deny that they have sold or advertised their belting manufactured by them as ‘Camel,’ ‘Camel Brand,’ and ‘Camel Hair.’

The Defendants deny that the use of the words ‘Camel,’ ‘Camel Brand,’ and ‘Camel Hair,’ would be calculated to deceive persons into the belief that they were buying goods of the Plaintiffs’ manufacture. The Plaintiffs had no prescriptive or distinctive right to the use of the said words.

The Defendants deny that the use of the words, ‘Camel Hair,’ as used by them, was calculated to deceive purchasers of belting manufactured by the Defendants into the belief that they were buying belting of Plaintiffs’ manufacture. The Defendants deny that any persons have been so deceived.’

The Defendants also denied that the Plaintiffs had been damnified, and alleged that their competition with the Plaintiffs was fair trade competition.

## APPENDIX XIX.

### FORMS OF ORDERS IN TRADE MARK CASES.

*Seizo v. Provezende*, L.R. 1 Ch. 194, (1865), Cranworth, L.C.,

An injunction to restrain the defendants from "affixing, or causing to be affixed, to any casks of wine shipped to their orders, the brand or mark of a crown and the word *Seizo*, or any other combination of marks or words so contrived, as by colourable imitation, or otherwise, to represent the marks or brands of the plaintiff, and from employing any marks or words which should be so contrived as to represent, or induce the belief, that such wines were Crown *Seizo*, or the produce of the *Quinta do Seizo*, or otherwise using the word *Seizo*, without clearly distinguishing the same from the wines produced by the *Quinta do Seizo*."

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*Wotherspoon v. Currie*, L.R. 5 H.L., p. 523 (1872).

Injunction restraining the respondent, his servants and agents, "from using the word 'Glenfield' in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be "Glenfield Starch" and from selling or causing the same to be sold as "Glenfield Starch" and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent is "Glenfield Starch" or starch manufactured by the appellants."

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*Ralli v. Fleming*, 3 Cal. 417.

Sir Richard Garth, C.J., and Markby, J.

(Interlocutory.)

"Order, that the defendants be restrained from selling any cloth impressed with the combination of marks described in exhibit D, annexed to the affidavit of Alexander Westerhout, or any other combination resembling that used by the plaintiffs, and especially from using the number '2008' in any such combination."

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*Orr-Ewing & Co. v. Johnston & Co.*, 13 C.D., p. 450 (1880),  
Fry, J., and C.A.

"To restrain the defendants, Robert Johnston & Co., their servants, workmen, and agents, from affixing or causing to be

affixed to any Turkey red yarn not dyed by the plaintiffs, Archibald Orr-Ewing & Co., the ticket marked B, and from using two elephants on any tickets used on Turkey red yarn, without clearly distinguishing such tickets from the Plaintiffs' ticket."

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*Massam v. Thorley's Cattle Food Company*, 14 C.D.,  
p. 762 (1880), James, L.J.

An injunction to restrain "the defendant company, their servants, workmen, agents and travellers, and representatives respectively, from selling, exporting, or shipping, or causing or procuring, or allowing to be sold, shipped, or exported, and from in any manner representing, or causing, or procuring to be represented, any goods manufactured by the defendant company as the manufacture or goods of the late *Joseph Thorley*, or of the plaintiffs, his trustees and successors in business; and also from in any manner representing, or causing, or procuring to be represented, or doing anything which shall lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or are the successors in business of the late *Joseph Thorley*; and also from affixing or permitting, or causing to be affixed to any goods or articles manufactured or bought, or procured, or sold, or shipped, or exported by the defendant company, or otherwise using or employing, or permitting to be used or employed, any labels, wrappers, or marks used by the late *Joseph Thorley* and the plaintiffs, his trustees and successors in business, or so contrived and prepared as to represent or lead to the belief that the goods or articles manufactured, or sold, or shipped or exported by the defendant company are the goods or manufacture of the late *Joseph Thorley*, or of the plaintiffs; and also from employing, using, or circulating, or causing to be employed, used, or circulated, any circulars, pamphlets, notices, or advertisements of the late *Joseph Thorley*, or of the plaintiffs, or which shall in any manner represent or lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or that they are his successors in business."

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*Lever v. Goodwin*, 4 R.P.C., p. 503 (1886), Chitty, J., and C.A.

"This Court doth order that this action, so far as the same claims protection in respect of the trade-mark, No. 39, 714, stand dismissed out of the said Court. And it is ordered that the defendants, Goodwin Bros., their agents and servants, be restrained from

selling, offering for sale, or disposing of any soap, not being manufactured for or by the plaintiffs in the wrapper, or of the form of any one of the three exhibits admitted in this action to have been issued by the defendants, and marked J.S.S. 1., J.S.S. 4, and B.B. 1, or in any wrapper or in any form calculated or intended to pass off, or to enable others to pass off, such soap as or for the goods of the plaintiffs. And it is ordered that the following account be taken, that is to say, an account of the profits made by the defendants in selling or disposing of soap, made by or for the defendants, in any wrapper such as that contained in the exhibits marked J.S.S. 1, J.S.S. 4, and B.B. 1, and in the form of those exhibits. And it is ordered that the defendants, Goodwin Bros., do within fourteen days after the date of the chief clerk's certificate, to be made pursuant to this order, pay to the plaintiffs, Lever & Co., the amount which, upon taking such account, shall be certified to be payable by the defendants to the plaintiffs. And it is ordered that it be referred to the taxing master to tax the costs of the plaintiffs of this action, up to and including the trial, except so far as the same have been incurred by their claim for protection in respect of the trade-mark aforesaid. And it is ordered that it be referred to the taxing master to tax the costs of the defendants of the action, so far as the same have been incurred by the plaintiffs setting up the said claim for protection in respect of the said trade-mark, and costs of the plaintiffs when so taxed, are to be set off against the said costs of the defendants, when taxed, and the taxing master is to certify to whom, after such set-off, the balance is due. And it is ordered that the party from whom such balance shall be certified to be due do pay the amount thereof to the other party. And the question of the costs of this action incurred subsequent to the trial are reserved, and either of the parties are to be at liberty to apply as they may be advised."

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*The Apollinaris Co. v. Herrfeldt*, 4 R.P.C., 488 (1887), C.A.

#### Interlocutory Injunction.

"That the defendants, Messrs. Herrfeldt and Campbell, their servants, agents, and workmen, be restrained, until judgment in this action or further order, from using the word '*Apollinis*,' or any other word only colourably differing from the word '*Apollinaris*,' upon any labels or corks used by them in the course of their trade in any mineral water, and also from offering for sale, or selling, or otherwise disposing of any mineral water in bottles bearing the word '*Apollinis*.'"

*Montgomery v. Thompson*, 41 C.D. 47, (1889) Chitty, J., and C.A.

An injunction restraining "the defendant until judgment or further order from carrying on the business of a brewer at *Stone*, under the title of "*Stone Brewery*," or "*Montgomery's Stone Brewery*," or under any other title so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling or causing to be sold any ale or beer not of the plaintiffs' manufacture, under the term "*Stone Ale*" or "*Stone Ales*," or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture."

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*Powell v. Birmingham Vinegar Brewery Co., Ltd.*, (1896)

2 Ch. 54; 12 R.P.C. 496, Stirling, J.

"This Court doth order that the defendants, The Birmingham Vinegar Brewery Co., Ltd., their servants and agents, be perpetually restrained by injunction from using the words "*Yorkshire Relish*" as descriptive of or in connection with any sauce or relish manufactured by them, or sauce or relish (not being of the plaintiff's manufacture) sold, or offered for sale, by them without clearly distinguishing such sauce or relish from the sauce or relish of the plaintiff. And it is ordered that the following account be taken at the risk of the plaintiff; an account of all profits made by the defendants by the sale of any sauce or relish (not manufactured by the plaintiff) in bottles having labels with the words "*Yorkshire Relish*" thereon. And it is ordered that in case the defendants shall on or before 12th November, 1895, serve a notice of appeal from this order, the restraint hereby imposed is, so far as regards the label secondly issued by the defendants, to be suspended until after such appeal shall have been heard or otherwise disposed of."

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*Saxlehner v. Apollinaris Co.*, 14 R.P.C. 657, (1897).

Kekewich, J.

An injunction to restrain the defendants, their officers, &c., "from selling or offering, or exposing or advertising for sale, in the United Kingdom, any Hungarian bitter water, not being "*Hunyadi Janos*" water derived from the plaintiff's spring near Buda Pesth, in the Kingdom of Hungary, under or with or by means of any name or description of which the name "*Hunyadi*" forms part, without clearly distinguishing the same from the water derived from the said spring. Delivery up or destruction of all labels and other documents, and also capsules in the possession or power of the defendants, or under their control, which exhibit the name



“Hunyadi” in connection with Hungarian bitter water without clearly distinguishing the same from water derived from the said spring.” (Defendant to pay costs except so far as they have been increased by plaintiff charging deception.)

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*Eastman Photographic Materials Co., Ltd. v. John Griffiths  
Cycle Corporation, Ltd., and Kodak Cycle Co., Ltd.,*  
15 R.P.C. 112, (1898), Romer, J.

An injunction restraining “the defendant companies, or either of them, from carrying on business under the name ‘Kodak Cycle Co., Ltd.’, or under any name comprising the word ‘Kodak’ likely to mislead or deceive the public into the belief that the defendant company is the same company as or is connected with either of the plaintiff companies, or that the business of the said companies, or either of them, is the same as, or is in any way connected with, the business of the plaintiffs, The Eastman Photographic Materials Co., Ltd. I also grant an injunction to restrain the defendant companies, and each of them, from selling, or offering to sell, any of their cycles or goods as ‘Kodak.’ ”

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*Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.,*  
17 R.P.C. 688, (1900), C.A.

“This Court doth order that the defendants, the Valentine Extract Co., Ltd., and Herbert Hughes, and each of them, their servants and agents, be perpetually restrained from carrying on business as manufacturers or vendors of any preparation of extract of meat, or meat juice under any name or title of which the name ‘Valentine’ or ‘Valentine’s’ forms part, and from selling, or offering, or exposing, or advertising for sale, or procuring to be sold any such preparation as aforesaid not being of the plaintiff’s manufacture under any name or description of which the name ‘Valentine,’ or ‘Valentine’s,’ or ‘Valtines;’ forms part. And it is ordered that the defendant, Charles Richard Valentine, his servants and agents, be perpetually restrained from carrying on any such business as aforesaid, under any such name or title as aforesaid, without clearly distinguishing such business from the business of the plaintiffs, and from selling, or offering, or exposing, or advertising for sale, or procuring to be sold, any such preparation as aforesaid, under any such name or description as aforesaid, without clearly distinguishing such preparation from goods of the plaintiffs. And doth order that the defendants, the Valentine Extract Co., Ltd., Charles Richard Valentine, and

Herbert Hughes, and each of them, their servants and agents, be perpetually restrained from in any manner representing or acting so as to be calculated to lead to the belief that the defendant, Charles Richard Valentine, is or ever has been interested in or connected with the business of the plaintiffs, and from passing off, or enabling or assisting others to pass off, any such preparation as aforesaid not being of the plaintiff's manufacture, as or for the plaintiff's goods."

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*Hendriks v. Montagu*, (1881) 17 Ch.D. p. 683, C.A.

"An injunction to restrain the defendants from applying to the Registrar of Joint Stock Companies in England for registration, under the Companies Acts, of any company to be incorporated under the name of *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the Universal Life Assurance Society, from issuing or publishing advertisements, circulars, or prospectuses, representing that a company is to be incorporated pursuant to the *Companies Act*, 1862, under the name of the *Universe Life Assurance Association, Ltd.*, or any other such name as aforesaid; and from carrying or commencing any business under the name of the *Universe Life Assurance Association, Ltd.*, or any such other name as aforesaid."

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*J. and J. Cash, Ltd. v. Cash.*

18 R.P.C. 220; 19 R.P.C. 186. C.A.

(Vaughan Williams, Stirling and Cozens-Hardy, L.JJ.).

"This Court doth order that the Defendant, Joseph Cash, be restrained from selling any frillings or woven names or initials not manufactured by the Plaintiffs as 'Cash's Frillings' or 'Cash's Woven Names or Initials', and from carrying on the business of a manufacturer or seller of frillings or woven names or initials under the name of 'Joseph Cash & Co.,' while not in partnership with any other person, and from carrying on any such business either in the name of 'Cash' or under any style in which the name 'Cash' appears without taking reasonable precautions to clearly distinguish the business carried on and the frillings and woven names and initials manufactured or sold by the Defendant from the business carried on and the frillings and woven names and initials manufactured by the Plaintiffs, and from carrying on any such business under any name or in any manner so as to mislead or

deceive the public into the belief that the business of the Defendant or the frillings or woven names or initials manufactured or sold by him are the business of or goods manufactured by Plaintiffs, or that the Defendant is carrying on the business formerly carried on at Coventry by Messrs. J. and J. Cash, the vendors to and predecessors in business of the Plaintiffs. And it is ordered, that the Defendant be also restrained from making over his business in frillings or woven names or initials to or acting as managing director of any limited or other Company formed to carry on business in frillings or woven names or initials, and having a name which is calculated or likely to mislead or deceive the public into the belief that the business, frillings or woven names or initials, of such Company are the business, frillings or woven names or initials of the Plaintiffs, or that such Company is carrying on the business formerly carried on at Coventry by the said Messrs. J. and J. Cash, and from otherwise assisting any such Company to so mislead or deceive the public, and that the defendant be also restrained from soliciting or assisting any limited or other Company or other person or persons to solicit, whether by circular or otherwise, any former customer or customers of the aforesaid old firm of Messrs. J. and J. Cash, of Coventry, to deal with the Defendant or such limited or other Company or other person or persons for goods of a kind manufactured by the said old firm and still manufactured by the Plaintiffs, or not to deal with the plaintiffs, the successors in business of the said old firm, for goods of the kind aforesaid. And it is ordered, that the Defendant pay to the Plaintiffs their costs of this action, to be taxed by the Taxing Master, and the Defendant is to be at liberty to apply for an inquiry as to damages sustained by reason of the said interim Order upon giving to the Plaintiffs two days' previous notice of his intention so to do."

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*Joseph Rodgers & Sons, Ltd. v. Joseph Rodgers Simpson,*

23 R.P.C. 348.

Buckley, J.

"This court doth order and adjudge that the Defendant Joseph Rodgers Simpson, his servants and agents, be perpetually restrained from passing-off table knives and other cutlery not being the goods of the Plaintiff Company as and for such goods, and from carrying on the business of a manufacturer or seller of knives or cutlery under the name of Rodgers, or under any style in which the name of Rodgers appears, without taking reasonable precautions to

clearly distinguish the business carried on and the knives or cutlery manufactured or sold by the Defendant from the business carried on and the knives and cutlery manufactured by the Plaintiffs, and from carrying on any such business under any name or in any manner so as to mislead or deceive the public into the belief that the business of the Defendant or the knives or cutlery manufactured or sold by him is the business or are the goods manufactured by the Plaintiff Company. And it is ordered that the following inquiry be made, that is to say:—(1) An inquiry as to what damages have been sustained or incurred by the Plaintiff Company by reason of the manufacture or sale by the Defendant of table knives and other cutlery stamped or sold as the manufacture of 'Joseph Rodgers Simpson & Sons, Sheffield.' And it is ordered that the Defendant, Joseph Rodgers Simpson do pay the plaintiffs, Joseph Rodgers & Sons, Ltd., their costs of this action up to and including this judgment, such costs to be taxed by the Taxing Master, and this Court doth reserve the costs of such inquiry, and the parties are to be at liberty to apply as they may be advised."

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*Mrs. Pomeroy, Ltd. v. Scale*, 24 R.P.C. 193.

Parker, J. (Lord).

"That the Defendant Jeannette Shepherd Scale (the wife of James Bernard Scale) be perpetually restrained from carrying on the business of hygienic complexion treatment and electrolysis or of a complexion specialist under the name or style of 'Jeannette Pomeroy' or 'Mrs. Pomeroy' or any other style of which the name of 'Pomeroy' forms part, and from representing or inducing the belief that she carries on or is connected with or interested in the business carried on by the Plaintiffs or formerly carried on by Mrs. Pomeroy, Ltd. (now in liquidation); and the Defendant by her Counsel undertaking not to sell or offer for sale or use any of the secret recipes or prescriptions the benefit of which was sold and transferred by her to the said Mrs. Pomeroy, Ltd., (now in liquidation) or make any use of any recipes, prescriptions, index cards, electrolysis cards, labels, lists of customers addresses or copies thereof, or any other documents relating to the business in the writ mentioned and taken or obtained by her while she was a director of or in the employment of Mrs. Pomeroy, Ltd., (now in liquidation) or any copies thereof since made by or for her."

*Havana Cigar and Tobacco Factories, Ltd. v. Tiffin, (1905) Ltd.,*  
26 R.P.C. pp. 480, 481.

(Cozens-Hardy, M. R., Buckley & Kennedy, L.J.J.).

“And it is ordered that the Defendants, their officers, servants and agents be perpetually restrained from selling or offering, or exposing or advertising for sale, or procuring to be sold, or passing-off, or inducing, or enabling others to pass off cigars not of the Plaintiffs’ manufacture, as or for the Plaintiffs’ ‘La Corona’ brand of cigars by the use of any words consisting of or containing the word ‘Corona’ as a brand name. And it is ordered that the Defendants do pay to the Plaintiffs the sum of 40s. by way of damages. And it is ordered that it be referred to the Taxing Master to tax the costs of the Plaintiffs of this action, and of and occasioned by the said appeal, except so much thereof (if any) as relate to the claim set up by them in respect of infringement of Trade Mark, and to tax the costs of the Defendants of so much of this action, and of and occasioned by the said appeal, as relates to the said claim, and the Taxing Master is to set off the said costs of the Plaintiffs and of the Defendants, and certify to which of them the balance after such set-off is due.”

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*The West End Watch Company v. The Berna Watch Company, 35 Bom. 437..*

(Sir Basil Scott, C.J.).

“Injunction restraining the defendant Company, their servants, agents, travellers, and representatives respectively, from in any manner representing or causing or procuring to be represented or doing anything which shall lead to the belief that the defendant Company have been or are carrying on the business carried on by the plaintiffs or are the successors in business of the plaintiffs, and from employing using or circulating or causing to be employed used or circulated any circulars, notices, or advertisements which shall in any manner represent or lead to the belief that the defendant Company are carrying on or have succeeded to the business of the plaintiffs.”

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*Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd. (1910) 27 R.P.C. 171. (Neville, J.).*

Injunction restraining the defendants, their directors, and servants and agents, “from selling or offering for sale motor tyres

as 'Warwick' tyres or using the word 'Warwick' in connection with the sale or offering for sale of motor tyres in such a way as to lead to the belief that the defendants' motor tyres are motor tyres of the plaintiff company. And it is ordered that the defendants do deliver up to the plaintiffs all advertisements and tyres in their possession or power which are in contravention of this injunction, or delete therefrom any statements which offend against this injunction."

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*Liquid Veneer Co., Ltd. v. Scott and others*, 29 R.P.C. 639.  
(Swinfen-Eady, J.).

An injunction "to restrain the Defendants and their respective servants and agents until the trial of the action or further Order—(1) from publishing or divulging to any person a secret process for the manufacture of a polish or liquid veneer in breach of their former contract of employment with and the confidence reposed in them by the plaintiffs, and from using any secret or confidential information or list of the Plaintiffs' customers acquired or made by them in the course of such employment, or acting in any other way in breach of their former contract of employment with and of the confidence reposed in them by the Plaintiffs; (2) from manufacturing a polish called "Elve" or any other substance in accordance with the Plaintiffs' secret process or in any way making use of the Plaintiffs' secret process or any other information or list acquired or made by the Defendants John Thomas Scott, Cecil Douglas Clack, and Barnett Barnett while in the employ of the Plaintiffs, and from selling or otherwise dealing in the said polish called 'Elve' or any other polish manufactured in accordance with the Plaintiffs' process or any variation thereof; and (3) from selling or dealing in any polish not of the manufacture or merchandise of the Plaintiffs as and for the Plaintiffs', or in bottles, boxes or wrappers which are a colourable imitation of the plaintiffs', and from representing in any way that the Plaintiffs have ceased to sell their Liquid Veneer, and have gone or are intending to go out of business."

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*Chetarpal Sharma v. Jagannath Das*, A.I.R. 1922 All. 178.  
(Mears, C. J., and Banerjee, J.).

"It is...ordered that the defendant be restrained from selling or offering for sale his medicine "Piyus Sindhu" in any outside wrapper or inside label or with any instructions for use or adver-

tisements in any form calculated or intended to pass off or enable others to pass off such medicine as and for the medicine of the plaintiff."

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*Upendra Nath Brahmachari v. Union Drug Co., Ltd.,*

A.I.R. 1926 Cal. 837.

(C. C. Ghose, J.).

(Interlocutory).

"I...make the rule absolute and direct that the defendant company, their servants and agents, be restrained until the final determination of this suit and until the further orders of this Court from being or applying or causing to be used or applied to the antimony compound mentioned in the plaint herein and sold by the defendant company the name "Urea Stibamine" with the present get-up or any colourable imitation thereof, and I further direct that the defendant company, their servants and agents, be further restrained until as aforesaid from using or employing the said word "Urea Stibamine" or any other words in a manner contrived or calculated to represent or induce the belief on the part of purchasers that the said antimony compound sold by the defendant company, their servants and agents is the antimony compound manufactured and sold by or on behalf of the plaintiffs; plaintiffs undertaking in damages."

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*Lissen, Ltd. v. Harley*, 46 R.P.C., p. 12.

(Clouston, J.)

"That the Defendants their servants and agents be restrained until Judgment in this action or until further order from passing off high tension batteries not of the Plaintiffs' manufacture as and for high tension batteries manufactured by the Plaintiffs and from selling or offering for sale any batteries under a label containing the word 'Lissenon' or under any label calculated to deceive without clearly distinguishing the said batteries from the batteries of the Plaintiffs."

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*Moolji Sicca & Co. v. Ramjan Ali*, A.I.R. 1930 Cal. 678.

(Page, J.).

"In order to afford reasonable protection to the plaintiffs the injunction will be in the following form: That the defendant, his

servants and agents be restrained from selling or offering for sale biris in packets, bundles or cases bearing the label Exhibit 10 or Exhibit 11 or any other label, (whether the word 'Mohini,' the figure of the woman, registered No. 247 in Exhibit 1 are used alone or in combination therein or not) in a form calculated or intended to pass off or to enable others to pass off his goods as and for the goods of the plaintiff.

I further order that the defendant within a week from the date hereof do file an affidavit stating the number of labels Exhibit 10 and Exhibit 11 in his possession or that of his servants and agents, and within a fortnight after the filing of such affidavit the defendant do destroy the said labels in the presence of the plaintiffs or their attorneys. Reference to determine profits that have accrued to defendant within a period of three years prior to the date of the institution of the suit."

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*C. & A. Modes, Ltd. v. Central Purchasing Association, Ltd.,*  
48 R.P.C. at p. 167.

(Humphreys, J.).

"This Court doth order that the Defendant Company, their Directors, servants, and agents, and the Defendants Herbert Frank Clarke and William Clarke, be restrained from carrying on or causing or permitting to be carried on business by advertisement or otherwise under the name or style of 'C.P.A. Modes' or 'C.P. Modes' without sufficiently distinguishing such business from that of the Plaintiffs or under any other style so closely resembling the Plaintiffs as to be calculated to lead to the belief that the Defendants are the Plaintiffs or are connected with them or are a branch or department of the Plaintiffs and from passing off the Defendants' goods as and for the goods of the Plaintiffs."

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*Shallis v. Freeman and Stirling Press, Ltd.,* 48 R.P.C. at p. 374.

(Lord Tomlin).

"An injunction to restrain the Defendants and each of them from printing, publishing and selling or distributing greyhound racing programmes, not being the programmes of the Plaintiff, as Stirling cards."



*Mohamed Noordin v. Abdul Kareem & Co., and another,*

48 R.P.C. pp. 509-510.

(Lords Thankerton and Russell and Sir Lancelot Sanderson).  
(Judicial Committee of the Privy Council).

“This Court doth order that as against the first Defendant, E. P. Mohamed Noordin, this appeal be dismissed, but that as against the second Defendant, S. Mohamed Hussain Sahib, this appeal be allowed and the said judgment dated the 23rd day of September, 1929, be reversed. And this Court doth Order that the second Defendant, his servants and agents, be restrained by the injunction of this Court from infringing the Plaintiffs’ trade marks in the pleadings mentioned and from affixing or applying or causing to be affixed or applied to any sarong not manufactured by the Plaintiffs any mark or label containing the representation of a fez or topi or any colourable imitation of the Plaintiffs’ said marks or any marks or device which would be calculated to cause any sarongs on which they were fixed to be believed to be of the manufacture of the Plaintiffs always save and except the blue label used by the second defendant and referred to in Clause 11 of the Statement of Claim and marked C.I.A., in terms of an agreement made between Plaintiff and the second Defendant dated the 28th day of September, 1927. And this Court doth order and adjudge that under the said agreement the second Defendant was prohibited from using any colour except blue or any shade or hue of blue on the second Defendant’s Chop Glass label. And the Court doth further order as against the second Defendant that he and his servants be restrained by the injunction of this Court from committing a breach of the undertaking of the second Defendant contained in the said agreement referred to in paragraphs 11 and 12 of the statement of claim. And it is adjudged that the Plaintiffs recover against the second Defendant the sum of 1,000 dollars, being liquidated damages as provided in the said agreement. And this Court doth make no order on paragraphs 2 and 3 of the prayer in the Statement of Claim. And it is ordered that the costs of the Plaintiffs of this action be taxed as between party and party and that the second Defendant do pay to the Plaintiffs one-half of the costs up to the close of the pleadings and one-third of the costs subsequent thereto, and it is ordered that the Appellants do pay to the first Defendant his costs of this appeal and that the second Defendant do pay to the Appellants their costs of this appeal, to be taxed in each case as between party and party, and this Court doth

certify for two Counsel for the Plaintiffs both in this Court and the Court below and doth certify for two Counsel for the first Defendant in this Court."

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*British Medical Association v. Marsh*, 48 R.P.C. pp. 576-577.  
(Maugham, J.).

"An injunction to restrain the Defendant from representing that he is carrying on business as a department of or in connection with or by the authority of the Plaintiff Association, or from otherwise holding out the Plaintiff Association as the owners of or in any way connected with the Defendant's business, or from carrying on business or advertising or issuing to the public circulars or exhibiting for sale or selling drugs or medical remedies under the name of the Plaintiff Association or the description "B.M.A." or "B.M.A. Drug Stores" or under any other name or names or description containing the letters "B.M.A." in juxtaposition so as to represent that the Plaintiffs are in any way connected with the Defendant's business."

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*Westinghouse Brake & Saxby Signal Co., Ltd. v. The Varsity Eliminator Co., Ltd.*, 52 R.P.C. at p. 296.

(Luxmoore, J.).

"Restraining the Defendants, their servants and agents (a) from selling or offering for sale or advertising as a Westinghouse rectifier a Westinghouse rectifier from which parts have been abstracted or which has been reassembled in a form other than the form in which the same was manufactured and sold by the Plaintiffs, (b) From selling or offering for sale or advertising rectifiers under the name "Westinghouse" or any other name representing that the same were wholly of the Plaintiffs' manufacture or merchandize unless the same were wholly made or assembled by the Plaintiffs without alteration by any other person. (c) From selling or offering for sale or advertising under the name "Westinghouse" rectifiers or like apparatus not of the Plaintiffs' manufacture or merchandise."

*Minimax, Ltd. v. Moffat (trading as L. & G. Fire Appliance Co.),*  
52 R.P.C. at p. 344.

(Eve, J.).

“Restraining the Defendant, his servants and agents from passing off or causing to be passed off Fire Extinguisher Refills not of the Plaintiffs’ manufacture or merchandise as or for the Plaintiffs’ goods, and in particular from supplying in response to orders for “Minimax Refills” refills not the Plaintiffs’ manufacture or merchandise without clearly indicating that the refills supplied are not of the Plaintiffs’ manufacture or merchandise and from using the name “Minimax” upon or in connection with fire-extinguisher refills not of the Plaintiffs’ manufacture or merchandise without clearly indicating that the said refills are not refills of the Plaintiffs’ manufacture or merchandise.”

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*The Clock, Ltd. v. The Clock House Hotel, Ltd.,*

52 R.P.C. at p. 397 (Farwell, J.)

Restraining the Defendants etc., “from carrying on the business of an hotel, road house or restaurant under the name of ‘The Clock House,’ ‘The Clock House Hotel’ or ‘The Clock House Hotel, Ltd.,’ on the premises now occupied by the Defendants or any name colourably resembling the Plaintiffs’ name or the name ‘The Clock’ or from otherwise carrying on business under any description calculated to produce the belief that the Defendants’ business is that of the Plaintiffs or that the one is a branch or department of the other.”

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*Walter v. Ashton, (1902) 2 Ch. 295 (Byrne, J.)*

Restraining “from representing that the cycles offered by him for sale are in fact offered for sale by the proprietors of ‘The Times’ newspaper, or representing that he is carrying on business as a department of, or in connection with, ‘The Times’ newspaper, or in any way holding out ‘The Times’ newspaper, or the proprietors thereof, to be the owners of the business.”

## APPENDIX XX.

### PROCEDURE FOR OFFENCES UNDER SECTIONS 478-489 OF THE INDIAN PENAL CODE.

- Section 482.* Not cognizable — Warrant — Bailable — Compoundable when permission is given by the Court before which the prosecution is pending—Triable by Presidency Magistrate, or Magistrate of the first or second class.
- Section 483.* Not cognizable — Warrant — Bailable—Compoundable when permission is given by the Court before which the prosecution is pending—Triable by Presidency Magistrate, or Magistrate of the first or second class.
- Section 484.* Not cognizable — Summons — Bailable — Not compoundable—Triable by Court of Session, Presidency Magistrate, or Magistrate of the first class.
- Section 485.* Not cognizable — Summons — Bailable — Not compoundable—Triable by Court of Session, Presidency Magistrate, or Magistrate of the first class.
- Section 486.* Not cognizable — Summons — Bailable—Compoundable when permission is given by the Court before which the prosecution is pending—Triable by Presidency Magistrate, or Magistrate of the first or second class.
- Section 487.* Not cognizable — Summons — Bailable — Not compoundable—Triable by Court of Session, Presidency Magistrate or Magistrate of the first or second class.
- Section 488.* Not cognizable — Summons — Bailable — Not compoundable—Triable by Court of Session, Presidency Magistrate, or Magistrate of the first or second class.

*Section 489. Not cognizable — Summons — Bailable — Not compoundable — Triable by Presidency Magistrate, or Magistrate of the first or second class.*

## APPENDIX XXI.

FORM OF DECLARATION OF OWNERSHIP OF TRADE MARKS  
GENERALLY MADE BEFORE THE REGISTRAR OF ASSURANCES.<sup>1</sup>

I (or we)<sup>2</sup>.....hereby declare:—

(1) that I am the sole proprietor of the trade mark, a facsimile of which is given below;<sup>3</sup>

(2) that I am using the trade mark on<sup>4</sup>.....

(3) that I have acquired the right of prior usage in British India in the said trade mark for the said class of goods;

(4) that any one counterfeiting the said trade mark or using a colourable imitation thereof for the said or closely allied class of goods will be dealt with according to law;

(5) that the facts and matters stated herein are true to the best of my knowledge, information and belief.

Dated this.....day of.....

(Signed).

Witness:—

Witness:—

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(1) The declaration should be made on Rs. 2 stamped paper and a further fee of Rs. 2 should be paid for registration.

(2) Insert name and address of the declarer.

(3) A facsimile of the trade mark may be affixed. Two copies of the trade mark should be forwarded.

(4) Give the description of the goods on which the trade mark is used.

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